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No. 93-___

Supreme Court, U.S.
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IN THE
Supreme Court of the United States
OCTOBER TERM, 1993

BELLSOUTH ADVERTISING
& PUBLISHING CORPORATION,
Petitioner,

v.

DONNELLEY INFORMATION PUBLISHING, INC., and
THE REUBEN H. DONNELLEY CORPORATION,
Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

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PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Whether the court below erred in concluding that the selection, coordination, and arrangement of the headings and the listings under those headings in a yellow pages directory are not sufficiently creative to qualify for copyright protection, so that a rival publisher does not violate the registered copyright in the yellow pages when it engages in wholesale copying of that compilation, rather than use more current listings made available to it by the telephone company.

PARTIES TO THE PROCEEDING

Petitioner BellSouth Advertising & Publishing Corporation was plaintiff, counterclaim defendant, and appellee below. Respondents Donnelley Information Publishing, Inc., and The Reuben H. Donnelley Corporation were defendants, counterclaim plaintiffs, and appellants below.

Pursuant to this Court's Rule 29.1, petitioner notes that its parent is BellSouth Corporation. A list of BellSouth Corporation's non-wholly-owned subsidiaries appears at App. 115a.

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Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

PETITION FOR A WRIT OF CERTIORARI

Petitioner BellSouth Advertising & Publishing Corporation respectfully prays that a writ of certiorari issue to review the judgment and opinion of the en banc United States Court of Appeals for the Eleventh Circuit entered in the above captioned case on September 2, 1993.

OPINIONS BELOW

The en banc opinion of the United States Court of Appeals for the Eleventh Circuit is reported at 999 F.2d 1436 and is reprinted in the appendix hereto ("App.") at 1a.[1] The panel opinion reversed by the en banc court

[1] The appendices to the majority opinion could not be reproduced in legible fashion for inclusion in the petition. Pursuant to guidance from the Clerk's Office of this Court, the exhibits constituting the appendices to the opinions have been lodged with the Clerk.

is reported at 933 F.2d 952 and is reprinted at App. 52a. The opinion of the United States District Court for the Southern District of Florida is reported at 719 F. Supp. 1551 and is reprinted at App. 68a.

JURISDICTION

Petitioner BellSouth Advertising & Publishing Corporation initiated this case by filing a complaint for copyright infringement, trademark infringement, and unfair competition against respondents in the United States District Court for the Southern District of Florida on October 2, 1985. Jurisdiction was based on 28 U.S.C. § 1331. The District Court granted summary judgment for petitioner on its copyright claim on October 27, 1988, App. 68a, and on January 5, 1989, entered a negotiated injunction barring infringement by respondents. *Id.* at 109a.

Respondents filed a timely notice of appeal from the injunction, basing jurisdiction in the Court of Appeals for the Eleventh Circuit on 28 U.S.C. §§ 1291, 1292 (a)(1). That court affirmed the district court judgment on June 18, 1991. App. 52a. Seventeen months later, on November 4, 1992, the Court of Appeals granted respondents' suggestion for rehearing en banc. *Id.* at 107a. On September 2, 1993, the en banc court overturned the panel decision and reversed the district court judgment. *Id.* at 1a. Judge Hatchett filed a dissenting opinion. *Id.* at 19a.

The jurisdiction of this Court to review the judgment below is based on 28 U.S.C. § 1254(1).

PERTINENT CONSTITUTIONAL AND STATUTORY PROVISIONS

Article I, section 8, clause 8 of the United States Constitution, and the pertinent provisions of the Copyright Act of 1976, 17 U.S.C. §§ 101 *et seq.*, are set forth at App. 113a-114a.

STATEMENT OF THE CASE

Petitioner BellSouth Advertising & Publishing Corporation ("BAPCO"), a subsidiary of BellSouth Corporation, is the world's largest publisher of classified business directories, creating and distributing more than 44 million directories in 550 different editions annually. The issue in this case is whether respondents' admitted acts of copying BAPCO's 1984 Miami Yellow Pages directory infringed BAPCO's copyright in the directory. In deciding that these acts did not constitute infringement, the court below concluded that yellow pages publishers are not entitled to copyright protection for their selection, coordination, and arrangement of business listings under the classified headings they select for their directories, because the resulting compilation lacks the minimal degree of creativity necessary to qualify for copyright protection.

1. *Creation of BAPCO's Directory*

BAPCO produced the Miami Yellow Pages—"a typical yellow pages directory," App. 2a—in the same manner it produces its other yellow pages directories. First, Southern Bell, the local telephone service provider, transmits telephone service information to BAPCO. The information includes a business subscriber's name, telephone number, and address. *Id.* at 70a & n.4, 80a. In some cases the information also includes one business classification for the subscriber, but often—40 percent of the time in the case of the 1984 Miami Yellow Pages—no such classification is provided. Those classifications that are furnished often prove to be incorrect and have to be changed by BAPCO. Affidavit of Bob P. Johnson ("Johnson Aff."), at 2.

A number of editorial judgments by BAPCO guide the development of its directory. First, BAPCO limits listings to businesses using business telephone service. App. 80a. Many businesses, particularly service-oriented ones, oper-

ate out of a home and use residential telephone service for business needs. Many other publishers, such as the respondent in this case, will include listings for such businesses in their directories. BAPCO does not, based on its judgment that (1) businesses using merely residential service do not evince a sufficient commitment to remaining in the marketplace, and (2) the presence of obsolete entries in the directory contributes to user dissatisfaction.

A second editorial judgment affecting the compilation of BAPCO's yellow pages is its decision to provide one free listing for every business with business telephone service, but to insist on payment for additional listings under other categories ("Hair Stylist" as well as "Barber") or within the same category under a different name ("T. Jones Warehouse" as well as "Jones, T., Warehouse"). Johnson Aff., at 2, 4. Other publishers, such as the respondent in this case, offer more than one free listing, and prior to 1950 Southern Bell offered no free listings in its yellow pages.

BAPCO next decides on the geographic scope of each particular yellow pages directory.[2] This decision has two components: a determination of the general geographic boundaries of the directory, and judgments about which businesses outside those boundaries should nonetheless be contacted for possible inclusion. The scope of BAPCO's yellow pages directories—unlike that of a white pages directory—turns on BAPCO's evaluation of shopping patterns, and does not correspond to and is not dictated by the accompanying white pages.

After the general scope of a directory is established, BAPCO personnel make decisions about contacting certain businesses outside that area for possible inclusion. For example, in compiling the 1984 Miami Yellow Pages, BAPCO decided to contact certain businesses located out-

[2] The service information provided to BAPCO by Southern Bell is not sorted by geographical area. App. 80a.

side the Miami directory area—typically in Hollywood or Ft. Lauderdale—for inclusion in the Miami directory. Only selected businesses in such outlying areas were contacted. Sales people may, for example, call upon a swimming pool contractor located 30 miles outside the Miami area, reasoning that such a business might be interested in customers that far away, but would not call upon a shoe store next-door to the swimming pool contractor, judging it unlikely that such a listing would be useful to the store owner or consumers in the Miami area. The Miami Yellow Pages contained no fewer than 1,772 such listings from selected businesses outside the general geographic scope of the directory. *See* Johnson Aff., at 10-11. BAPCO also made the decision to solicit listings from national advertisers (*e.g.*, Hertz or American Airlines) for inclusion in specific directories. The Miami Yellow Pages contained 2,215 such listings. *Id.* at 11. Not all yellow pages directories include such national advertising.

BAPCO then determines the headings that will be used in its directory, from the familiar ("Attorneys") to the obscure ("Juice Extractors"). It also determines the subheadings to be included (*e.g.*, "Automobile, Plate, Window," "Beveled, Carved, Ornamental" and "Block—Structural" under "Glass"). BAPCO has developed a "Heading Book" which it uses in its publication efforts, *id.* at 7, but not all headings in the Heading Book are made available in every BAPCO yellow pages. BAPCO's list of appropriate headings is continually evolving, with hundreds of additions and deletions occurring each year after review by BAPCO's Heading Committee. Continuous revision is necessary because too many or too few headings would make the book less useful to the consumer and advertiser. Only BAPCO decides how many and which headings to offer in a particular BAPCO directory.

BAPCO's next step in compiling a yellow pages directory is to coordinate particular business listings with an appropriate heading classification or classifications. In

undertaking this task, BAPCO initially determines which businesses to contact and in which manner. BAPCO selects some businesses to be visited on their premises, others to be telephoned, and some not to be contacted at all. *Id.* at 5-6.

When contacting a business concerning its listings in the yellow pages, BAPCO personnel use their experience and expertise to develop with the customer a strategy for advertising through the yellow pages. *See id.* at 7-9. The decision on how to list a particular enterprise is seldom a mechanical one, instead involving judgments among related but quite distinct categories. It may well be unclear whether to list a particular business under "Grocers," "Delicatessens," or "Gourmet Shops," another under "Restaurants," "Sandwiches," or "Foods-Carryout," and yet another under "Loans," "Mortgages," or "Financial Planning." Using the authorized headings for the particular directory from the Heading Book and their accumulated experience, BAPCO personnel discuss additional listings with the customer. A business appearing under "Books" in its one free listing may be encouraged, if appropriate, to purchase an additional listing under "Magazines". A business appearing only under "Rental" may be alerted to the advantages of placing an additional listing under "Tents", if the BAPCO representative believes that tent rentals form or could form a significant part of that particular rental store's business.

In compiling its yellow pages BAPCO adheres to rules it has devised to ensure the integrity of the directory for its users. For example, businesses selling balloons often want to be listed under "Florists," in an effort to attract customers who might send a bouquet of balloons rather than flowers. A carryout sandwich shop may want to appear under "Pizza," in the hopes of attracting customers more interested in the fact that the food is take-out rather than of any particular variety. Even though a customer may request such an appearance, BAPCO policies do not

permit such practices, because they would cause confusion and reduce the utility of the directory. *See* 5SR-Tr. of Oct. 1985 Prel. Inj. Hearing, at 133-134.

The cumulated results of the foregoing decisions by BAPCO and the thousands of sales calls by BAPCO personnel on the businesses selected by them are then compiled and arranged to create a specific yellow pages directory.

2. *Copying of the Directory by Donnelley*

After release of the 1984 Miami Yellow Pages directory, respondents (collectively "Donnelley") undertook to publish their own directory in Miami. Although Donnelley had obtained a list of all business telephone subscribers from Southern Bell pursuant to a licensing agreement, App. at 71a—a list more current than the listings in BAPCO's 1984 directory—Donnelley did not rely on that list in launching its effort. Instead, it obtained a copy of BAPCO's copyrighted directory and, employing a data entry company, "keyed" the directory into a computer database. A keypunch operator input into a computer every listing in BAPCO's directory by name, address, telephone number, and classified heading code. *Id.* at 82a. The data base resulting from this activity was a copy of the BAPCO directory, excluding graphic advertising, in machine readable form. The computer then generated from this database what are known as "sales lead sheets". These sales lead sheets reproduced the keyed material from the BAPCO directory—every name, address, telephone number, and corresponding classified heading—arranged by telephone number. *Id.* at 3a, 83a. The sales lead sheets were used by Donnelley to solicit advertising for its directory, and the material from the database was used in the publication of the Donnelley directory. *Id.* at 3a-4a.

3. *The Proceedings Below*

BAPCO filed suit against Donnelley for, *inter alia*, copyright infringement, and the District Court granted

summary judgment in favor of BAPCO on its copyright claim. The court concluded that "BAPCO has created a unique directory due to its method of selecting, coordinating and arranging its material" and that "BAPCO's compilation is an original work of authorship which is subject to a valid copyright." *Id.* at 81a (footnote omitted). Noting that "Donnelley has offered no evidence to refute the fact that it copied BAPCO's directory," *id.* at 83a-84a, the District Court found Donnelley liable for three acts of copying: keying the material from BAPCO's directory into the computer, generating the sales lead sheets, and publishing the Donnelley directories. *Id.* at 84a.

Donnelley appealed to the Court of Appeals for the Eleventh Circuit, and a unanimous panel of that court affirmed. *Id.* at 52a. The panel considered the case in light of this Court's decision in *Feist Publications, Inc.* v. *Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282 (1991). In that case this Court determined that a telephone white pages directory was not entitled to copyright protection, because no creativity went into the selection of which listings to include in that directory (all subscribers) or how to arrange them (alphabetically). *Id.* at 1295-97. The panel below concluded that "[t]he format of the Yellow Pages before us is sufficiently distinct from the 'white pages' phone directory involved in *Feist* to meet the minimal level of independent creativity required to qualify as original." App. 59a. As the panel explained:

> If Donnelley had been interested only in the *information* contained in the directory, they could have extracted all the information that they needed from the list furnished to them by Southern Bell. Instead, Donnelley copied the formatted information from the Yellow Pages because they were interested in the format and organization of the information in the Yellow pages which was authored by BAPCO. [*Id.* at 62a.]

After rehearing en banc, the Eleventh Circuit overturned the unanimous panel opinion.[3] Writing for the majority, Judge Birch rejected the District Court's conclusion that BAPCO showed originality in selecting the scope for its directory, and concluded that the various acts of selection that the District Court and panel had found to be original were "not acts of authorship, but techniques for the discovery of facts." *Id.* at 8a. According to the majority, BAPCO simply "discovered" how businesses wished to be listed, and such activity was not protected by the Copyright Act. *Id.* at 8a-9a.

The en banc Eleventh Circuit ruled that BAPCO's coordination and arrangement of the particular listings under its selected headings also failed to exhibit the requisite degree of creativity, because this general structure "did not deviate from the arrangement of the typical business directory." *Id.* at 10a n.13. The majority further concluded that Donnelley had not copied the particular heading structure used by BAPCO, but instead "determine[ed] the type of business of each subscriber by observation of the BAPCO directory and translat[ed] that business type into an encoded heading of its own creation." *Id.* at 13a. The court also found that the selection of particular headings did not constitute original expression warranting copyright protection. *Id.* at 14a.

Judge Hatchett dissented. He began by noting that the majority's decision "establishes a rule of law that transforms the multi-billion dollar classified publishing industry from a business requiring the production of a useful di-

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[3] Due to recusals, only seven of the eleven Eleventh Circuit judges participated in the rehearing en banc. In addition, because the author of the panel opinion—Senior Circuit Judge Edward S. Smith—was a visiting judge from the Federal Circuit, and because another panel member—Circuit Judge Frank Johnson—took senior status while the suggestion for rehearing en banc was pending, only one of the three panel members participated in the rehearing en banc.

rectory based on multiple layers of creative decision-making, into a business requiring no more than a successful race to a data processing agency to copy another publisher's copyrighted work-product." *Id.* at 19a. He noted that the majority reached this "incredible result" by misinterpreting this Court's opinion in *Feist*, and by indulging "nothing more than its collective judgment of what ought to be copyrightable." *Id.*

Judge Hatchett found originality in BAPCO's choice of classified headings and in its arrangement of specific businesses under particular headings. *Id.* at 25a, 27a. As he explained, "it defies logic to conclude that BAPCO's grouping over 106,398 business listings from 32,559 different businesses, under approximately 7,000 [sic, 3,795] classified headings amounts to no more than mechanical grouping of data." *Id.* at 28a. Judge Hatchett also concluded that BAPCO's selection of only businesses with business telephone service was an act of selection contributing to the originality of the BAPCO yellow pages. Donnelley itself included other businesses in its directory, confirming that BAPCO's choice was hardly inevitable or mechanical. *Id.* at 31a-32a. Finally, the dissent found originality in BAPCO's selection of the geographic scope of the directory. *Id.* at 32a. The fact that BAPCO and Donnelley made different scoping decisions in this very case demonstrated that the choice was "not an 'obvious' act of selection." *Id.* at 34a (quoting *Feist*, 111 S. Ct. at 1297).

The dissent relied extensively on the Second Circuit's decision in *Key Publications, Inc.* v. *Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991), for the proposition that such activities involved sufficient creativity and originality to render a business directory copyrightable under *Feist*. Indeed, Judge Hatchett cited *Key Publications* for support no fewer than seven times. *See* App. 24a, 27a, 29a, 32a, 35a, 48a.

REASONS FOR GRANTING THE WRIT

This Court should grant certiorari to resolve the direct conflict between the decision of the Eleventh Circuit below and that of the Second Circuit in *Key Publications, Inc.* v. *Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991). The majority below construed this Court's decision in *Feist* as precluding compilation copyright protection for a yellow pages directory; the Second Circuit in *Key Publications* construed *Feist* as affording such protection. The question presented is important and recurring, because the manner in which BAPCO creates its yellow pages is similar to that employed by more than 100 yellow pages publishers around the country in annually compiling more than 5,800 different copyrighted yellow pages directories, and because Donnelley's method of copying BAPCO's directory is increasingly common throughout the industry.

Quite apart from the specific conflict with respect to yellow pages, the decision below also conflicts more generally with the approach of other Circuits to compilation copyright issues after *Feist*. In a wide range of areas—from video games to news footage services to maps—courts of appeals are being asked to re-examine copyright protection in the wake of *Feist*. Most courts of appeals have read *Feist* narrowly, acknowledging this Court's admonition that "the requisite level of creativity is extremely low" and that "the vast majority of compilations will pass this test." 111 S. Ct. at 1287, 1294. The Eleventh Circuit below took the opposite approach, transforming the inquiry into minimal creativity into a quite different test of novelty, and evaluating creativity on an element-by-element basis, rather than judging the compilation as a whole. The question presented is important and recurring not only with respect to yellow pages directories, but also with respect to these broader issues of copyright law. This Court should grant the writ to resolve this conflict and clarify the import of its decision in *Feist*.

I. THE DECISION BELOW CONFLICTS WITH A RECENT DECISION OF THE SECOND CIRCUIT

The decision below conflicts with the recent decision of the Second Circuit in *Key Publications, Inc.* v. *Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991). The court in that case held that a yellow pages directory for New York City's Chinese-American community was entitled to compilation copyright protection. Applying *Feist*, the Second Circuit began by noting that "[t]he requirement of originality * * * is not particularly rigorous. Simply stated, original means not copied, and exhibiting a minimal amount of creativity." *Id.* at 512-513. As the court emphasized, "for purposes of copyright, originality is not synonymous with novelty." *Id.* at 513.

Writing for the Second Circuit, Judge Winter explained that the publishers of the Chinese-American yellow pages exhibited the requisite degree of creativity and originality in the selection of which businesses to include in their directory. *Id.* Responding to the contention that the publishers "slavishly" included every business about which they had information, the court noted that the publishers excluded certain businesses they "did not think would remain open for very long," and that this "alone indicates thought and creativity in the selection of businesses included in the * * * Directory." *Id.*

The court also found the requisite originality in the arrangement of the directory. The court noted that "[t]he format of the * * * Directory is common to most classified directories," but reiterated that "[t]he lack of novelty is * * * not a bar to copyright protection." *Id.* at 514. The question instead was

> whether the arrangement of the * * * Directory, *viewed in the aggregate*, is original. We believe it is. The arrangement is in no sense mechanical, but involved creativity on the part of [the author] in

> deciding what categories to include and under what name. * * * This task entailed the de minimis thought needed to withstand the originality requirement. [*Id.* at 514 (emphasis added).]

The Second Circuit specifically contrasted the foregoing with the alphabetical arrangement of names at issue in *Feist*, which involved "nothing remotely creative." *Id.* (quoting *Feist*, 111 S. Ct. at 1297).[4]

The decision below stands in sharp contrast to the Second Circuit decision in *Key Publications*. The Second Circuit found a yellow pages directory copyrightable under *Feist* because of the acts of selection, coordination, and arrangement that went into compiling the directory; the Eleventh Circuit below held, also in reliance on *Feist*, that such acts did not give rise to copyright protection. While the Second Circuit found originality in the selection of businesses included in the directory, the court below dismissed such activity as involving "not acts of authorship, but techniques for the discovery of facts." App. 8a. Under the Eleventh Circuit's view, the publishers of the yellow pages in *Key Publications* simply "discovered" those businesses of interest to the Chinese-American community that were willing to be listed.[5]

Quite apart from the conflict on the issue of selection, the two Circuits are also in stark conflict on whether the

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[4] The court in *Key Publications* went on to rule that the authors of the rival directory had not infringed the copyright, because the arrangement in their directory "can hardly be described as even remotely similar to the arrangement utilized by the [protected directory]." 945 F.2d at 515.

[5] The cases cannot be distinguished on the ground that *Key Publications* involved a yellow pages for a particular ethnic community. That is clear from Judge Winter's conclusion in *Key Publications* that the decision to exclude certain businesses from the directory on the ground of their questionable longevity in the marketplace, standing alone, evinced the requisite creativity and originality. 945 F.2d at 513.

acts of arrangement and coordination that go into compiling a yellow pages directory are original within the meaning of the copyright laws. The Eleventh Circuit below concluded that "BAPCO's arrangement and coordination is 'entirely typical' for a business directory." App. 9a (quoting *Feist*, 111 S. Ct. at 1296).

> While the listings in BAPCO's yellow pages required somewhat more organization and arrangement than the white pages directory considered in *Feist*, BAPCO's claim of "originality" must be resolved by comparison to other business telephone directories. BAPCO did not deviate from the arrangement of the typical business directory, which employs an alphabetical list of headings to describe the various types of business and then alphabetizes the listings under the appropriate headings. [App. 9a-10a n.13.]

The Second Circuit, in sharp contrast, recognized that although "[t]he format of the * * * Directory is common to most classified directories, and particular categories have, of course, been used in other classified directories," this was not an impediment to copyright protection. A contrary approach would confuse originality with novelty, and, as Judge Winter explained, "[t]he lack of novelty is * * * not a bar to copyright protection." 945 F.2d at 514. The issue was not—as the Eleventh Circuit viewed it—whether anyone had ever thought of the business directory format before, but instead—as the Second Circuit viewed it—whether the particular arrangement, "viewed in the aggregate," was mechanical or rather "involved creativity * * * in deciding which categories to include and under what name." *Id.*[6]

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[6] The distinction between novelty and originality is the core distinction between patent and copyright protection. To be eligible for a patent, an inventor must show novelty—a new invention not previously conceived. A later inventor who independently creates the same invention will nonetheless not be entitled to a patent, because the invention is not novel. In contrast, to be eligible for copyright protection, an author need show only originality—that

Judge Hatchett's dissent highlights the conflict between *Key Publications* and the majority opinion below. The dissent repeatedly relied upon *Key Publications* in support of its explanation of why BAPCO's various acts of selection, coordination, and arrangement were sufficiently creative to constitute acts of authorship under the copyright laws. For example, the dissent cited *Key Publications* as being in accord with its view that BAPCO's choice of classified headings satisfied the originality requirement, noting the Second Circuit's holding that "a publisher's selection of 260 different categories, even if including particular categories that have been used in other directories, involved sufficient creativity to contribute to the overall originality of a classified directory." App. 25a. To cite another example, the dissent also relied on *Key Publications* for the proposition that BAPCO's "grouping 106,398 business listings under approximately 7,000 [sic, 3,795] classified headings, which BAPCO selected from a heading book containing 4,700 primary entries and 34,000 related headings," was hardly "mechanical" under *Feist*, noting the Second Circuit's parallel "holding that a classified publisher's grouping of over 9,000 listings into approximately 260 different categories constituted original arrangement entitled to copyright protection." *Id.* at 29a.[7]

Both the majority below and the Second Circuit in *Key Publications* relied on this Court's decision in *Feist* in reaching their conflicting conclusions. This is therefore

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he has not copied the work in question and that it displays minimal creativity. A later author who independently creates the same work is entitled to a copyright, because the later author's work—though not novel—is nonetheless original. *See Feist*, 111 S. Ct. at 1287-88.

[7] The conflict between the Second Circuit's opinion in *Key Publications* and the majority opinion below is also confirmed by the recent D.C. Circuit opinion in *Atari Games Corp.* v. *Oman*, 979 F.2d 242 (D.C. Cir. 1992) (R. B. Ginsburg, J.). In that case the D.C. Circuit described both *Key Publications* and the panel decision below as holding that a "yellow page telephone directory is copyrightable." 979 F.2d at 246. *See infra* at 22-24.

not a case in which the conflict among the Circuits can be explained away or minimized on the ground that the courts looked to different precedents, where the hope remains that the conflict can be reconciled in the future without intervention by this Court. Only this Court can resolve the conflict.

II. THE DECISION BELOW IS CONTRARY TO THIS COURT'S DECISION IN *FEIST*

The court below erred in its understanding of *Feist*. While the Eleventh Circuit denied copyright protection for BAPCO's directory because a "comparison to other business telephone directories" showed that "BAPCO did not deviate from the arrangement of the typical business directory," *id.* at 10a n.13, this Court in *Feist* emphasized that "[o]riginality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying." 111 S. Ct. at 1287.

This Court's analysis in *Feist* compels the conclusion that BAPCO's creative acts of authorship in compiling its directory were entitled to copyright protection. After explaining that only an "extremely low" and "minimal degree" of creativity was needed to meet the originality requirement, *id.*, this Court denied copyright protection for a white pages directory because the publisher of the directory "simply takes the data provided by its subscribers and lists it alphabetically by surname," a process "devoid of even the slightest trace of creativity." *Id.* at 1296. As the Court explained, the white pages contained simply "uncopyrightable facts" which "existed before [the publisher] reported them and would have continued to exist if [the publisher] had never published a telephone directory." *Id.* The publisher's "selection of listings could not be more obvious" and there was "nothing remotely creative about arranging names alphabetically in a white pages directory." *Id.* at 1296-97.

The opposite is true here. The selection of which listings to include in the yellow pages—in contrast to the white pages—is not obvious. It is not obvious to exclude businesses using residential telephone service, however much they want to be listed. Many classified directories do not draw such a distinction. It is not obvious to seek to include a swimming pool contractor located 30 miles outside the general area covered by the directory, but not a similarly located shoe store. That decision reflects an editorial judgment. It is not obvious to offer one free listing—rather than none or several—and the editorial decision to do so plainly affected the number of listings (paid and unpaid) appearing in BAPCO's directory as a whole.

BAPCO's decisions about which businesses to contact and in what manner were also not mechanical or obvious, and plainly affected the final product. For example, a decision to contact all general contractors to determine whether they would benefit from an additional listing under "Siding Contractors" would likely expand the listings in that area; a judgment not to contact painters about additional listings under "Paper Hangers" will limit growth of the listings under that heading. Donnelley copied the fruits of these editorial judgments when it copied the resulting listings from BAPCO's directory under "Siding Contractors" and "Paper Hangers." If it had compiled its own directory rather than copying BAPCO's, it may have made the opposite choice and come up with a work of authorship with more "Paper Hangers" and fewer "Siding Contractors" listings.

Nor was there anything obvious about selecting the thousands of headings available in BAPCO's yellow pages. *See Key Publications,* 945 F.2d at 513. The court below noted that "many of the selected headings, for example, 'Attorneys' or 'Banks,' represent such an obvious label * * * as to lack the requisite originality for copyright protection." App. 14a. But the question is the original-

ity of the work "as a whole," 17 U.S.C. § 101, and while "Attorneys" or "Banks" may be obvious headings, it is not obvious or mechanical to include headings for "Appliances-Household-Major-Dealers," "Appliances-Household-Small-Dealers," "Appliances-Household-Major Whol & Mfrs," and "Appliances-Household-Small Whol & Mfrs." While BAPCO chose to use these four headings in the 1984 Miami Yellow Pages, another publisher might choose to use only two—"Appliances-Household-Dealers," and "Appliances-Household-Whol & Mfrs"—another publisher six—"Appliances-Household-Major-Dealers," "Appliances-Household-Small-Dealers," "Appliances-Household-Major-Whol," "Appliances-Household-Major Mfrs," "Appliances-Household-Small Whol" and "Appliances-Household-Small Mfrs"—and yet another publisher only one—"Appliances-Household." Whichever choice is made results in a different arrangement or grouping of listings. Hundreds upon hundreds of similar decisions make the directories—"considered as a whole"—creatively original, even if every one contains headings for "Attorneys" and "Banks." [8]

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[8] The majority below sought to avoid the significance of BAPCO's creativity in selecting headings by concluding that Donnelley did not copy the particular hearing structure employed by BAPCO. App. 12a-13a. The majority's conclusion was based on a legal determination that Donnelley could escape liability for infringement on this score simply by associating the material copied from the BAPCO directory with corresponding Donnelley headings. *Id.* at 13a. But that in no way alters the fact that the BAPCO material was copied by Donnelley—it simply goes to what Donnelley did with the copied material. The majority itself acknowledged that Donnelley "admitted" that it "copied the * * * type of business from every BAPCO listing," *id.* at 18a n.23, and Donnelley stipulated that "[k]ind of business" was "obtained from the [BAPCO] Directory." 1SR1-8. *See* 5SR-Tr. of Oct. 1985 Prel. Inj. Hearing, at 140 (Donnelley counsel) ("I have stipulated that the keying people took from [BAPCO's] '84 directory the name, the address, the phone number, *the type of business* and the advertising unit") (emphasis added); Donnelley Answer, at 4, 7, 9 (admitting "heading" or "business classification" was "obtained" from BAPCO directory).

Nor was the arrangement of listings under the various headings a mechanical exercise "devoid of even the slightest trace of creativity." *Feist*, 111 S. Ct. at 1296. Name, address, and telephone number are objective *facts*; the characterization of a specific business is not. If a BAPCO sales person convinces a proprietor that he qualifies for and should purchase a listing as a hair stylist in addition to his free listing as a barber, that element in the directory—the listing of the shop as a hair stylist—is not a "fact" that "existed before" BAPCO engaged in its creative process of authorship. And the listing is not a "fact" that "would have continued to exist if [the publisher] had never published a telephone directory." *Feist*, 111 S. Ct. at 1296.[9] Different BAPCO personnel may make different recommendations as to where and how the same business should be listed, precisely because such judgments are not objective facts waiting to be discovered but creative acts of authorship.

There may be no creativity in deciding how to list J. Jones on Maple Street in the white pages; there is considerable creativity involved in deciding how to list a bakery with a sandwich counter that offers take-out. "Bakers-Retail," "Bagels," "Sandwiches," "Foods-Carry Out," "Wedding Supplies & Services," and "Delicatessens" are simply a few of the dozens of possible choices. J.

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[9] The majority below dismissed as insignificant the fact that Donnelley copied errors introduced into the yellow pages by BAPCO, App. 18a n.23, but Donnelley's actions refute the majority's contention that all Donnelley was copying were noncopyrightable facts. It is not a "fact" that the Fort Lauderdale News sells "Balancing Equipment." *See id.* at 83a n.23. Donnelley's replication of this erroneous listing in its book confirms that Donnelley was copying not facts but BAPCO's selection and arrangement of listings—no matter how fictitious. *See id.* at 47a (Hatchett, J., dissenting) ("Donnelley's assertion that it independently classified businesses using its own heading scheme is wholly unbelievable when one considers the statistical improbability of two publishers independently classifying the same newspaper as a 'Balancing Equipment' dealer").

Jones cannot decide that he would also like to be listed under the "Smiths" in the white pages, but that is precisely the sort of editorial judgments BAPCO makes in authoring its yellow pages directory: advising a toy store, if appropriate, to be listed under the categories for "Party Supplies" and/or "Novelties," as well as "Toys".

Even if the individual listings are considered to be facts, it is plain that BAPCO's grouping of the 106,398 listings in its 1984 Miami Yellow Pages was not obvious or mechanical. As this Court explained in *Feist*, a directory containing "only facts" nonetheless "meets the constitutional minimum for copyright protection if it features an original selection or arrangement." 111 S. Ct. at 1289. As the Copyright Act makes clear, the question is whether the "facts" are "selected, coordinated, or arranged in such a way that the resulting work *as a whole* constitutes an original work of authorship." 17 U.S.C. § 101 (emphasis added).

The white pages in *Feist* failed that test because the arrangement of the facts—even considered as a whole—was entirely predictable. That is not true of the grouping of the 106,398 listings in BAPCO's 1984 Miami Yellow Pages. That group of listings was in no sense pre-existing but instead was created only by the actions of BAPCO in compiling its directory.

In copying BAPCO's directory, Donnelley copied the results of these original acts of authorship as a whole, and not simply objective "facts" BAPCO had discovered. Indeed, as the panel below noted, Donnelley already possessed those elements of the directory that can be characterized as facts—names, addresses, and telephone numbers—pursuant to a licensing agreement with Southern Bell. Donnelley copied BAPCO's original selection, coordination, and arrangement of those facts not because that was the only or even the easiest way to gain access to the facts—indeed, the material from Southern Bell was more current than that in BAPCO's directory—but precisely because Donnelley wanted the benefit of BAPCO's

original and creative compilation of those facts. App. 61a-62a (panel opinion).

The court's error below is confirmed by its invocation of the "merger doctrine" to support its analysis. *See id.* at 10a-12a. The point of the merger doctrine is that if different authors undertake to express a particular idea, they will come up with the same way of expressing that idea. Protecting the authorship of that singular expression would therefore extend protection to the idea itself, contrary to basic principles of copyright law. It is easy to see how the analysis applies to a white pages directory. If different authors independently compile a white pages, their final products—assuming they perform the task well—will be the same. But that is not at all true with respect to a yellow pages directory. One author might arrange listings under headings for "Barbers," "Hair Styling," and "Beauty Salons;" another might simply include the listings under one "Hair Care" heading, or include subheadings for barbers, hair stylists, and beauty salons under the "Hair Care" heading. One approach is not objectively "better" than the other; they are simply different, and result in different "original work[s] of authorship" entitled to compilation copyright protection. 17 U.S.C. § 101.[10]

III. THE INTERPRETATION OF *FEIST* BY THE COURT BELOW CONFLICTS WITH THAT OF OTHER CIRCUITS

In a broad range of areas, defendants in copyright actions are relying on *Feist* to argue that compilations previously recognized as entitled to copyright protection are

[10] This Court in *Feist* also noted that the white pages directory before it may also have failed the originality requirement because the local telephone company was required by state law to publish such a directory as part of its monopoly franchise. 111 S.Ct. at 1296-97. Here no law or regulation of any kind required BAPCO (or the telephone company, for that matter) to create and publish a yellow pages directory. The decision to do so, and the myriad decisions concerning how to go about doing so, were BAPCO's alone.

no longer protected. Most courts of appeals reject such contentions as an overreading of *Feist*'s limited holding, finding that the minimal creativity requirement is satisfied except in those rare instances where a particular selection, coordination, or arrangement of facts is "practically inevitable" or "mechanical." *Feist*, 111 S. Ct. at 1296, 1297. These decisions—unlike the decision below—provide the protection that is critical to the continued viability of industries that create and market factual compilations. The existence of these competing interpretations confirms the need for this Court to address the important issues left unresolved in *Feist*: namely, what type of creativity is required for a factual compilation to receive copyright protection, and how is that creativity to be measured?

For example, in *Atari Games Corporation* v. *Oman*, 979 F.2d 242 (D.C. Cir. 1992), the D.C. Circuit held that the Register of Copyrights abused his discretion in refusing to register a copyright to the video game "Breakout." The Register had rejected the copyright registration application on the grounds that the video game portrayed geometric shapes and colors that were not themselves copyrightable, and that there was "no original authorship in either the selection or arrangement of the images or their components." *Id.* at 243 (quoting Letter Ruling). The D.C. Circuit agreed that the individual graphic elements of the game were not copyrightable, but—relying on *Feist*, *Key Publications*, and the panel decision below—concluded that the selection and arrangement of the shapes taken as a whole satisfied the creativity requirement. *Id.* at 245-246.

In her opinion for the court, then-Judge Ginsburg criticized the Register for focusing on the individual elements rather than on the work as a whole, and for insisting that the selection and arrangement of the elements be "distinctive" and "unique" to qualify for copyright protection. *Id.* at 246. Noting that the issue before her was analo-

gous to the compilation copyright issue in *Feist*, Judge Ginsburg explained that there were no such requirements for copyright protection, and that "Breakout" evinced the "minimal creative spark" required for protection because the assemblage of the graphic shapes was not entirely mechanical. *Id.* at 245-247 (quoting *Feist*, 111 S. Ct. at 1297).

Judge Ginsburg noted that "*Feist* and decisions applying *Feist* confirm[ed]" that " 'distinctive' or 'unique' qualities were [not] requirements for protection." 979 F.2d at 246. The "decisions applying *Feist*" cited by Judge Ginsburg included the Second Circuit's decision in *Key Publications* and the panel decision below,[11] and Judge Ginsburg described each of these decisions as holding that a "yellow page telephone directory is copyrightable." *Id.* at 246.

The Eleventh Circuit took an opposite tack, similar to the approach of the Register of Copyrights that the *Atari Games* court rejected. Like the Register and unlike the D.C. Circuit, the majority below focused on the individual elements of the yellow pages—business names, addresses, and telephone numbers—rather than BAPCO's selection and arrangement of those elements in the directory as a whole. The court below ruled that BAPCO's directory was not original because it "did not deviate from the arrangement of the typical business directory," App. 10a n.13, while the D.C. Circuit emphasized that there were no " 'distinctive' or 'unique' * * * requirements for protection" under the copyright laws. 979 F.2d at 246. The fact that the D.C. Circuit cited not only *Feist* but also the panel opinion below and *Key Publications* for this proposition confirms the conflict between the D.C. Circuit's approach in *Atari Games* and the approach of the en banc majority below, as well as the conflict between

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[11] The other case cited, *Kregos* v. *Associated Press*, 937 F.2d 700 (2d Cir. 1991), is discussed *infra* at 24.

Key Publications and the en banc Eleventh Circuit. *See id.*

The D.C. Circuit is not alone in its deviation from the approach adopted by the court below. The Second Circuit in *Kregos* v. *Associated Press*, 937 F.2d 700 (2d Cir. 1991)—in line with its later decision in *Key Publications*—upheld the copyrightability of a "pitching form" consisting solely of a selection of nine categories of baseball statistics. Even though eight of the plaintiff's categories had appeared in competing pitching forms, the court held that the plaintiff could demonstrate the " 'minimal level of creativity' " required under *Feist* in his selection of the particular categories to include in his form. *Id.* at 703-705 (quoting *Feist*, 111 S. Ct. at 1294). As the court explained, even if there had been only twenty possible pitching statistics, and a selector were limited to choosing nine, there would be more than 167,000 possible combinations. 937 F.2d at 704 n.3. The myriad decisions that go into compiling and arranging a yellow pages directory result in a limitless number of distinctive yellow pages possibilities.[12]

In *Harper House, Inc.* v. *Thomas Nelson, Inc.*, 1993 WL 346546 (9th Cir. Sep. 10, 1993), *prior opinion*, 889 F.2d 197 (9th Cir. 1989), the Ninth Circuit considered whether an "organizer" was entitled to copyright protection as a compilation. In a pre-*Feist* opinion, the court held that although the different elements that went into the plaintiff's organizers were not copyrightable, "the organizers' selection, coordination, and arrangement are protectable." 889 F.2d at 204, 205. As the Ninth Circuit explained, "[a] copyrightable compilation can consist

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[12] On remand, the district court in *Kregos* granted summary judgment for the defendant, concluding that the defendant's competing pitching form—which relied on ten statistics, four of which were different from the plaintiff's—did not infringe plaintiff's copyright. 795 F. Supp. 1325 (S.D.N.Y. 1992). On September 1, 1993, the Second Circuit affirmed. 3 F.3d 656.

mainly or entirely of uncopyrightable elements." *Id.* at 204.

On remand the district court granted summary judgment for the defendants, but the Ninth Circuit—applying *Feist*—recently reversed. The court of appeals reiterated its earlier holding that "[e]ven though the individual pages of [plaintiff's] organizers were not copyrightable, * * * [the] organizers were still within the subject matter of copyright, protectable as compilations." 1993 WL 346546 at *1. Contrary to the district court, the court of appeals found "the inclusion of additional sections and some limited reshuffling of sections in defendants' organizer insufficient to take [the infringement] issue out of the hands of the jury." *Id.* at *2.

Contrary to the Eleventh Circuit in this case, these courts upheld the copyrights at issue precisely because of the plaintiffs' creative decisions in selecting, coordinating, and arranging the relevant facts, notwithstanding that there were other works utilizing the same general format, and notwithstanding the non-copyrightability of the various elements comprising the compilation. By contrast, under the decision below, a compilation may not receive copyright protection whenever there are other compilations using the same basic format—regardless of the author's selection, coordination, or arrangement within that format. Few compilations, if any, would meet that stringent standard. Such a result is contrary to this Court's ruling in *Feist* that "[t]he vast majority of works make the grade quite easily." 111 S. Ct. at 1287.[13]

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[13] BAPCO has been informed that the defendant in *Harper House* and the plaintiff in *Kregos* intend to file petitions for certiorari with this Court to review the judgments in those cases. While BAPCO believes that both *Harper House* and *Kregos* correctly decided the issues of copyrightability presented in those cases, the petitions for certiorari underscore the conflict in the Circuits that has arisen after *Feist*, confirm that the issue is important and recurring, and demonstrate the need for this Court to resolve the conflict over the meaning of its decision.

Nor are the issues raised by this case limited to compilations of textual material. In *Los Angeles News Service* v. *Tullo*, 973 F.2d 791 (9th Cir. 1992), for example, the Ninth Circuit held that "raw" videotape of news events (film footage without commentary) was entitled to copyright protection because of the "intellectual and creative input" entailed in deciding what events to film and how to position the camera. *Id.* at 794. The court rejected the defendant's reliance on *Feist*, noting this Court's admonition that "the 'requisite level of creativity is extremely low.'" *Id.* at 794-795 (quoting *Feist*, 111 S. Ct. at 1287).

To cite another example, the Fifth Circuit in *Mason* v. *Montgomery Data, Inc.*, 967 F.2d 135 (5th Cir. 1992), held that a map was copyrightable in light of the mapmaker's originality and creativity in deciding what information to include and how to depict it. *Id.* at 141-142. The court of appeals rejected the defendant's reliance on *Feist*, explaining that while "bare facts are never copyrightable 'because facts do not owe their origin to an act of authorship.'" a compilation "may be copyrightable if the author made choices as to 'which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers.'" *Id.* at 141 (quoting *Feist*, 111 S. Ct. at 1288-89).[14]

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[14] To similar effect is *Nester's Map & Guide Corp.* v. *Hagstrom Map Co.*, 796 F. Supp. 729 (E.D.N.Y. 1992). In that case the court, applying *Feist* and *Key Publications*, found sufficient originality and creativity in a map guide for New York City taxi drivers. The court based its ruling on the publisher's selection of which street address listings to include on its map and which destinations to include on a mileage list. *See* David B. Wolf, *Is There Any Copyright Protection for Maps After* Feist?, 39 J. Copyright Soc'y USA 224 (1992). *See also Penelope* v. *Brown*, 792 F. Supp. 132, 135 (D. Mass. 1992) (author's selection and arrangement of preexisting statements of others constituted original, copyrightable subject matter).

Unlike the District of Columbia, Second, Ninth, and Fifth Circuits, the Eleventh Circuit below did not adopt an appropriately limited reading of *Feist*. It instead concluded that the very sort of acts of selection and arrangement viewed by the other Circuits applying *Feist* as warranting copyright protection did not meet the *Feist* standard. This Court should grant the writ to resolve this conflict among the Circuits on the meaning of *Feist*.[15]

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[15] The conflicting analyses employed by the courts of appeals in post-*Feist* cases have not escaped the notice of commentators, who have pointed to the lack of clear direction from *Feist* on the standard for determining whether certain factual compilations meet the requisite standard of creative originality. *See, e.g.*, Howard B. Abrams, *Originality and Creativity in Copyright Law*, 55 Law & Contemp. Probs. 3, 15 (1992) (*Feist* does not promulgate a definition or test for determining whether creativity requirement has been met); Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information After* Feist *v.* Rural Telephone, 92 Colum. L. Rev. 338, 343 (1992) ("The *Feist* opinion is more explicit in describing what is not original than in delineating what is"); John P. McDonald, *The Search for Certainty*, 17 U. Dayton L. Rev. 521, 522 (1992) (changes in copyright doctrine made by *Feist* have created a "conceptual void that needs to be filled"); Philip H. Miller, *Life After* Feist: *Facts, the First Amendment and the Copyright Status of Automated Databases*, 60 Fordham L. Rev. 507, 516 (1991) (*Feist*'s failure to provide explicit guidelines for evaluating whether a compilation satisfies the originality requirement will make it difficult for lower courts to make this determination with any degree of consistency); Alfred C. Yen, *The Legacy of* Feist: *Consequences of the Weak Connection Between Copyright and the Economics of Public Goods*, 52 Ohio St. L. J. 1343, 1376 & n.149 (1991) (noting inconsistency in analytical approaches by lower courts attempting to construe *Feist*); Russ VerSteeg, *Rethinking Originality*, 34 Wm. & Mary L. Rev. 801, 823 (1993) (the Court in *Feist* "did not define 'creativity' in any manner other than by default" and "neglected to articulate a standard"); Ralph Oman, Register of Copyrights, *Reflections on the Changing Shape of Database Protection*, 40 Fed. Bar News & J. 232, 234 (1993) ("Certainly, many directories and related compilations will leap the low originality hurdle described in *Feist* and enjoy protection under copyright. However, *Feist* may generate new uncertainties around the application of the 1976 [Copyright] Act to databases").

IV. THE QUESTION PRESENTED IS IMPORTANT AND RECURRING

As Judge Hatchett noted, the decision below—if allowed to stand—will transform the basic nature of "the multi-billion dollar classified publishing industry." App. 19a. The reason the decision has such broad impact is that, as the majority below recognized, it concerns "a typical yellow pages directory," *id.* at 2a, and the way BAPCO compiled the directory is similar to the way the other operating telephone companies compile their yellow pages directories across the Nation. By the same token, Donnelley's manner of copying is widely prevalent. *See* Affidavit of Gary R. Johnson, ¶ 11. The case is thus a test case for the nature of copyright protection for yellow pages in general. The impact of the decision below on this specific industry alone is reason enough to grant certiorari.

As explained above, however, the impact of the Eleventh Circuit decision cannot be confined to the classified directory industry. The misreading of *Feist* by the majority below calls into serious question the validity of copyright protection across the entire spectrum of compilation works: photographs, maps, charts, databases, news services, and the like. This Court should grant the writ to resolve the conflict not only between the Eleventh and Second Circuits on the copyrightability of yellow pages directories, but also between the Eleventh Circuit and the various other Circuits that have read *Feist* far more narrowly as not precluding copyright protection for other types of compilations.

The present case is an ideal vehicle for resolving the conflict among the Circuits and deciding this important question of copyright law. First, the decision below is in no sense fact-specific. The en banc majority reached its decision that BAPCO's directory was not entitled to copyright protection "as a matter of law." App. 15a. What is at issue is not simply an application of law to particu-

lar facts, but instead, as Judge Hatchett explained, the "establish[ment] [of] a rule of law." *Id.* at 19a.

Second, the legal issues have been fully aired. The Court has the benefit in this case of considered published opinions not only by the district court and a panel of the court of appeals, but by the en banc majority and dissent as well.

Third, the court below specifically considered the conflicting authority, and nonetheless elected to adhere to its position. When it granted rehearing en banc, the Eleventh Circuit directed counsel to address certain decisions from other courts of appeals—including the Second Circuit's decisions in *Key Publications* and *Kregos*. Counsel also alerted the court to the more recent decision of the D.C. Circuit in *Atari Games*. *See* En Banc Brief of Appellee at 40-42. Judge Hatchett's extensive reliance on *Key Publications* in his dissent also ensured its consideration by the majority.

Nor is this a case in which the Court can leave it to Congress to resolve the conflict in the state of the law. As this Court explained in *Feist*, the originality requirement in the Copyright Act tracks the originality requirement discerned by this Court in the Constitution. *See* 111 S. Ct. at 1288, 1290-94. The en banc majority was, therefore, necessarily deciding not only that Congress did not but could not extend copyright protection to directories like BAPCO's. Only this Court can correct the erroneous decision below.

Finally, this is not a situation in which the Court should allow the issue to "percolate" further in the lower courts. Such forbearance may be appropriate when there is a reasonable prospect that the conflict will work itself out as new arguments are raised and considered. There is no likelihood of that here. The Eleventh Circuit expressly considered the Second Circuit's view in *Key Publications* and declined to follow it, though Judge Hatchett did in

dissent. Additional decisions hold no promise of further sharpening the pertinent legal issues, and, in the meantime, "the multi-billion dollar classified publishing industry," App. 19a (Hatchett, J., dissenting), would remain in deep confusion concerning the applicable copyright rules.

CONCLUSION

For the foregoing reasons, this Court should grant the writ and reverse the decision below.

Respectfully submitted,

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APPENDICES

APPENDICES

APPENDIX A

UNITED STATES COURT OF APPEALS
ELEVENTH CIRCUIT

No. 89-5131

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,
Plaintiff-Counterclaim
Defendant-Appellee,

v.

DONNELLEY INFORMATION PUBLISHING, INC. and
THE REUBEN H. DONNELLEY CORP.,
Defendants-Counterclaim
Plaintiffs-Appellants,

BELLSOUTH CORPORATION, *et al.*,
Counterclaim Defendants.

Appeal from the United States District Court
for the Southern District of Florida

Sept. 2, 1993

Before TJOFLAT, Chief Judge, FAY, HATCHETT, EDMONDSON, BIRCH, BLACK and CARNES, Circuit Judges*.

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* Honorable Phyllis A. Kravitch, Honorable R. Lanier Anderson, III, Honorable Emmett Ripley Cox and Honorable Joel F. Dubina did not participate in this decision.

BIRCH, Circuit Judge:

I. INTRODUCTION

In this appeal we must decide whether acts of copying infringed the compilation copyright registered in a "yellow pages" classified business directory. The parties have stipulated that the directory, which is a typical yellow pages directory, qualifies for compilation copyright protection. Thus, we are called upon to apply *Feist Publications, Inc. v. Rural Telephone Service Co.*, —— U.S. ——, 111 S.Ct. 1282, 113 L.Ed.2d 358 (1991), which addressed copyright protection for a "white pages" telephone directory, to resolve the infringement claims presented to us concerning a directory of a different color.

The pivotal issue in this case is whether that which was copied by the accused infringer was protected by the registered claim of compilation copyright. The parties agree that the only elements of a work entitled to compilation copyright protection are the selection, arrangement or coordination as they appear in the work as a whole. The parties dispute what elements of a classified directory constitute such selection, arrangement or coordination. Mindful that the protection afforded to a whole work by a compilation copyright is "thin," [1] the determination as to whether an infringement of a compilation copyright has occurred is particularly difficult where less than the entire work is copied.

II. BACKGROUND

BellSouth Advertising & Publishing Corp. ("BAPCO") is a wholly-owned subsidiary of BellSouth Corp. ("BellSouth") created for the purpose of preparing, publishing and distributing telephone directories. Using telephone listing information supplied by Southern Bell Telephone and Telegraph Co. ("Southern Bell"), another wholly-

[1] *Feist*, —— U.S. at ——, 111 S.Ct. at 1289.

owned subsidiary of BellSouth. BAPCO publishes a classified, "yellow pages," advertising directory for the Greater Miami area. The BAPCO directory is organized into an alphabetical list of business classifications. Each business-rate telephone service subscriber is listed in alphabetical order under one appropriate heading without charge. A subscriber may purchase cross listings under different business classifications or advertisements to appear along with its business listing.

After BAPCO published its 1984 directory for the Greater Miami area, Donnelley Information Publishing, Inc. and Reuben H. Donnelley Corp. (collectively "Donnelley") began promoting and selling classified advertisements to be placed in a competitive classified directory for the Greater Miami area. To generate a list of business telephone subscribers to be solicited for placement in its directory, Donnelley gave copies of BAPCO's directory to Appalachian Computer Services, Inc. ("ACS"), a data entry company. Donnelley first marked each listing in the BAPCO directory with one alphanumeric code indicating the size and type of advertisement purchased by the subscriber [2] and a similar code indicating the type of business represented by the BAPCO heading under which the listing appeared. ACS then created a computer data base containing, for each listing appearing in the BAPCO directory, the name, address, and telephone number of the subscriber, as well as the codes corresponding to business type and unit of advertising. From this data base, Donnelley printed sales lead sheets, listing this information for each subscriber, to be used to contact business telephone subscribers to sell advertisements and list-

[2] The code corresponding to the type of advertising appearing in the BAPCO directory indicated only the unit of advertising purchased. Donnelley did not record, nor was alleged to have recorded, information regarding the graphic appearance or page location of the advertising material, nor did it copy facts concerning individual businesses, such as product lines, services, hours of operation, contained in the advertisements themselves.

ings in the Donnelley directory. Relying on this information copied from the BAPCO directory. Donnelley ultimately prepared its own competitive directory for the Greater Miami area.

BAPCO sued Donnelley alleging copyright infringement,[3] trademark infringement, and unfair competition. After the district court denied BAPCO's motion for a preliminary injunction. Donnelley answered and counterclaimed against BAPCO, Southern Bell and BellSouth, alleging violations of federal antitrust law. On the copyright infringement claim, the district court granted summary judgment to BAPCO and denied Donnelley's motion seeking partial summary judgment in its favor,[4] 719 F. Supp. 1551.

The district court found, and Donnelley admitted, that BAPCO owned a valid compilation copyright in its classified directory. Donnelley stipulated that, in preparing its data base and sales lead sheets, it obtained from each listing in the BAPCO directory, the telephone number, name, address, kind of business, and unit of advertising for the listed subscriber. As further evidence of copying, the district court relied on affidavits and deposition testimony from Donnelley's representatives and the presence of a number of erroneous listings common to

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[3] BAPCO registered its claim of copyright (attached to this opinion as Appendix A) for the "entire text and compilation" of both volumes of its 1984 Miami yellow pages directory. R1-1-Ex. D. It was upon this registration that BAPCO initiated its action for infringement. *See* 17 U.S.C. § 411(a) (". . . no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with this title.").

[4] The district court granted BAPCO's motion for summary judgment on Donnelley's antitrust counterclaim, but denied BellSouth and Southern Bell's motion for summary judgment on the antitrust counterclaim. The only issue presented by this appeal is the district court's resolution of the copyright infringement claims.

the BAPCO and Donnelley directories. From the process by which Donnelley prepared its competitive yellow pages directory, the district court identified three acts of copying: (1) the entry of subscriber information into the computer data base by ACS; (2) the printout of sales lead sheets from this data base; and (3) the publication of Donnelley's directory. Based on these acts of copying, the court granted BAPCO's motion for summary judgment on its copyright infringement claims.[5] Donnelley appealed the district court's resolution of the parties' motions on the copyright claim.[6]

III. DISCUSSION

A. *Feist Publications* and the Requirement of Originality

In *Feist Publications*, the Supreme Court clarified the scope of copyright protection afforded to factual compilations. Rural Telephone Service Company ("Rural") claimed that Feist Publications, Inc. ("Feist") infringed Rural's copyright by using names and telephone number listings from Rural's white pages directory to compile its own white pages directory. Observing the inherent tension between the axiom of copyright law that facts are not copyrightable[7] and the principle that compilations of

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[5] In granting summary judgment in favor of BAPCO, the district court rejected, as a matter of law, Donnelley's fair use and antitrust, or misuse of copyright, affirmative defenses. Because we hold that summary judgment should have been granted in favor of Donnelley on BAPCO's copyright claim, we do not reach the issue of whether Donnelley's defenses were properly rejected on summary judgment.

[6] The judgment of the district court was affirmed by a panel of this court, but was subsequently vacated by a grant of rehearing en banc. *Bellsouth Adv. & Pub. Corp. v. Donnelley Inf. Pub., Inc.*, 933 F.2d 952 (11th Cir.1991), *vacated and reh'g en banc granted*, 977 F.2d 1435 (11th Cir.1992).

[7] *See* 17 U.S.C. § 102(b).

fact generally are copyrightable, the Court identified those components of a factual compilation that may, under certain circumstances, receive copyright protection. —— U.S. at ——, 111 S.Ct. at 1287.

The Court stressed that "[t]he *sine qua non* of copyright is originality." —— U.S. at ——, 111 S.Ct. at 1287.[8] "Facts, whether alone or as a part of a compilation, are not original and therefore may not be copyrighted." —— U.S. at ——, 111 S.Ct. at 1290. Drawing upon the requirement of originality and the definition of "compilation" in the Copyright Act,[9] the Court held that a compiler's selection, arrangement and coordination, if original, are the only protectable elements of a factual compilation. —— U.S. at ——, 111 S.Ct. at 1289.[10]

Applying the requirement of originality to the directory compiled by Rural, the Court noted that the listings, consisting of subscribers' names, towns of residence, and telephone numbers, were uncopyrightable facts. Further,

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[8] Moreover, "[o]riginality is a constitutional requirement" for copyright protection implicit in the grant of power to Congress to "secur[e] for limited Times to Authors . . . the exclusive Right to their respective Writings." *Feist*, —— U.S. at ——, 111 S.Ct. at 1288 (quoting U.S. Const. art. I, § 8, cl. 8).

[9] Section 101 of the Copyright Act of 1976 defines a compilation as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101.

[10] In confirming originality as the focus of copyright protection, the Court rejected an alternative theory to justify the protection of factual compilations. Relying upon a doctrine known alternatively as "sweat of the brow" or "industrious collection," some courts had extended copyright protection to every element of a factual compilation based on the labor expended by the author in compiling the constituent facts. By extending copyright protection in a compilation beyond the author's original selection, arrangement, and coordination, this line of cases "eschewed the most fundamental axiom of copyright law—that no one may copyright facts or ideas." —— U.S. at ——, 111 S.Ct. at 1291.

the selection, coordination, and arrangement of Rural's white pages were not sufficiently original to merit copyright protection. "Rural's selection of listings could not be more obvious: it publishes the most basic information—name, town, and telephone number—about each person who applies to it for telephone service." —— U.S. at ——, 111 S.Ct. at 1296. Rural failed to establish any original elements of coordination or arrangement: "there is nothing remotely creative about arranging names alphabetically in a white pages directory. It is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course." —— U.S. at ——, 111 S.Ct. at 1297. In short, "Rural expended sufficient effort to make the white pages directory useful, but insufficient creativity to make it original." —— U.S. at ——, 111 S.Ct. at 1296.

B. BAPCO's Claim of Infringement

To establish its claim of copyright infringement, BAPCO must prove "(1) ownership of a valid copyright, and (2) copying of constitutional elements of the work that are original." —— U.S. at ——, 111 S.Ct. at 1296. The validity of BAPCO's copyright in its directory, considered as a whole, was conceded by Donnelley.[11] To demonstrate the second element of infringement, BAPCO must prove that Donnelley, by taking the material it copied from the BAPCO directory, appropriated BAPCO's *original* selection, coordination or arrangement.

The district court found that BAPCO engaged in a number of acts of selection in compiling its listings. For example, BAPCO determined the geographic scope of its directory and the closing date after which no changes in listings would be included. *BellSouth Adv. & Pub. Corp. v. Donnelley Inf. Pub., Inc.*, 719 F.Supp. 1551, 1557-58 (S.D.Fla.1988). The district court erred, however, in

[11] Because of the parties' concession, we do not consider whether BAPCO's yellow pages directory, taken as a whole, is copyrightable.

implicitly determining that these selective acts were sufficiently original to merit copyright protection. Rural obviously established a geographic scope and a closing date for its white pages, which were held uncopyrightable as a matter of law in *Feist*. The district court's analysis would protect such factual elements of every compilation; any collection of facts "fixed in any tangible medium of expression" [12] will by necessity have a closing date and, where applicable, a geographic limit selected by the compiler. The district court found that BAPCO "selected" its listings by requiring its yellow pages subscribers to use business telephone service. *Id.* at 1557. The district court also focused on a number of marketing techniques employed by BAPCO to generate its listings, such as the determination of the number of free listings offered to each subscriber, the selection of which customers to contact by an on premise visit from sales personnel, the selection of the date of commencement of its advertisement sales campaign, and the procedure used to recommend the purchase of listings under multiple headings. *Id.* at 1557. The district court again failed to consider whether these "acts of selection" met the level of originality required to extend the protection of copyright to BAPCO's selection.

More fundamental, these acts are not acts of authorship, but techniques for the discovery of facts. In *Feist*, the Court emphasized the distinction "between creation and discovery: the first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence." —— U.S. at ——, 111 S.Ct. at 1288. By employing its sales strategies, BAPCO discovered that certain subscribers describe their businesses in a particular fashion and were willing to pay for a certain number of listings under certain available business descriptions. To be sure, BAPCO employed a set of strategies or techniques for discovering this data. Any

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[12] 17 U.S.C. § 102(a).

useful collection of facts, however, will be shaped by a number of decisions regarding the optimal manner in which to collect the pertinent data in the most efficient and accurate manner. If this were sufficient, then the protection of copyright would extend to census data, cited in *Feist* as a paradigmatic example of a work that lacks the requisite originality. —— U.S. at ——, 111 S.Ct. at 1288. Just as the Copyright Act does not protect "industrious collection," it affords no shelter to the resourceful, efficient, or creative collector. *See Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1372 (5th Cir. July 1981) ("The valuable distinction in copyright law between facts and the expression of facts cannot be maintained if research is held to be copyrightable."). The protection of copyright must inhere in a creatively original *selection* of facts to be reported and not in the creative means used to discover those facts. *See* 17 U.S.C. § 102 (b) ("In no case does copyright protection . . . extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work"). Ultimately, the district court erred by extending the protection of copyright to the collection of facts in the BAPCO directory based on the uncopyrightable formative acts used to generate those listings.

In addition to these acts of selection, the district court found that BAPCO engaged in feats of coordination and arrangement to generate its yellow pages directory. The court explains that BAPCO arranged its directory into an alphabetized list of business types, with individual businesses listed in alphabetical order under the applicable heading. The Copyright Act protects "original works of authorship." 17 U.S.C. § 102(a). BAPCO's arrangement and coordination is "entirely typical" for a business directory. *Feist*, —— U.S. at ——, 111 S.Ct. at 1296.[13]

[13] While the listings in BAPCO's yellow pages required somewhat more organization and arrangement than the white pages

With respect to business telephone directories, such an arrangement "is not only unoriginal, it is practically inevitable." —— U.S. at ——, 111 S.Ct. at 1297.

BAPCO's claim of copyright in the arrangement of its directory also does not survive application of the "merger" doctrine. Under the merger doctrine, "expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself." *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991).[14] *See also Baker v. Selden*,

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directory considered in *Feist*, BAPCO's claim of "originality" must be resolved by comparison to other business telephone directories. BAPCO did not deviate from the arrangement of the typical business directory, which employs an alphabetical list of headings to describe the various types of business and then alphabetizes the listings under the appropriate headings.

Applying *Feist*, the Second Circuit declined to extend copyright protection to the selection and arrangement of certain charts displaying the results of horse racing. *Victor Lalli Enters. v. Big Red Apple, Inc.*, 936 F.2d 671, 673-74 (2d Cir.1991). "The format of the charts is a convention: Lalli exercises neither selectivity in what he reports nor creativity in how he reports it." *Id.* at 673. Similarly, the Ninth Circuit rejected a claim that two automobile catalogs listing replacement radiators and associated parts were substantially similar. *Cooling Systems and Flexibles, Inc. v. Stuart Radiator*, 777 F.2d 485, 491 (9th Cir.1985). Although both works were arranged into three sections (an illustrations section, an original equipment manufacturer section, and an applications section), the court found that this arrangement was obligatory for a useful radiator parts catalog. "[T]he fewer the methods of expressing an idea, the more the allegedly infringing work must resemble the copyrighted work in order to establish substantial similarity." *Id.* at 491. A subsequent collector is not required to arrange its compilation in a fashion not usable by those for whom it is intended. *Id.* at 492. The format of a typical business telephone directory is even more obvious and well-established than the radiator catalogs at issue in *Cooling Systems*.

[14] *See Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1463-64 (5th Cir.) (applying merger doctrine where idea of locating pipeline along certain route was inseparable from

101 U.S. (11 Otto) 99, 25 L.Ed. 841 (1879). Because this is the one way to construct a useful business directory, the arrangement has "merged" with the idea of a business directory, and thus is uncopyrightable.[15]

The district court's suggestion that BAPCO could have arranged its headings according to the number of advertisers or to list its subscribers under each heading according to the length of time for which that subscriber had appeared under that heading misapprehends the ques-

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expression of the route on a topographical map), *cert. denied*, 498 U.S. 952, 111 S.Ct. 374, 112 L.Ed.2d 336 (1990). *See also Educational Testing Services v. Katzman*, 793 F.2d 533, 539 (3d Cir.1986); *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986).

[15] In *Matthew Bender & Co. v. Kluwer Law Book Publishers, Inc.*, 672 F.Supp. 107 (S.D.N.Y.1987), the court considered the application of the merger doctrine to a claim of copyright in a system of charts displaying information regarding the amount of recovery in previous personal injury cases. Both the plaintiff's work and that of the alleged infringer divided the cases into chapters corresponding to the part of the body injured and further divided the cases within each chapter based on whether the recovery was a result of a settlement, or an "adequate," "inadequate," or "excessive" award. 672 F.Supp. at 108. Both works listed the cases according to forum state, arranging awards from the same state from largest to smallest amount. In both collections, information regarding each case was organized into categories for amount, case name, plaintiff, event, injury, and further relevant data. The court rejected the plaintiff's claim of copyright, concluding that the plaintiff's work employed one of the few practical and useful means of organizing data regarding personal injury awards. The idea and the expression of such a work thus "merged." *Id.* at 109-110. Further, the information selected for display about each case was obvious and did not demonstrate the original selection, arrangement or coordination required for copyright protection. *Id.* at 112. *See also Coates-Freeman Assocs., Inc. v. Polaroid Corp.*, 792 F.Supp. 879, 883-84 (D.Mass.1992) (placement of decision-making steps on chart purporting to categorize leadership styles was not copyrightable feature where selection of those particular steps out of a universe of very limited options resulted in merger of any creativity into basic idea of chart).

tion. The relevant inquiry is not whether there is some imaginable, although manifestly less useful, method of arranging business telephone listings. In *Feist,* Rural could have published multiple directories for its service area or listed its numbers in numerical order, by age, or by neighborhood within a single directory. The pertinent inquiry is whether the compiler has demonstrated originality, the *"sine qua non"* of copyright, in *its* arrangement or coordination. The arrangement of BAPCO's yellow pages, like that of Rural's white pages is "entirely typical" of its respective type.

The district court also identified acts of coordination and arrangement in the particular system of headings used in the BAPCO directory. The district court appears to find that, when Donnelley entered the listing information from the BAPCO directory, it also copied the particular heading under which that listing appeared in the BAPCO directory. 719 F.Supp. at 1558-59.[16] BAPCO, however, failed to introduce evidence sufficient to establish a genuine dispute of material fact as to whether Donnelley copied the particular heading structure employed by BAPCO. Donnelley stipulated that it obtained the "business type" for each listing from the BAPCO directory. R1-8. The evidence submitted to the district court in the form of affidavit, deposition, and witness testimony reveals that Donnelley established its own system of headings and that, in constructing its data base, Donnelley en-

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[16] Significantly, BAPCO registered no claim of copyright in the glossary of terms used to describe the types of businesses represented by its listings. BAPCO claims that Donnelley infringed its putative copyright in its directory (the *only* claim of copyright before the court) by somehow copying the directory onto the sales lead sheets (Appendix B). This argument highlights the fundamental misconception of the nature and scope of a compilation copyright. A comparison of the Donnelley sales lead sheets and the BAPCO directory pages (Appendix C) manifests no substantial similarity as to those copyrightable elements of a compilation. The dissent continues to confuse and merge the copying of uncopyrightable data with the replication of the copyrightable elements of a compilation.

tered, with each BAPCO listing, an alphanumeric code that corresponded to the *Donnelley* heading. 5SR2, pp. 183-85; 1SR-434, pp. 76-77, 143-44; 1SR-435, pp. 253-54 and Ex. 278; Deposition of John Notestein, pp. 10, 12, 14-15, 22. Further, the sales lead sheets generated by Donnelley from its database, as well as pages of the respective directories submitted to the district court, illustrate that Donnelley selected a somewhat different category of headings to describe the listings originally appearing in the BAPCO directory.[17] Considering the extent to which the heading structure of a classified business directory is dictated by functional considerations and common industry practice, the differences apparent in the glossary of headings employed by Donnelley are sufficient to rebut any inference of copying that otherwise might be drawn from those terms that are common to both directories.[18] In sum, the evidence before the district court requires the conclusion that, by determining the type of business of each subscriber by observation of the BAPCO directory and translating that business type into an encoded heading of its own creation, Donnelley extracted uncopyrightable information regarding the business activities of BAPCO's subscribers without appropriating any arguably original, protectable expressive element in the BAPCO glossary of headings.

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[17] Despite the dissent's belief to the contrary, our opinion is based on the evidence that was before the district court, including a number of sales lead sheets (Appendix B) and pages from both directories (Appendix C).

[18] Where the form of expression is largely prescribed by functional constraints, the similarity of expression in a subsequent work must be very close in order to establish infringement. "Factual works are different [from works of fiction]. Subsequent authors wishing to express the ideas contained in a factual work often can choose from only a narrow range of expression. . . . Therefore, similarity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed." *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 488 (9th Cir.1984).

Further, BAPCO failed to present evidence that, even if copied, its heading structure constitutes original expression warranting copyright protection. Initially, many of the selected headings, for example "Attorneys" or "Banks," represent such an obvious label for the entities appearing under these headings as to lack the requisite originality for copyright protection.[19] BAPCO can claim no copyright in the idea of dividing churches by denomination or attorneys by area of speciality. Further, any expressive act in including a category such as "Banks" or in dividing "Attorneys" into categories such as "Bankruptcy" or "Criminal Law" would lose copyright protection because it would merge with the idea of listing such entities as a class of businesses in a business directory.[20] The evidence submitted by Donnelley also establishes that many of BAPCO's headings result from certain standard industry practices, such as the recommendations of the National Yellow Pages Sales Association, with regard to the selection and phrasing of headings in business directories. Finally, as established by the testimony of BAPCO's representatives, the ultimate appearance of a particular subscriber under a certain heading is determined by the subscriber's willingness to purchase those listings in the BAPCO directory. While BAPCO may select the headings that are *offered* to the subscriber, it is the subscriber who selects from those alternatives the headings under which the subscriber will appear in the copyrighted directory. The headings that actually appear in the directory thus, do not owe their origin to BAPCO and BAPCO has claimed no copyright in the

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[19] *See Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851, 854-55 (6th Cir.1991) (copyright law does not protect "forms of expression dictated solely by functional considerations").

[20] *See Matthew Bender*, 672 F.Supp. at 111 (Under merger doctrine, plaintiff could claim no copyright protection in headings used to display data regarding personal injury awards where "terms employed are the most logical and clear way of expressing the idea to be conveyed . . . . [and] these terms, or synonyms for them, are the only way of conveying the desired information.").

larger universe of headings that are offered to subscribers. Thus, the elements of selection, coordination and arrangement identified by the district court, and purportedly copied by Donnelley, as a matter of law, do not display the originality required to merit copyright protection.

Although purporting to consider whether Donnelley copied the original elements of selection, arrangement or coordination from the BAPCO directory, the opinion of the district court rests, at least in part, on a comparison of the appearance of corresponding pages from both directories.[21] For example, the court concluded that "Donnelley used a format nearly identical to that used by BAPCO" and that "although Donnelley's directory is not identical to BAPCO's directory, the material was copied and used to produce a directory substantially similar in both content and format." 719 F.Supp. at 1559. The district court erred, however, by failing to consider the degree to which the similarity between the two directories was due to Donnelley's use of the copyrightable facts, such as name, number, address, and business type, from the BAPCO directory. Further, to the extent that this similarity of format was due to the common arrangement and coordination of the two directories into alphabetized business classifications, with alphabetized listings under each classification, the district court erred by extending the scope of BAPCO's copyright to capture the system of organization common to all classified directories from the

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[21] A comparison of corresponding pages from the two directories, which were before the district court as set out in Appendix C, reveals several obvious differences in type-face and graphic layout. Donnelley included different advertisements, not only in content, but in number and design. BAPCO underlines its headings while Donnelley marks its headings with a sideways triangle. Donnelley uses a different type face. Whatever original authorship is represented by these types of presentation choices was clearly not copied by Donnelley. Further, the sales lead sheets (attached in Appendix B) produced from the ACS data base are obviously not similar in appearance or arrangement to BAPCO's directory, in which its claim of copyright was registered.

public domain. Moreover, the other elements of format common to the two directories, such as the organization of listings into four columns, are also manifestly typical, obvious and unoriginal.

By comparing the overall appearance of the two directories through its comparison of the corresponding pages, the district court effectively failed to consider whether Donnelley copied the "constituent elements of the work that are original." *Feist*, —— U.S. at ——, 111 S.Ct. at 1296. In the case of a factual compilation, a comparison of the copyright holder's work with that of the alleged infringer must distinguish similarities attributable to ideas, which are unprotected *per se*, or to expression not owned by the copyright holder, from those similarities resulting from the copying of the compiler's original elements.[22] We consider this conclusion to be compelled by section 103(b) of the Copyright Act, which directs that "[t]he copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material." 17 U.S.C. § 103(b).

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[22] The Second Circuit has observed:

> Although the test for infringement of original works and compilations is one of "substantial similarity," the appropriate inquiry is narrowed in the case of a compilation. As noted, the components of a compilation are generally in the public domain, and a finding of substantial similarity or even absolute identity as to matters in the public domain will not suffice to prove infringement. What must be shown is substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed compilation.

Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc., 945 F.2d 509, 514 (2nd Cir.1991) (citations omitted). *See also Cooling Systems*, 777 F.2d at 492-93 ("What is important is not whether there is substantial similarity in the total concept and feel of the works, but whether the very small amount of protectable expression in Cooling Systems' catalog is substantially similar to the equivalent portions of Stuart's catalog.") (citation omitted).

We note that Donnelley did not copy, nor was alleged to have copied, the text or graphic material from the advertisements in the BAPCO directory, the positioning of these advertisements, the typefaces, or the textual material included by BAPCO to assist the user. Unlike the infringer in *Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers*, 756 F.2d 801 (11th Cir.1985), Donnelley did not photocopy, or reproduce by any equivalent means, the page by page arrangement or appearance of its competitor's directory in the process of creating its own work. Although the amount of material taken from the BAPCO directory was substantial in a purely quantitative sense, Donnelley did not, by this process, appropriate whatever original elements might arguably inhere in the BAPCO directory. That a competitor might take the bulk of the factual material from a preexisting compilation without infringement of the author's copyright is not surprising, given that the copyright protection of a factual compilation is "thin." *Feist*, —— U.S. at ——, 111 S.Ct. at 1289. It may seem unfair that a compiler's labor may be used by a competitor without compensation. As noted by the Court in *Feist*, "[t]he primary objective of copyright is not to reward the labor of authors, but '[t]o promote the Progress of Science and useful Arts." —— U.S. at ——, 111 S.Ct. at 1290 (quoting U.S. Const. art. I, § 8, cl. 8). "To this end, copyright assures authors the right to their *original* expression, but encourages others to build freely upon the ideas and information conveyed by a work." *Id.* (emphasis added). *See also Harper & Row, Publishers v. Nation Enterprises*, 471 U.S. 539, 545-46, 105 S.Ct. 2218, 2223, 85 L.Ed.2d 588 (1985).

IV. CONCLUSION

By copying the name, address, telephone number, business type, and unit of advertisement purchased for each listing in the BAPCO directory,[23] Donnelley copied no original element of selection, coordination or arrangement; Donnelley was thus entitled to summary judgment on BAPCO's claim of copyright infringement.[24] We REVERSE the judgment of the district court granting summary judgment to BAPCO on its claim of copyright infringement and enter judgment in favor of Donnelley on this claim.

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[23] The common errors in the BAPCO and Donnelley listings prove only that, as admitted, Donnelley copied the name, number, address, and type of business from every BAPCO listing. The presence of common errors is not probative of whether the portions of the BAPCO directory copied by Donnelley included the copyrightable elements of original selection, coordination and arrangement. In *Feist*, the alleged infringer copied every listing from the compilers' white pages, including four erroneous listings. —— U.S. at ——, 111 S.Ct. at 1287. Because Rural copied only uncopyrightable facts, however, the presence of common errors was not relevant. *See also* Shira Perlmutter, "The Scope of Copyright in Telephone Directories: Keeping Listing Information in the Public Domain," 38 J. Copyright Society 1, 5-6 (Fall 1990) ("Where, as in *Feist*, the defendant has admitted copying, such evidence is simply irrelevant. Copying of erroneous or fictitious entries has no bearing on the question of whether material admittedly copied is protected by the plaintiff's copyright, and if so, whether the taking is substantial."); Alan Latman, "Probative Similarity as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement," 90 Columbia L.Rev. 1187, 1204-06 (1990) (distinguishing use of common errors as proof of copying from use as proof of substantial similarity of protected material).

[24] Summary judgment in favor of the defendant in an infringement action is appropriate where the similarity between the two works concerns only uncopyrightable elements of the plaintiff's work. *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1072 (2d Cir. 1992); *Warner Bros., Inc. v. American Broadcasting Cos.*, 720 F.2d 231, 240 (2d Cir.1983).

HATCHETT, Circuit Judge, Dissenting:

The majority's holding establishes a rule of law that transforms the multi-billion dollar classified publishing industry from a business requiring the production of a useful directory based on multiple layers of creative decisionmaking, into a business requiring no more than a successful race to a data processing agency to copy another publisher's copyrighted work-product. In reaching this incredible result, the majority forsakes thoughtful analysis of the evidence under the governing principles articulated in *Feist,* and leaps to a conclusion based on nothing more than its collective judgment of what ought to be copyrightable.

Not only does the majority ignore the evidence presented in the district court, but it also allows the appellant to obtain an outright reversal of the district court with new arguments and supplemental evidence that the district court never considered. In doing so, the majority transforms this en banc appellate court into no more than a multiple judge trial court that allows unsuccessful litigants to have the proverbial 'second bite at the apple.' I cannot join the majority in its disregard for the well-established parameters of appellate review; thus, I respectfully dissent.[1]

DISCUSSION

In order to prevail on a claim of copyright infringement, a plaintiff must prove two elements: (1) that the plaintiff owns a valid copyright in the work; and (2) that the defendant copied "constituent elements of the work that are original." *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, —— U.S. ——, ——, 111 S.Ct. 1282, 1296, 113 L.Ed.2d 358, 379 (1991). Donnelley Information Publishing, Inc. and Reuben H. Donnelley Corporation (collectively "Donnelley") concedes

[1] During the discussion of the evidence presented to the district court, I will also discuss the evidence presented and the new theories advanced at the "en banc trial."

that Bellsouth Advertising & Publishing Corporation ("BAPCO") possesses a valid compilation copyright in the *1984 Greater Miami Yellow Pages (1984 Yellow Pages)*, taken as a whole. Donnelley also stipulated that it copied the following information from the *1984 Yellow Pages* in preparing its "sales lead" sheets: "1. telephone number—under the first column; 2. name—under the second column; 3. address—under the third column; 4. kind of business—under the fourth column; and 5. unit of advertising—under the fifth column." Therefore, based on Donnelley's concessions that BAPCO possesses a valid copyright and its stipulation to copying information from the *1984 Yellow Pages*, this court is only asked to determine whether Donnelley substantially copied constituent elements of the *1984 Yellow Pages* that are original.

I. *Copyrightability of Compilations*

It is settled that compilations of facts are copyrightable, even though the facts themselves are not subject to copyright protection. *Feist Publications*, —— U.S. at ——, 111 S.Ct. at 1287, 113 L.Ed.2d at 368 (discussing the inherent tension between these well-established propositions). The Copyright Act of 1976 defines a copyrightable compilation as "a work formed by the collection and assembly of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101 (1988). Therefore, section 101 identifies three requirements for a compilation to qualify for copyright protection: "(1) the collection and assembly of preexisting material, facts, or data; (2) the selection, coordination, or arrangement of those materials; and (3) the creation, by virtue of the particular selection, coordination, or arrangement, of an 'original' work of authorship." *Feist*, —— U.S. at ——, 111 S.Ct. at 1293, 113 L.Ed.2d at 376.

The Court in *Feist* noted that the "selection, coordination, or arrangement" requirement is the key to determin-

ing whether a work qualifies as a copyrightable compilation. *See Feist,* —— U.S. at ——, 111 S.Ct. at 1294, 113 L.Ed.2d at 377 (explaining that "facts are never original, so the compilation author can claim originality, if at all, only in the way that the facts are presented"). The Court in *Feist* emphasized that "the originality requirement is not particularly stringent." *See Feist,* —— U.S. at ——, 111 S.Ct. at 1294, 113 L.Ed.2d at 377 (explaining that originality means only that a compiler selects or arranges independently and displays some minimal level of creativity, even if the compiler settles upon a selection or arrangement that others have used). In addition, the Court in *Feist* noted that a copyrightable compilation is protected only to the extent of the author's "original" selection, coordination, or arrangement. *See Feist,* —— U.S. at ——, 111 S.Ct. at 1295, 113 L.Ed.2d at 378. Accordingly, this court must first determine what particular elements of BAPCO's selection, coordination, and arrangements of preexisting facts in the *1984 Yellow Pages* are sufficiently original to merit copyright protection.

II. *Original Selection, Coordination, or Arrangement*

Based on the undisputed facts, the district court concluded that BAPCO performed the following acts of selection, coordination, or arrangement, which were sufficiently original to merit copyright protection: (1) the selection of the geographic scope of businesses to be covered in the directory; (2) the selection of the number of free listings for businesses in the covered area; (3) the selection of only businesses with business telephone service for advertisements in the directory; (4) the selection of a menu of classified headings that would be available for business listings; (5) the selection of the criteria for determining whether a business may advertise under a particular classified heading; (6) the selection of the classified headings that would be recommended to a particular

business customer; (7) the selection of customers who would receive on-premise sales contact, telephone sales contact, or no contact; (8) the selection of the dates for the beginning and closing of the sales campaign for advertisements in the directory; and (9) the arrangement of all of the business listings under a particular heading, in alphabetical order. *See BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 719 F.Supp. 1551, 1557-58 (S.D.Fla.1988).

The panel agreed that the *1984 Yellow Pages* constituted a copyrightable compilation, identifying the following acts of selection, coordination, or arrangement as sufficiently original: (1) selection of the geographic scope of businesses to be included in the directory; (2) selection of a directory close date as a limit on modifications that would be reflected in a pending directory publication; (3) the creation or selection of numerous classified headings that would be available for business listings; (4) the coordination of all the informational components—name, address, and telephone number—of a particular business into one complete business listing; and (5) the arrangement of all coordinated business listings under the appropriate classified headings. *See Bellsouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 933 F.2d 952, 957-58 (11th Cir. 1991), *vacated and reh'g en banc granted*, 977 F.2d 1435 (11th Cir. 1992).

Donnelley challenges the district court's and panel's holding that BAPCO performed sufficiently original acts of selection, coordination, or arrangement to merit copyright protection for the *1984 Yellow Pages*. Donnelley argues that the district court erred in identifying BAPCO's alphabetizing of the listings and classified headings as contributing to the originality of the directory. Donnelley also argues that the district court erred in characterizing BAPCO's decisions to offer one free listing, to include

only business telephone service subscribers, and decisions on soliciting advertisements as acts of selection "fixed" in the *1984 Yellow Pages,* as opposed to invisible business decisions. In addition, Donnelley argues that the panel erred in identifying BAPCO's coordination of the informational components—name, address, and telephone number—of a particular business as an original act of coordination. Moreover, Donnelley argues that both the district court and the panel erred in identifying BAPCO's selection of a geographic scope, selection of classified headings, and arrangement of all business listings under a particular classified heading as "original" acts of selection or arrangement.

BAPCO responds that the district court and panel correctly concluded that BAPCO's acts of selection, coordination, or arrangement were sufficiently original to be copyrightable. BAPCO analogizes the so-called "business decisions" with the techniques that a photographer uses in taking a picture. As the techniques of the photographer affect the photograph, BAPCO argues that the published *1984 Yellow Pages* would have been completely different if BAPCO had selected a different geographic scope, permitted residential telephone service subscribers to be listed, chosen a different closing date, elected not to provide a free listing, changed its available menu of classified headings, engaged in different marketing efforts to sell business listings, excluded businesses listings from nearby communities such as Fort Lauderdale, excluded listings of national businesses, or permitted arrangements between the available classified headings and business listings.

Donnelley is correct to assert that the holding in *Feist* precludes this court from concluding that BAPCO satisfied the originality requirement based on the mere alphabetizing of business listings and classified headings, or based on the mere coordination of the name, address, and telephone number of a particular business into one com-

plete business listing. *See Feist,* —— U.S. at ——, 111 S.Ct. at 1297, 113 L.Ed.2d at 380-81 (holding that a telephone company's white pages lack the requisite originality for copyright protection where the telephone company merely published basic subscriber information—name, town, and telephone number—and arranged it alphabetically based on surnames).

Donnelley is also correct to assert that the district court erred in characterizing BAPCO's decision to offer one free listing and decisions on the dates and procedures for soliciting advertisements as original acts of "selection." "Selection implies the exercise of judgment in choosing which facts from a given body of data to include in a compilation." *Key Publications v. Chinatown Today Publishing Enterprises, Inc.,* 945 F.2d 509, 513 (2d Cir. 1991) (citations omitted). BAPCO's decisions regarding a free listing and solicitation procedures did not entail the exercise of judgment in choosing among facts to be included in its directories. "Selection" is not an appropriate term to describe the choices to include *all* of the data in a given body of data, on a given date. Instead of acts of selection, these BAPCO's decisions are more closely analogous to ideas or procedures for reliably and profitably collecting facts. As ideas or procedures, BAPCO's decision to offer a free listing and its decisions regarding soliciting advertisements, are not copyrightable. *See* 17 U.S.C. § 102(b) (providing that no copyright protection for an original work of authorship extends to any "idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work").

However, even ignoring these erroneously identified acts of selection, coordination, or arrangement, BAPCO's other acts of selection and arrangement in compiling the *1984 Yellow Pages* were sufficient originality to merit copyright protection under *Feist.*

A. *Selection of Classified Headings*

The clearest example of BAPCO's original selection is its choice of the classified headings that would be included in the *1984 Yellow Pages. Accord Key Publications,* 945 F.2d at 514 (holding that a publisher's selection of 260 different categories, even if including particular categories that have been used in other directories, involved sufficient creativity to contribute to the overall originality of a classified directory). BAPCO selected the approximate 7,000 classified heading in the *1984 Yellow Pages* from the 4,700 primary headings and approximately 34,000 related headings in the BAPCO headings book. BAPCO presented the undisputed testimony of Gerald Brown that the BAPCO headings book is not standardized to coincide with the menu of classified headings used in National Yellow Page Sales Association (NYPSA) publications. Moreover, even if BAPCO's selection of classified headings is similar to other NYPSA publications, it would still be copyrightable under *Feist* so long as BAPCO selected independently. *See Feist,* —— U.S. at ——, 111 S.Ct. at 1287, 113 L.Ed.2d at 369 (holding that "originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying").[2]

In addition, the testimony of Donnelley's own witness supports the district court's conclusion that BAPCO's selection of headings constituted an original act of selection. Donnelley's corporate representative, Jon Notestein, responded to a question about whether Donnelley created its headings especially for the Donnelley Miami directory, with the following statement: "What we have learned in this business after 99 years is that individual markets may

[2] In reasoning that BAPCO's selection of headings lack originality because many resemble NYPSA headings, the majority completely ignores the *Feist* Court's holding that an independent selection of data need not be "novel" in order to be deemed original. See Majority Slip op. at p. 3097.

have local terminology that reflect differently in different parts of the country. So, yes, I'm sure we have created some headings, classifications to represent types of business that we didn't normally use in Donnelley in the Mid-west, for example." *See Deposition of Jon Notestein*, p. 50. In further describing the process of particularizing headings for a specific directory, Notestein explained that Donnelley maintains a list of over 7,000 headings that are generally applied across the country, but "in the end the type of business appears in our directory is a reflection of the marketing and needs of the market and users of the product. It is an ongoing process changing every day." *See* Deposition of Jon Notestein, p. 51 (also stating that Donnelley probably selected its headings for Miami from "looking at" the *1984 Yellow Pages*).

On appeal, Donnelley appears to concede that copyright protection extends to a publisher's selection of which headings to include in a particular classified directory, arguing instead that it did not copy BAPCO's selection of classified headings. Donnelley asserts that its *1985 Miami North* directory contains approximately 4,000 headings and that its *1985 Miami South* directory contains approximately 4,300 headings, as compared to the 7,000 headings in BAPCO's *1984 Yellow Pages*. Even though more relevant to the separate issue of substantial copying, Donnelley's assertion that it independently selected a substantially smaller and distinct "universe" of classified headings underscores the originality, and thus copyrightability of BAPCO's selection of headings.[3]

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[3] In reaching its over-broad conclusion that none of BAPCO's selection, coordination, or arrangement is copyrightable, the majority merges the issues of originality and substantial copying. In doing so, the majority allows Donnelley to defeat BAPCO's claim of original selection, the first issue before this court, based on new evidence presented for the first time on appeal that relates mainly to the second, substantial similarity issue. Regarding the substantial similarity issue, the majority concludes that Donnelley presented

B. *Categorizing Businesses Under Classified Headings*

The originality of BAPCO's arrangement of business listings under a particular classified heading is also clear under the standard definition of "arrangement" in the copyright laws. "Arrangement 'refers to the ordering or grouping of data into lists or categories that go beyond the mere mechanical grouping of data as such, for example, the alphabetical, chronological, or sequential listings of data.'" *Key Publications*, 945 F.2d at 513-14 (quoting Copyright Office, *Guidelines for Registration of Fact-Based Compilations 1* (Rev. Oct. 11, 1989)). In this case, BAPCO presented the undisputed affidavit testimony of its General Manager-Publishing, Bob Johnson, regarding BAPCO's grouping of listings under a particular classified heading. *See* Exhibit A to Donnelley's En Banc Brief (copy of *Affidavit of Bob Johnson*). Because most business subscribers offer multiple product lines, goods, and services, Johnson testified that BAPCO sales representatives were responsible for itemizing the products or services of a business subscriber, determining the degree of importance or profitability to the business, and recommending an appropriate classified heading for listing the business in the *1984 Yellow Pages*. Johnson further testified that BAPCO annually updates and publishes

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evidence showing that it "established its own system of headings." The majority relies on citations to the record that Donnelley uses in support of its new assertion that it selected "a smaller universe" of classified headings. *See* Majority Slip op. at 3096-97. The majority's reliance on these citations is misplaced for two reasons. First, as BAPCO argues, none of Donnelley's citations actually support the "smaller universe" assertion. *See* BAPCO En Banc Brief at p. 3 (compiling all portions of the record that Donnelley cites as "Exhibit 2"). Moreover, as discussed fully in section III-A, the relevant question is whether Donnelley proved that it selected a menu of classified headings for particular use in compiling its South Florida directories, *not* whether Donnelley entered codes corresponding to a general universe of headings in the Donnelley heading book.

its heading book in order to provide sales representatives with a quick-reference of the approximately 34,000 authorized BAPCO "related headings" for making recommendations to businesses about additional listings.

Moreover, Johnson's statements about the skill and judgment that BAPCO sales representatives exercise in recommending appropriate related headings is supported in the statistics that he provided about the *1984 Yellow Pages*. Johnson testified that the resulting *1984 Yellow Pages* included 56,459 free business listings and 49,939 paid listings from a total of 32,559 local, foreign, and national business subscribers. These statistics on total listings and advertisers highlight the fundamental error in the majority's conclusion that BAPCO's grouping of business listings under classified hearings is not an original act of arrangement. Using Donnelley's figure of approximately 7,000 classified headings in the *1984 Yellow Pages*, it defies logic to conclude that BAPCO's grouping of over 106,398 business listings from 32,559 different businesses, under approximately 7,000 classified hearings amounts to no more than mechanical grouping of data. The numbers alone indicate that BAPCO had numerous options for grouping the 106,398 listings among the 7,000 classified headings.

Beyond statistics, however, BAPCO presented the district court with conclusive evidence concerning the originality of its groupings of business listings under classified headings. BAPCO attached to Johnson's affidavit a sample page from its heading book, which includes the primary heading of "Bakers-Retail" and related headings including "Biscuits," "Cakes," "Pastries," "Bagels," "Candy & Confectionery," "Caterers," "Cookies & Crackers," "Delicatessens," "Donuts," "Food Products," "Foods-Carry Out," "Grocers-Retail," "Health & Diet Food Products-Retail," "Pies," "Pretzels," "Restaurants," "Sandwiches," "Snack Products," "Wedding Supplies & Serv-

ices." Although some primary entries on the sample page contain less related headings than the "Bakers-Retail" example, other primary headings contain more related heading options. Hence, the "Bakers-Retail" example provides a representative illustration of the wide-ranging choices that BAPCO sales representatives made in categorizing the 32,559 businesses under the appropriate related headings from the approximately 34,000 options in the heading book. With so many related headings to describe a business principally known as a bakery, BAPCO's arrangement of the listing of a particular bakery under one, two, three, four, or more headings is neither "obvious" nor "practically inevitable" as defined in *Feist*. *See Feist*, —— U.S. at ——, 111 S.Ct. at 1297, 113 L.Ed.2d at 380. Accordingly, the evidence is clear that BAPCO's arrangement was in no sense mechanical. On the contrary, the *1984 Yellow Pages* reflects several layers of BAPCO choices on grouping 106,398 business listings under approximately 7,000 classified headings, which BAPCO selected from a heading book containing 4,700 primary entries and 34,000 related headings. *Accord Key Publications*, 945 F.2d at 514 (holding that a classified publisher's grouping of over 9,000 listings into approximately 260 different categories constituted original arrangement entitled to copyright protection).

Donnelley challenges BAPCO's evidence of an original arrangement with repeated assertions that the businesses themselves, not BAPCO, selected the appropriate classified heading or headings with which to describe their businesses. In its reply brief to the panel, Donnelley conceded that if BAPCO supported its "belated allegation that *BAPCO* selects the headings, there would result a material issue of fact, making summary judgment improper on the issue of infringement." Donnelley Panel Reply Brief at p. 13. The evidence before the district court not only supports BAPCO's so-called "belated allegation," but the only evidence presented to the district court conclusively

establishes that BAPCO makes the final decisions on whether to list a business under a particular classified heading.[4]

Donnelley does not point to any independent evidence that it presented on the issue, but relies on testimony that it elicited from BAPCO's General Manager-Directory, Gerald Brown, during the October, 1985, preliminary injunction hearing. Specifically, Donnelley relies on Brown's statements that customers generally select additional classified headings in the course of a sales presentation by a BAPCO employee, and his statement that the owner of Havana Welding made the decision to be listed under ten different headings, including "Exporter," with the guidance of a BAPCO sales person. Based on Brown's testimony about a business owner's role and the fact that business owners pay BAPCO for the additional listings, Donnelley argues that "it defies logic to even suppose that [businesses] would leave to a directory publisher any discretion to decide what business they are in."

Donnelley's argument completely ignores the undisputed evidence that BAPCO presented on the editorial role of its Heading Committee in arranging business listings under a particular classified heading.[5] In addition to discussing the role of a BAPCO sales representative in recommending related headings to businesses, Gerald Brown testified via deposition that BAPCO's Heading Committee had the final responsibility for deciding whether a requested classified heading was appropriate for inclusion in the

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[4] The majority summarily concludes that "it is the subscriber who selects" a particular classified heading without any discussion of BAPCO's evidence on this issue. *See* Majority Slip op. at p. 3098.

[5] The majority blindly accepts Donnelley's argument that BAPCO surrenders ultimate editorial authority to advertisers without any consideration of BAPCO's obvious need to maintain final editorial discretion in order to protect the integrity and accuracy of its compilation.

1984 Yellow Pages. Brown further testified that a business's willingness to pay for a listing under a particular classified heading did not influence the Heading Committee's decision on whether to approve the proposed new heading. Moreover, during the October, 1985, preliminary injunction hearing, Brown responded to questions about whether BAPCO allowed businesses to make final decisions on a particular heading based on their willingness to pay for the advertisement. In response to a question on redirect, Brown testified that BAPCO would not allow businesses to select classified headings under a particular category that is totally incorrect, responding to the extreme example of a butcher who asked to be listed as a plumber. *See* 5SR2-4, p. 133. On recross-examination, Brown responded to a more subtle example stating that BAPCO would allow a butcher to be listed as a delicatessen only if the butcher was in fact a delicatessen, regardless of the butcher's willingness to pay for a full-page ad under the "Delicatessen" heading. *See* 5SR2-4, pp. 133-34. Donnelley fails to point to any evidence contradicting Brown's testimony regarding the final editorial authority of the Heading Committee on whether a business would be grouped under a particular classified heading.

Therefore, the uncontroverted testimony in this case proves that BAPCO performed an original act of arrangement in deciding how to group appropriately the 106,398 business listings from 32,559 businesses, under the approximate 7,000 classified headings in the *1984 Yellow Pages.*

C. *Selection of Only Businesses with Business Telephone Service*

BAPCO's selection of only businesses with business telephone service, as opposed to residential service, is also an act of selection contributing to the originality of the *1984 Yellow Pages.* As noted earlier, selection involves "the exercise of judgment in choosing which facts from a

given body of data to include in a compilation." *See Key Publications,* 945 F.2d at 513. BAPCO exercised such judgment in choosing only business service subscribers from the body of data including both business and residential subscribers for inclusion in the *1984 Yellow Pages.* The originality is BAPCO's choice is amply demonstrated in the fact that Donnelley, unlike BAPCO, would accept listings and advertising from residential telephone service subscribers in addition to business telephone service subscribers. For example, the Assistant Vice-President and General Manager of the Southeast Operation of Donnelley Information Publishing, Louis Sudholz, testified about the disparate treatment of a hypothetical prospective customer, "John, the painter." Sudholz testified that Donnelley, unlike BAPCO, would include "John, the painter" in its directory, regardless of Donnelley's discovery that John does not have a business telephone and operates out of a shed in his backyard. *See* 5SR2-4, pp. 194-95. Based on the different choices of two competing classified publishers, it is clear that BAPCO's selection of only businesses with business telephone service represents an exercise of judgment that is in no sense automatic or dictated by functional considerations. Hence, the record also supports the district court's holding that BAPCO's selection of only business telephone subscribers for inclusion in its *1984 Yellow Pages* constitutes an original act of selection contributing to the copyrightability of its compilation.

D. *Selection of a Geographic Area to be Covered Comprehensively*

Although a closer question, BAPCO's geographic scoping also represents an original act of selection. BAPCO asserts that its selection of a geographic scope refers to a choice about what geographic region would be covered comprehensively in the *1984 Yellow Pages.* BAPCO argues that its selection of a geographic area is not determined simply based on the scope of a white-page directory for the same community, but is instead selected based

on BAPCO's evaluation of the shopping habits and desired shopping areas of consumers within a white-pages community. Donnelley responds that geographic scoping merely refers to BAPCO's decision about the geographic area for free distribution of copies of its *1984 Yellow Pages*. Donnelley further asserts that BAPCO did not, in fact, limit advertisements in its directory to businesses in a particular area. Based on Bob Johnson's affidavit testimony that the *1984 Yellow Pages* contains advertisements from 1,772 businesses in nearby cities and from 2,215 national businesses, the evidence supports Donnelley's assertion that BAPCO did not limit classified listings to only businesses in a certain geographic area. Johnson's testimony also demonstrates that BAPCO solicited, not selected, the advertisements from national businesses and businesses in nearby cities. However, the fact that BAPCO did not limit its *1984 Yellow Pages* exclusively to greater Miami businesses does not dispose of the issue, because BAPCO's claim of copyrightability is based on its selection of *an area*, not individual businesses, to be covered comprehensively, not exclusively.

The evidence before the district court supports its conclusion that geographic scoping is an original act of selection. Besides BAPCO's evidence, Donnelley presented evidence on the uniqueness of its different scoping choice to cover the greater Miami area in two North and South Miami regions. In addition, Donnelley elicited testimony from Louis Sudholz on Donnelley's decision to cover the geographic region between Dallas and Fort Worth in a "Mid-City" directory. Based on such evidence of how classified publishers could easily select geographic regions that do not strictly follow the boundaries of cities, it is clear that the selection of a geographic region is not "practically inevitable." *See Feist*, —— U.S. at ——, 111 S.Ct. at 1297, 113 L.Ed.2d at 380 (recognizing that the alphabetizing of names in a white pages is an age-old practice that is unoriginal and practically inevitable).

The evidence before the district court also compels a conclusion that the geographic scoping of a classified directory is not an "obvious" act of selection. *See Feist*, —— U.S. at ——, 111 S.Ct. at 1297, 113 L.Ed.2d at 380 (describing a white-page publisher's selection of basic information—name, town, and telephone number—as "obvious" and lacking sufficient creativity to make it original). On this point, BAPCO presented "Donnelley Directory Publishing Start-Up Business Plan October 21, 1984," which discussed Donnelley's own geographic scoping decisions as being based on "extensive research [leading Donnelley] to scope differently from its competitors." *See* 6SR12-34, *Volume IV—Appendix to Summary Memorandum of Bellsouth Advertising & Publishing Corporation*, p.DM207045 (stating that Donnelley generally will scope to cover areas of two or more telco directories, and stating that "more logical scoping is intended to be a key selling point for [Donnelley]"). Therefore, even though Donnelley now argues that geographic scoping represents an obvious decision lacking a modicum of creativity, the evidence before the district court was uncontroverted that geographic scoping results from thoughtful analysis of research on shopping habits and analysis of how to distinguish one directory from its competitors.[6] Such thoughtful selection is sufficient under *Feist* to contribute to the originality of the *1984 Yellow Pages*. *See Feist*, —— U.S. at ——, 111 S.Ct. at 1294, 113 L.Ed.2d at 377

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[6] The majority reaches the conclusion that geographic scoping is an obvious and inevitable act of selection based on cursory analysis that analogizes the geographic scoping involved in classified directories to the scoping of white pages. However, as the majority points out, this case concerns a "directory of a different color." That distinction requires this court to thoroughly analyze the evidence under the *Feist* principles. Instead of such analysis, the majority's holding appears to be based on the mistaken notion that deciding copyright cases requires no more than an application of the collective common sense of judges.

(explaining that "the originality requirement is not particularly stringent").

In sum, the record on this case demonstrates that BAPCO performed at least four original acts of selection and arrangement: (1) the selection of 7,000 classified headings; (2) the arrangement of 106,398 business listings, from 32,559 businesses under the 7,000 classified headings; (3) the selection of only businesses with business telephone service, as opposed to businesses having either business service or residential service; and (4) the selection of a geographic area to be covered comprehensively in the *1984 Yellow Pages.* Accordingly, I would hold that BAPCO performed four acts of selection or arrangement which are sufficiently original to merit copyright protection. The analysis of BAPCO's infringement claim, however, does not end with a finding of originality. This court must next determine whether Donnelley copied those constituent elements of selection and arrangement which are copyrightable.

III. *Substantial Copying of BAPCO's Original Selection or Arrangement*

Because the copyright in a factual compilation is "thin," a plaintiff must prove "substantial similarity" between the defendant's compilation and the original elements of the plaintiff's compilation. *Key Publications,* 945 F.2d at 514 (adopting the "substantial similarity" test for infringement, and rejecting arguments that *Feist* requires a subsequent compiler to produce an "exact replica" of the copyrighted compilation); *see also* Majority Opinion at n. 21 (citing favorably the *Key Publications* test); *Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers,* 756 F.2d 801, 810-11 (11th Cir.1985) (applying the "substantially similarity" test). Therefore, in order for BAPCO to prevail on its infringement claim, it must prove that Donnelley substantially appropriated the particular elements of selection or arrangement that are orig-

inal. Based on the previous discussion identifying those elements of selection or arrangement that are copyrightable, BAPCO must prove that Donnelley substantially appropriated BAPCO's selection of classified headings, arrangement of business listings under classified headings, selection of only businesses with business telephone service, or selection of a geographic area to be covered comprehensively.

A proper analysis of whether Donnelley substantially appropriated BAPCO's original selection or arrangement requires this court to analyze separately each of the three acts of copying at issue in this case. The district court concluded that Donnelley engaged in the following three acts of copying: (1) hiring Appalachian Computer Services, Inc. (Appalachian), a data entry company in London, Kentucky, to key BAPCO's compilation into a computer database; (2) using the computer database to print out sales lead sheets that represented a reproduction of substantially the entire *1984 Yellow Pages* in inverted or crisscross form; and (3) publishing the *1985 Miami North* and *1985 Miami South* directories based on the information copied into the computer database and onto the sales lead sheets. *See BellSouth*, 719 F.Supp. at 1558-59. Similarly, this court should evaluate each alleged act of copying separately.[7]

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[7] The majority not only merges its analysis of the originality and the substantial similarity issues, as previously noted, the majority also intertwines its slight discussion of Donnelley's first two alleged acts of copying, the computer database and sales lead sheets, with its exhaustive discussion of the lack of similarity between the actual published directories. The majority's focus on the distinguishable features of Donnelley's published directories, with only slight mention of the computer database and sales lead sheets, is not consistent with the development of facts in this case. That is, Donnelley's alleged copying of BAPCO's compilation into the computer database and onto the sales lead sheets occurred before BAPCO filed this action putting Donnelley on notice. Donnelley's actual publication of the 1985 Miami North and 1985 Miami South

A. *Computer Database*

Donnelley does not dispute that it obtained copies of the *1984 Yellow Pages*, separated and mounted each sheet individually, and assigned a classified heading code, advertising code, and directory code for every business listing. It is also undisputed that Appalachian keyed the following information into a computer database: name, address, telephone number, code corresponding to a classified heading, code corresponding to the unit of advertising, and a code for the directory from which the listing came. Appalachian stored this information on magnetic tape and sent it to Donnelley for reproduction in the form of sales lead sheets. The only factual dispute concerning the creation of the computer database derives from Donnelley's assertion that Appalachian entered a code corresponding to a previously chosen Donnelley classified heading, as opposed to a code corresponding to the BAPCO heading directly next to each code.

The record support's Donnelley's version of the alleged factual dispute. Several Donnelley employees testified that Appalachian keyed-in heading codes that corresponded to headings in a Donnelley heading book. For example, Gary Johnson explained that

> if we found a heading on our database that had a heading code which was similar or the same meaning as the BAPCO heading, we used our heading, the Donnelley support file heading. We didn't directly copy the heading from the BAPCO book. We used our heading. This heading code is a Donnelley heading code that applies to a support file, mechanized support file, that we maintain in Terre Haute [, Indiana, a Donnelley Publishing Center].

Directories occurred *after* BAPCO filed this action and after the district court denied BAPCO's motion for a preliminary injunction. Hence, it is not at all surprising that Donnelley's published directories contain a number of distinguishable features.

Deposition of Gary Johnson, at p. 143. Johnson further testified that he sent Appalachian a "Donnelley heading book" and "asked Appalachian to use [the Donnelley heading book] and find alike [sic] or similar, in our book to the BAPCO book." *Deposition of Gary Johnson,* at p. 254. Johnson's testimony, along with that of other Donnelley employees, resolves the alleged factual dispute and makes it clear that Appalachian keyed a heading code that corresponded to a heading in the Donnelley heading book. But, the mere fact that Appalachian entered codes that corresponded to a heading in Donnelley's own heading book does not resolve the issue.

The relevant question is whether Appalachian entered codes that corresponded to Donnelley's previously selected menu of headings for particular use in its Miami directories, not whether Appalachian entered codes corresponding to a heading in a Donnelley heading book that Donnelley uses for compiling directories generally. As discussed earlier, the evidence is undisputed that BAPCO selected approximately 7,000 classified headings from those in its heading book containing 4,700 primary entries and approximately 34,000 authorized related headings. Therefore, the originality of BAPCO's selection of headings is based on its selection of approximately 7,000 headings for inclusion in the *1984 Yellow Pages,* not the selection of the nearly 40,000 authorized headings in the BAPCO heading book. In considering whether Donnelley copied BAPCO's selection of headings from the *1984 Yellow Pages,* Johnson's testimony makes it apparent that Donnelley did not previously select headings from its own heading book for inclusion in its *1985 Miami North* and *1985 Miami South* directories. Instead, Johnson testified that Donnelley merely sent Appalachian its heading book so that Appalachian could assign a code to each BAPCO heading that corresponded to a like or similar heading in the Donnelley heading book.

Johnson's testimony is bolstered in the testimony of Jon Notestein, who made the following statement in response to a question about how Donnelley selected classified headings that reflected needs of the market and users in Miami: "They were probably created by looking at the directories representing Miami, [the BAPCO directory]." *See Deposition of Jon C. Notestein*, pp. 50-52; *see also* Donnelley En Banc Reply Brief, p. 19 n. 14 (conceding that Notestein testified that Donnelley used the *1984 Yellow Pages* in order to refine its preexisting set of headings for use in Florida).

Therefore, even resolving the alleged factual dispute regarding Appalachian's coding of headings in favor of Donnelley's version, Johnson's and Notestein's testimony makes it clear that Donnelley did not previously select a universe of headings for particular use in its Miami directories. Instead, Donnelley copied BAPCO's selection of headings with what can only be described as a high-tech copying process. Donnelley's high-tech copying involved Appalachian keying codes rather than the words of BAPCO headings into a database, from which the wording of the BAPCO headings could be reconstructed later using the Donnelley heading book as a decoder.

Besides the evidence showing that Donnelley substantially appropriated BAPCO's selection of headings, Donnelley's stipulation regarding what information Appalachian keyed into the computer database leaves no factual dispute that Donnelley also substantially appropriated BAPCO's other original acts of selection and arrangement. As previously discussed, BAPCO's original acts of selection or arrangement included the selection of approximately 7,000 headings for particular use in the *1984 Yellow Pages*; the arrangement of 106,398 listings from 32,559 businesses under the approximately 7,000 classified headings; the selection of only businesses with business telephone service; and the selection of a geographic area to be covered comprehensively in the directory. It

is undisputed that Appalachian keyed into the computer database every business listing with a corresponding heading code and a code indicating the directory source for every listing in the *1984 Yellow Pages.*

Although the keying of each code in isolation would amount to the lawful copying of facts, Appalachian's grouping of the business listing with an associated heading code and a directory code amounts to the appropriation of virtually all of BAPCO's original acts of selection and arrangement. That is, Donnelley copied BAPCO's selection of headings based on Appalachian's keying of a heading code, even if it corresponded to headings in Donnelley's own heading book, for virtually every heading used in the *1984 Yellow Pages.* Donnelley copied BAPCO's arrangement of business listings under a particular classified heading based on Appalachian's grouping of the business listing data with a heading code that corresponded to a heading like or similar to BAPCO's. Donnelley copied BAPCO's selection of only businesses with business telephone service based on Appalachian's keying of every business listed in the *1984 Yellow Pages.* In addition, Donnelley copied BAPCO's selection of a geographic area based on Appalachian's grouping of the business listing data and the code indicating the directory source.

Because the keyed information was stored in or on some material object until later printed on the sales lead sheets, Donnelley's creation of the computer database represents an act of "copying" as defined in the Copyright Act. *See* 17 U.S.C. § 101 (defining a copy as a material object "in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device"). Accordingly, I would hold that Donnelley's substantial appropriation of BAPCO's original acts of selection or arrangement in creating the computer database, represented an act of copyright infringement.

B. *Sales Lead Sheets*

Donnelley's substantial appropriation of BAPCO's original act of selection or arrangement is also apparent in the printed sales lead sheets. As discussed previously, Donnelley stipulated in the district court that it prepared the sales lead sheets from the following information obtained from the *1984 Yellow Pages:* (1) telephone number—under the first column; (2) name—under the second column; (3) address—under the third column; (4) kind of business—under the fourth column; and (5) unit of advertising—under the fifth column. A visual examination of the printed sales lead sheets shows that the sales lead sheets also contain rate information under the sixth column and a directory code under the seventh column. Because it is uncontroverted that the sales lead sheets represented merely a printed version of the same information that Appalachian keyed into the computer database, the previous analysis of how Donnelley substantially appropriated BAPCO's original selection or arrangement in creating the database applies equally to its printing of the sales lead sheets. Hence, I would also hold that Donnelley's printing sales lead sheets using the information already copied into the computer database, represented a second act of copyright infringement.

Even though a discussion of the sales lead sheets necessarily turns on analysis of the information keyed into the computer database, the printed sales lead sheets have independent significance because the sales lead sheets, not the actual directories, constituted the chief visual evidence of copying in the district court. In the district court, Donnelley stipulated that the seven lead sheets attached to BAPCO's motion for preliminary injunction were representative of all the thousands of sales lead sheets that Donnelley created. Donnelley now attempts to retreat from its concession concerning the representativeness of the sales lead sheets and to retry this case based on a visual comparison of the *1984 Yellow Pages* and the

1985 Miami North and the *1985 Miami South* directories. In its *En Banc* Reply Brief, Donnelley responds to BAPCO's assertions of substantial similarity based on the seven lead sheets with the following argument: "BAPCO bases this assertion entirely on a chart drawn from just seven of the thousands of lead sheets produced by Donnelley for Miami. However, BAPCO's chart 'conclusively demonstrates' only that a small sample can produce a misleading result." *See* Donnelley En Banc Reply Brief, p. 22 (citations omitted). Donnelley continues its response with its newly created chart comparing the headings in the *1984 Yellow Pages* and those used in the *1985 Miami North* and *1985 Miami South* directories.

Donnelley's arguments are fatally flawed in that they rely on a visual comparison of the actual directories, which Donnelley admits that it only recently, on January 27, 1993, moved for leave to place physical copies of the three directories in the record on appeal. *See* Donnelley En Banc Reply Brief, p. 22 n. 16. Likewise, Donnelley failed to present the chart comparing the headings in the three directories to the district court, attaching it for the first time as an appendix in its En Banc Reply Brief. *See* Donnelley En Banc Reply Brief, p. 22 n. 17 (explaining the results of its new analysis as indicated in Appendix A of the En Banc Reply Brief).[8]

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[8] Contrary to settled principles of finality, the majority permits Donnelley to back away from its stipulation in the district court regarding the representativeness of the seven lead sheets. Instead of considering the seven sales lead sheets and analysis of them as presented to the district court, the majority relies heavily on a visual comparison of selected pages from the three published directories. Indeed, it is unusual that this copyright case proceeded from October, 1985, to October, 1988, in the district court without the parties submitting complete physical copies of the disputed publications. But, it was this court, not the district court, that admitted the directories into the record in response to the parties' joint motion of January, 1993. The majority properly, albeit implicitly, declines Donnelley's request that this en banc court to

Unlike Donnelley, BAPCO did present the district court with a comparative analysis of the seven lead sheets showing the virtual identity between BAPCO headings and Donnelley headings. BAPCO presented the affidavit testimony of Barbara Wiggs, who explained her findings on the similarities between information on the sales lead sheets and that in the *1984 Yellow Pages.* Based on line-by-line comparisons of the sales lead sheets to the *1984 Yellow Pages,* Wiggs concluded that "the listing information on the attached Donnelley Sales Lead sheets were identical to the *1984 Yellow Pages* directories, except for a small number of very minor discrepancies." *See* 6SR10-17, pp. 11-12, *Affidavit of Barbara J. Wiggs,* in *Volume 1—Appendix to Summary Memorandum of Bellsouth Advertising & Publishing Corporation.* Specifically, Wiggs listed her findings of complete identity except for the following entries: (1) Evian associated with the heading

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engage in a side-by-side visual comparison of all pages in three published directories. See Donnelley En Ban Reply Brief, p. 22 nn. 16 & 17. However, the majority's visual comparison of selected pages from the directories is equally unfounded. As discussed fully in section III-C, the record before the district court consisted of a total of approximately forty pages from the published directories. Nothing in the district court opinion indicates that the district court actually made a side-by-side visual comparison of those pages except possibly to verify the conclusions in the Affidavit of Barbara J. Wiggs.

This court generally bases a reversal of a district court on evidence that the district court considered. The majority's outright reversal of the district court based upon its original 'finding' from a visual comparison of selected pages from the published directories, places this court in the novel position of retrying this case rather than reviewing it. Because Donnelley's own stipulation as to the representativeness of the sales lead sheets led the district court to reach what Donnelley now calls a "misleading result," this court must affirm the district court's conclusion on the substantial similarity issue. At a minimum, this court is required to remand to the district court for consideration of Donnelley's new theory of the case which hinges on a comparative analysis of pages from the published directories.

"Water Coolers" instead of "Water Coolers—Renting"; (2) Star Appliances being associated with the heading "Air Conditioning—Room Units" instead of "Air Conditioning Equipment—Room Units"; (3) Star Appliances being associated with the heading "Television Dealers—Retail" instead of "Television & Radio—Dealers"; (4) Star Appliances being associated with the heading "Vacuum Cleaners—YSTEM Household—Dealers" instead of "Vacuum Cleaners—Household—Dealers"; (5) Star Appliances being associated with the heading "Vacuum Cleaners—S Household—Dealers" instead of "Vacuum Cleaners—Household—Dealers"; and (6) Audiotron-High Fidelity Corp. being associated with the address of "145 S.W. 52nd Avenue" instead of "145-147 S.W. 52nd Avenue Second Floor." Wiggs's conclusion that the discrepancies were "minor" is entirely reasonable in light of the fact that the seven lead sheets contain information concerning seven different businesses, appearing under forty different headings in the *1984 Yellow Pages*, for a total of sixty-eight listings, averaging five different headings and ten listings. It is also significant to note that the headings on the lead sheets ranged from "Gas—Industrial & Medical Cylinder & Bulk" to "Antiques—Repairing & Restoring." The identity between the headings on the lead sheets and those in the *1984 Yellow Pages* included even the hyphens and the ampersands.

Based on Donnelley's stipulation that the seven sales lead sheets were representative and Wiggs's testimony on the virtual identity between the headings and other information on the sales lead sheets and that in the *1984 Yellow Pages*, the chief visual evidence in the district court conclusively shows that Donnelley's printing of the sales lead sheets represented a second act of substantial appropriation of BAPCO's original acts of selection or arrangement.

C. *The Donnelley Directories*

As previously discussed, only a small portion of the arguments and evidence before the district court related to a visual comparison of published copies of the actual directories. In its opinion, the district court references a comparison of the directories only three times. The first reference is the district court's statement that "a comparison of the two (2) directories reveal that Donnelley used a format nearly identical to that used by BAPCO. *See* Exhibit P and P Enlarged to BAPCO's Brief." *See BellSouth*, 719 F.Supp. at 1559. In their February, 1993, letters to the clerk of this court regarding requests for certain portions of the record, both parties agreed that the district court did not refer to the BAPCO and Donnelley directories when referencing Exhibit P and P Enlarged.

In fact, Exhibit P and P Enlarged are copies of a sales solicitation form of Associated Telephone Directory Publishers that this court reproduced as Appendix A in *Southern Bell Tel. & Tel. v. Associated Tel. Directory Publishers,* 756 F.2d 801, 813-14 (11th Cir.1985). Donnelley stated in its February 22, 1993, letter to the clerk that "Exhibits P and P enlarged do not involve any yellow pages directory at issue in the present appeal" and that the district court cited the exhibits erroneously. BAPCO responded that the district court correctly referred to the exhibits from the *Southern Bell* opinion, but only for the limited purposes of showing what the *Southern Bell* court considered to be a copyrightable format, and showing that Donnelley's format as evidenced in the sales lead sheets was nearly identical to that of BAPCO. Regardless of why the district court referenced Exhibits P and P Enlarged, the fact that the parties agree that the district court was not referencing pages from the BAPCO or Donnelley directories makes it uncontroverted that the district court was not stating that it performed page-by-page visual comparison of the *1984 Yellow Pages* and the Donnelley directories.

The second suggestion that the district court visually compared the disputed directories, is the district court's discussion of the evidence of "common errors." *See BellSouth*, 719 F.Supp. at 1559 & n. 23. But, in discussing the common errors in the three directories, the district court referenced pages from the directories that BAPCO attached to the *Second Affidavit of Barbara J. Wiggs*. *See BellSouth*, 719 F.Supp. at 1559 n. 23. The district court did not cite pages in complete published copies of the directories. Similarly, in concluding that the directories are substantially similar, the district court cites the Barbara Wiggs affidavit and Gerald Brown testimony rather than pages from the published directories. *See BellSouth*, 719 F.Supp. at 1559-60.

Therefore, none of the references in the district court's opinion provide a basis for this court to engage in side-by-side comparisons of all pages in the *1984 Yellow Pages* with those in the *1985 Miami North* and *1985 Miami South* directories. It is only possible to conclude that the district court examined the pages of the directories that BAPCO attached to the *Second Affidavit of Barbara J. Wiggs*. Because Donnelley failed to present its own comparative analysis of pages from the actual directories and also failed to place physical copies of the directories in the record until January, 1993, this court is required to limit its determination on the substantial similarity of the directories to those pages attached to the *Second Affidavit of Barbara J. Wiggs*, and only to the extent of Wiggs's comparative analysis.

The district court relied on Wiggs's analysis of pages from the directories as support for the following conclusion: "Although Donnelley's directory is not identical to BAPCO's directory, the material was copied and used to produce a directory substantially simliar in both content and format." *See BellSouth*, 719 F.Supp. at 1559-60 (citing Affidavit of Barbara Wiggs and October, 1985, testimony of Gerald Brown). In her affidavit, Wiggs iden-

tified twenty-five errors that were common to both the *1984 Yellow Pages* and the Donnelley directories. *See* 6SR11-18, *Second Affidavit of Barbara J. Wiggs,* pp. 2-19. For example, Wiggs explained that BAPCO incorrectly listed Fort Lauderdale News under the heading "Balancing Equipment" in the *1984 Yellow Pages,* and that Donnelley's *1985 Miami North* directory also lists Fort Lauderdale News under a "Balancing Equipment" heading. *See BellSouth,* 719 F.Supp. at 1559 n. 23 (also noting the example of the common erroneous listing of "Flash Courier Systems" even though the subscriber's telephone was disconnected before January 1, 1984).

The presence of common errors is "one of the most significant evidences of infringement." *Callaghan v. Myers,* 128 U.S. 617, 662, 9 S.Ct. 177, 190, 32 L.Ed. 542 (1888). Based on the earlier conclusions that the *1984 Yellow Pages* constitutes an original selection and arrangement of facts that is copyrightable, Wiggs's testimony regarding the presence of common errors is relevant to rebut Donnelley's repeated assertions that it used the *1984 Yellow Pages* "only to ascertain the fact revealed by BAPCO's heading—the kind of business carried on by the listed firm—so as to enable Donnelley to classify that firm in its own system of classification." *See* Donnelley En Banc Reply Brief at p. 20; *see also,* Donnelley En Banc Brief at p. 12. Donnelley's assertions that it independently classified businesses using its own heading scheme is wholly unbelievable when one considers the statistical improbability of two publishers independently classifying the same newspaper as a "Balancing Equipment" dealer. Therefore, the presence of the common errors in the published directories is significant evidence that Donnelley substantially appropriated BAPCO's original arrangement of business listings under particular classified headings.

As further evidence of Donnelley's substantial appropriation of BAPCO's grouping of listings under particular

headings, Wiggs's affidavit included a heading comparison based on a random selection of Donnelley headings and a comparison of the listings appearing under those headings with the listings appearing under the corresponding headings in the *1984 Yellow Pages.* BAPCO presented the district court with the following chart summarizing Wiggs's findings regarding the percentage of correlation between the listings under particular headings in the Donnelley directories and those in the *1984 Yellow Pages:*

Heading	North Miami	South Miami
"Bail Bonds"	68%	55%
"Boxes, Corrugated & Fiber"	86%	100%
"Ceilings"	64%	50%
"Driving Instruction"	72%	73%
"Engineers—Civil"	88%	86%
"Furniture—Outdoors"	63%	70%
"Gold, Silver & Platinum Dealers"	95%	85%

See 6SR5-3 *Reply to Donnelley's Memorandum in Opposition to Motion for Partial Summary Judgment on Copyright Infringement by Bellsouth Advertising & Publishing Corporation and Memorandum in Opposition to Donnelley's Copyright Partial Summary Judgment Motion,* p. 40 (March 6, 1986).

As the chart indicates, Wiggs found a high (averaging seventy-five percent) statistical correlation of listings under particular headings when comparing the *1984 Yellow Pages* with the Donnelley directories. Donnelley did not respond with its own correlation analysis, and thus, Wiggs's findings represent further undisputed evidence that Donnelley's published directories contain a substantially similar arrangement of business listings under particular classified headings. *Accord see Key Publications,* 945 F.2d at 515, 517 (finding no substantial similarity based on the lack of any evidence that the defendant copied an entire category of the plaintiff's directory, but explaining that a finding of infringement would succeed if the defendant had exactly duplicated a substantial designated

portion of the plaintiff's directory such as all of the listings of professionals such as medical doctors, lawyers, accountants, engineers, and architects).

To the extent that Wiggs's analysis of the directories was misleading, it is an elementary rule on summary judgment that the burden shifted to Donnelley to produce its own comparative analysis of the published directories in order to rebut the undisputed evidence of substantial similarity in Wiggs's affidavit. *See United States v. Four Parcels of Real Property,* 941 F.2d 1428, 1438 (11th Cir.1991) (recognizing that the burden on summary judgment shifts to the non-moving party once the moving party has met its initial responsibility of showing the absence of a triable issue of fact, and that the moving party is entitled to summary judgment if the non-moving party fails to make a sufficient showing on an essential element of the case); Fed.R.Civ.P. 56(e). As a non-moving party opposing a motion for summary judgment which BAPCO supported with affidavits, Donnelley could not simply rely on legal conclusions or evidence which would be inadmissible at trial in order to meet its burden of coming forward with relevant and competent evidence. *See Avirgan v. Hull,* 932 F.2d 1572, 1577 (11th Cir. 1991).

In the district court, Donnelley failed to respond to the evidence in Wiggs's affidavit showing substantial similarity in the arrangement of listings under headings in the published directories. Contrary to Donnelley's assertions to the *en banc* court, Donnelley also failed to present evidence to the district court that the selection of headings in its published directories was substantially smaller and different from those in the *1984 Yellow Pages. Compare* Donnelley En Banc Brief at p. 12 and BAPCO En Banc Brief at p. 3 (attaching as "Exhibit 2" those portions of the record that Donnelley cites). Instead of responding to BAPCO's evidence in the district court, Donnelley waited until January, 1993, before moving to place the published directories in the record. *See*

Donnelley En Banc Reply Brief p. 22 n. 16. Donnelley also waited until its *En Banc* Reply Brief before presenting a comparative analysis of the heading structure in the published directories. *See* Donnelley En Banc Reply Brief, pp. 22-23 & n. 17. Stated simply, Donnelley waited too late to meet its burden of presenting competent evidence to oppose BAPCO's motion for summary judgment. Because Wiggs's affidavit represented the only evidence before the district court concerning the substantial similarity of the published directories, I would affirm the district court's conclusion that Donnelley substantially appropriated BAPCO's original acts of selection and arrangement when publishing the *1985 Miami North* and *1985 Miami South* directories.[9]

In sum, the uncontroverted evidence before the district court shows that Donnelley substantially appropriated BAPCO's original selection and arrangement in the *1984 Yellow Pages* with three separate acts of copying: (1) keying-in that selection and arrangement into the computer database; (2) printing the sales lead sheets from the data in the computer database; and (3) using the computer database and the sales lead sheets to publish the Donnelley directories with a substantially similar selection of headings and substantially similar arrangement or grouping of listings under particular headings. Accordingly, I would affirm the judgment of the district court granting summary judgment in favor of BAPCO on all

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[9] Incredibly, the majority ignores the fact that Donnelley failed to meet its burden of coming forward with relevant and competent evidence to rebut BAPCO's affidavit evidence. In doing so, the majority departs from the settled rule that a non-moving party may lose at the summary judgment stage based on its failure to come forward with competent evidence showing a genuine issue of material fact. *See Four Parcels*, 941 F.2d at 1438. As a replacement for the established rules concerning summary judgment, the majority's reliance on its original fact-finding in a visual comparison of pages from the published directories, establishes a new and absurd rule that a non-moving party failing to meet its burden in the district court may nonetheless win outright judgment with evidence considered for the first time on appeal.

three claims that Donnelley infringed its compilation copyright in the *1984 Yellow Pages*.[10]

Because the majority reaches the opposite result based on an utter failure to analyze the evidence presented to the district court under the controlling legal principles announced in *Feist*, and also based on an unwarranted departure from well-established rules limiting this court's review to arguments and evidence presented in the district court, I must respectfully DISSENT.

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[10] In addition, for the reasons stated in the now vacated panel opinion, *Bellsouth*, 933 F.2d at 960-61, I would affirm the district court's rejection of Donnelley's "fair use" and "antitrust misuse" defenses.

APPENDIX B

UNITED STATES COURT OF APPEALS
ELEVENTH CIRCUIT

No. 89-5131

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,
Plaintiff-Counterclaim
Defendant-Appellee,

v.

DONNELLEY INFORMATION PUBLISHING, INC., and the
REUBEN H. DONNELLEY CORP.,
Defendants-Counterclaim
Plaintiffs-Appellants.

BELLSOUTH CORPORATION, *et al.*,
Counterclaim-Defendants.

Appeal from the United States District Court
for the Southern District of Florida

June 18, 1991

Douglas C. Broeker, Michael J. Cappucio, Miami, Fla., Fowler, White, Burnett, Hurley, Banick & Strickroot, P.A., David L. Foster, Theodore Case Whitehouse, Francis J. Menton, Jr., Willkie, Farr & Gallagher, Baila H. Celedonia, Roger L. Zissu, Cowan, Liebowitz, & Lat-

man, PC, New York City, for defendants-counterclaim plaintiffs-appellants.

Robert E. Richards, Anthony B. Askew, Jones, Askew & Lunsford, Atlanta, Ga., for Bellsouth Advertising.

John K. Roedel, Jr., Senniger, Powers, Leavitt & Roedel, St. Louis, Mo., for amicus curiae, ANADP.

Robert E. Marsh, Blackwell, Sanders, Matheny, Weary & Lombardi, Kansas City, Mo., for amicus curiae, US WEST.

Robert Alan Garrett, Arnold & Porter, Washington, D.C., for amicus curiae, Bell Atlantic.

Before JOHNSON and HATCHETT, Circuit Judges, and SMITH *, Senior Circuit Judge.

EDWARD S. SMITH, Senior Circuit Judge:

The case before us concerns infringement of copyright. The United States District Court for the Southern District of Florida granted summary judgment to appellee, Bellsouth Advertising & Publishing Corp. (BAPCO), on its claim that appellants, Donnelley Information Publishing, Inc. and Reuben H. Donnelley Corp. (Donnelley), had infringed on BAPCO's copyrights in its phone directory. The district court also granted summary judgment against Donnelley on their fair use and antitrust misuse defenses. To preserve the integrity of BAPCO's copyrights, the district court enjoined Donnelley from copying any of BAPCO's directories in the future. 719 F.Supp. 1551. Donnelley appeals to this Court for review of the grant of summary judgment and the injunction order. We affirm.

Facts

BAPCO and Southern Bell Telephone and Telegraph Co. (Southern Bell) are wholly-owned subsidiaries of

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* Honorable Edward S. Smith, Senior U.S. Circuit Judge for the Federal Circuit, sitting by designation.

BellSouth Corp. (BellSouth). BAPCO was created for the purpose of preparing, publishing and distributing telephone directories. Pursuant to an agreement between Southern Bell and BAPCO, the latter publishes and distributes a classified advertising directory entitled the Greater Miami Yellow Pages (Yellow Pages). The information that BAPCO presents in its directory is supplied by Southern Bell. This controversy concerns the Yellow Pages published in 1984 in which BAPCO owns a valid copyright.

The information embodied in the Yellow Pages is presented in a convenient, organized fashion. A particular directory is organized to have its own geographic scope, so that businesses which have a phone exchange located within the geographic scope are listed in the appropriate directory. Moreover, the Yellow Pages directory is categorized according to business classification. Each business listing is placed within its appropriate business classification in alphabetical order. A business listing comprises the business name, address and phone number. To attract prospective customers, a given business may purchase an advertisement which will appear in the Yellow Pages in addition to its business listing. These advertisements are interspersed within each business classification throughout the Yellow Pages.

After BAPCO published the 1984 Yellow Pages, Donnelley began promoting and selling classified advertisements which were to be placed in a competitive classified directory for the Greater Miami area. Donnelley's vice president wrote to BAPCO concerning the acquisition of listings that could be published in their own directory. Subsequently, Southern Bell and Donnelley entered an agreement pertaining to Donnelley's publication and distribution of a competing classified advertising directory in the Greater Miami area. Pursuant to the agreement, Southern Bell provided Donnelley with the name, address, and telephone number of all of its relevant business subscribers.

However, Donnelley did not utilize the licensed information to generate their own directory. Instead, Donnelley had Appalachian Computer Services, Inc. key the information and the inherent organizational elements embodied in BAPCO's Yellow Pages into a computer and store it on magnetic tape. Donnelley subsequently printed out listings from the computer data base along with some of its corresponding organizational elements onto sales lead sheets. Donnelley's sales representatives used these lead sheets to solicit additional advertising purchases from those businesses listed in their directory. Donnelley also printed the listings onto their own directory in substantially the same format as that inscribed in the Yellow Pages.

On October 2, 1985, BAPCO filed suit against Donnelley alleging three causes of action: (1) copyright infringement, (2) trademark infringement, and (3) unfair competition. BAPCO moved for a preliminary injunction which the district court eventually denied. After the preliminary injunction proceedings, Donnelley answered the complaint naming BAPCO, Southern Bell and Bell South as counterdefendants and alleged: (1) unlawful monopolization, (2) unlawful attempt to monopolize, and (3) invalid trademark registration.

After several salvos of summary judgments were motioned by each party, the district court granted summary judgment in favor of BAPCO on the copyright infringement claim, antitrust counterclaims and affirmative defenses. The district court denied Donnelley's motion for summary judgment on the trademark issues and denied BellSouth and Southern Bell's motion for summary judgment on the antitrust counterclaims. Donnelley appeals to this Court, contesting the district court's decision regarding the copyright infringement and the antitrust and fair use affirmative defenses.

Issues

The district court found that BAPCO was entitled to summary judgment on its claim that Donnelley infringed its copyright and that BAPCO had not committed any antitrust violation. We must determine whether the evidence before the court indicates "that there is no genuine issue as to any material fact" relevant to the copyright infringement claim and the fair use and antitrust defenses.[1] If the law applicable to the undisputed facts entitles BAPCO to the judgment entered by the district court, we must affirm.[2]

Infringement

BAPCO claims that Donnelley infringed its copyright in the Yellow Pages. To prevail on a claim of copyright infringement, the plaintiff must establish two elements: (1) that plaintiff owns a valid copyright in the work; and (2) that defendant copied "constituent elements of the work that are original." [3]

As to the first element, a phone directory is afforded copyright protection if it classifies as a compilation.[4] Donnelley admits that BAPCO possesses a valid compilation copyright in their phone directories because it qualifies as a compilation under 17 U.S.C. § 101.[5] Donnelley's defense to infringement is that although they did copy information from BAPCO's phone directory, they did not copy any constituent elements that make the work original (*i.e.*, protected expression). Instead the defendant maintains that they only "extracted" information which is not protected by copyright.

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[1] Fed.R.Civ.P. 56(c).

[2] *Id.*

[3] *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, —— U.S. ——, ——, 111 S.Ct. 1282, 1296, 112 L.Ed.2d 358 (1991).

[4] 17 U.S.C. § 103(a) (1988).

[5] (1988).

The Courts of Appeal were in disagreement as to the extent that a compilation work is protected. The "sweat of the brow" standard extends copyright protection to the information in a compilation because labor and effort were expended to gather the information that is placed in the work.[6] The Supreme Court has disapproved the "sweat of the brow" standard, explaining that its defect lies in the fact that the copyright laws were never intended to protect information merely for the reason that it may stem from effort or labor.[7] The copyright laws, as part of the overall protection afforded intellectual property, were designed only to protect "original works of authorship fixed in any tangible medium of expression. . . ." [8] Therefore, the *information* contained in the directory which is accumulated by effort or labor does not lie within the hegemony of BAPCO's copyright.[9]

Instead, the proper standard is delineated in the statute itself. "A compilation is a work formed by the collection and assembling of preexisting materials or of data that are *selected, coordinated, or arranged in such a way* that the resulting work as a whole constitutes an *original work* of authorship." [10] Therefore, in the case of com-

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[6] *See, e.g., Hutchinson Tel. Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir.1985); *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir.1977).

[7] *Feist Publications*, —— U.S. at ——, 111 S.Ct. at 1291.

[8] 17 U.S.C. § 102(a) (1988).

[9] *Feist Publications*, —— U.S. at ——, 111 S.Ct. at 1291.

[10] 17 U.S.C. § 101 (1988) (emphasis added). The illuminating statutory distinction is basic to all copyright protection. Words and elements of delineated forms themselves are generally not original; it is the originality of their combination that the law seeks to protect. For example, the notes of the scale from "a" to "g" are preexisting, as one can see. The notes themselves clearly never change, but the manner in which the notes arrange, assembled by an inventive mind, is property of a protected kind. To copy that work is alike to trespass, and will get the infringer a kick off the property.

pilations, the protected expression is the manner of selection, coordination, or arrangement of the information that constitutes the originality, not the information itself that is accumulated by the "sweat of the brow".[11] Hence, copyright protection only extends to the selection, coordination and arrangement which comprises an original *format* of the compilation work.[12] In the case of compilations, to satisfy the second element of the copyright infringement cause of action, there must be a substantial appropriation of the original format of the compilation to constitute the copyright of protected material.[13] Accordingly, we must determine whether there was a substantial appropriation of the format of the plaintiff's compilation.

To determine whether there was a substantial appropriation, we initially determine whether BAPCO's format was original. First of all, BAPCO performed several acts of selection. BAPCO had to select and demark the geographic boundaries that correspond to the scope of each directory. These boundaries determine in which directory or directories a particular business will be listed. BAPCO also had to select a directory close date on which no more listing modifications would be reflected in the pending directory publication. Moreover, BAPCO had to create or select numerous business classifications. A particular business is listed according to its appropriate business classification.

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[11] The labor is more appropriately protected under the law of unfair competition. *Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory*, 756 F.2d 801, 809-10 n. 9 (11th Cir.1985).

[12] *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1369-70 (5th Cir.1981) (decided before the Fifth Circuit split, so binding on this Court, *Bonner v. City of Prichard*, 661 F.2d 1206 (11th Cir. 1981)); *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 572-74 (9th Cir.1987), *cert. denied*, 485 U.S. 977, 108 S.Ct. 1271, 99 L.Ed.2d 482 (1988); *Financial Information, Inc. v. Moody's Investors Serv., Inc.*, 751 F.2d 501, 506 (2d Cir.1984).

[13] *Associated Tel. Directory*, 756 F.2d at 810.

Secondly, BAPCO had to coordinate all the current informational components of a particular business into one complete business listing. The name of the business had to be coordinated with the business' address and the business' phone number.

Lastly, BAPCO had to arrange these coordinated listings according to various categories. All business listings and advertisements had to be arranged under the appropriate business classification. In the final product, all current business listings and advertisements that were arranged according to business classification had to be arranged according to geographical scope. Hence, a particular directory only included those businesses located within the peculiar geographic scope selected for the particular directory. These acts of selection, coordination and arrangement contribute to produce what we agree to be an original format of the directory. The format of the Yellow Pages before us is sufficiently distinct from the "white pages" phone directory involved in *Feist* to meet the minimal level of independent creativity required to qualify as original. The "white pages" format is a simple alphabetical listing of residential names, addresses and phone numbers. Because the Yellow Pages directory published by BAPCO provides a convenient, unique organization of business listings and advertisements, it merits originality. Therefore, only the original format is protected, the bare information itself segregated from the compilational format is not protected.

Next, we decide whether Donnelley substantially appropriated the selection, coordination, or arrangement that comprised the format of the BAPCO directory. The district court found that Donnelley committed three acts of copying: keying the formatted information into the computer, preparing the sales lead sheets and publishing the Donnelley directories. We review these findings to determine if any or all of these acts constitute a substantial appropriation of BAPCO's protected format.

The first alleged act of copying is keying formatted information into a computer. Before proceeding on, we put the legal analysis on hold, in order to determine whether the act of keying this formatted information into the computer to form a data base can be a physical act of copying. A copy is a "material object[] . . . in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."[14] When the formatted information is first keyed into the computer, it is held in or on some material object. There is no doubt that the work can be perceived by calling up the formatted information on the computer monitor screen. Therefore, such an act is copying if the work is *fixed* in the computer.

"A work is 'fixed' . . . when its embodiment . . . is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration."[15] In the case of a computer, data is not stabilized for more than a transitory duration unless it is stored in or on a material object.[16] Although the record does not indicate whether or how the formatted information was stored in the computer, the district court did find that the formatted information was at some point "stored on magnetic tape and sent to Donnelley." Therefore, the act of keying the formatted information into a computer and storing it on magnetic tape is a physical act of copying.

Knowing that keying the work into the computer is an act of physical copying, we now decide whether Donnelley appropriated enough of BAPCO's format to con-

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[14] 17 U.S.C. § 101.

[15] *Id.*

[16] *See Stern Electronics, Inc. v. Kaufman,* 669 F.2d 852, 855-56 n. 4 (2d Cir.1982).

stitute illegal copying. Donnelley's process involved keying into a computer database the name, address, telephone number, the classified heading code, the advertising code and the directory code for every business listing.[17] The classified heading code corresponds to the type of business classification or classifications under which a particular business is placed. The advertising code represents the number of units of advertising that the particular business has purchased. The directory code signifies the directory or directories in which the business was listed thereby revealing its geographical arrangement. These encoded elements could be readily translated back into its BAPCO counterpart classifications through use of Donnelley's decoding key. Although these codes were authored by Donnelley, they correspond to the selection, coordination and arrangement originally authored by BAPCO.

The district court correctly found that Donnelley expropriated the essence of BAPCO's compilation. In effect, Donnelley has distilled the BAPCO compilation down to its basic elements, but retained the tools that are required to reconstitute the compilation. By utilizing their classification codes and their decoder keys which match particular codes to the corresponding BAPCO classification, Donnelley can reconstruct the format of BAPCO's compilation.[18]

Also probative is the fact that Southern Bell had furnished Donnelley with a list of all Southern Bell business phone subscribers, pursuant to a licensing agreement. The licensed information included the names, addresses and

[17] Donnelley hired Appalachian Computer Services, Inc. of London, Kentucky to key BAPCO's compilation into a computer data base.

[18] Donnelley attempts to evaluate individually each element of the BAPCO directory in asserting that they lack originality and are thereby unprotected by copyright. However, each component must not be evaluated in a literary vacuum but as an integral part of the whole to determine if BAPCO's original format was copied.

telephone numbers for all business subscribers in Greater Miami. If Donnelley had been interested only in the *information* contained in the directory, they could have extracted all the information that they needed from the list furnished to them by Southern Bell. Instead, Donnelley copied the formatted information from the Yellow Pages because they were interested in the format and organization of the information in the Yellow pages which was authored by BAPCO. We agree that Donnelley has copied BAPCO's protected material by substantially appropriating the constituent elements of the original format inscribed in the BAPCO directory.

Although a closer question, we also agree that Donnelley's printing of the sales lead sheets from the formatted information fixed on their magnetic tape constitutes copying. Donnelley's sales representatives use these lead sheets to sell advertisements to listed businesses. A single entry on the lead sheet comprises the telephone number, the business name, the business address, the business classification, the number of advertising units previously purchased from BAPCO, the advertising rate, and the BAPCO directory in which it was listed.

We realize that BAPCO's Yellow Pages and Donnelley's lead sheets were arranged differently. On line one, BAPCO arranged their listings in the phone directory first according to alphabetized business classification and then according to alphabetized business name within each classification. On the other line, Donnelley's lead sheets are arranged in tabular form. However, the protected part of a compilation work is the "selection, coordination *or* arrangement." [19] Although the arrangement of Donnelley's sales lead sheets and BAPCO's phone directory is different, Donnelley's sales lead sheets continue to appropriate the coordination of informational components in a business listing and the selection of categories utilized by the BAPCO format. This appropriation is substantial

[19] 17 U.S.C. § 101 (emphasis added).

and constitutes the copying of constituent elements of originality.[20]

Publication of the Donnelley directories is also an act of copying BAPCO's Yellow Pages. Although some of the additional advertisements interspersed throughout the Yellow Pages may be arranged differently or omitted in Donnelley's directory, the overall format of the Yellow Pages is substantially appropriated in the Donnelley directories. Consequently, we agree with the district court in that Donnelley committed acts of copying protected material from BAPCO's copyrighted compilation work.

Fair Use Defense

The doctrine of fair use permits one to use protected material without infringing the copyright. In determining whether fair use is an applicable defense, we must dial through the two-pronged analysis contemplated by 17 U.S.C. § 107.[21] First, we must determine whether the purpose underlying the use committed by the defendant is condoned by the statute. "[F]air use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching, . . . scholarship, or research, is not an infringement of copyright." [22] Although the list of acceptable purposes enumerated in the statute is not exclusive, it is evident that the purpose envisioned by the statute must be of a salutary nature. If, and only if, the purpose is acceptable, must we determine whether the defendant's use is fair.[23]

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[20] The district court's finding that this particular act was a substantial appropriation, hence copying, might not be as felicitous had the sales lead sheets not been derived from the initial copy which was entered into the computer data base and fixed on the magnetic tape.

[21] (1988).

[22] *Id.*

[23] *Id.*

In *Associated Telephone Directory*, this Court paid cursory attention to the first prong of the analysis by assuming that defendant's use of the expression in the phone directory advanced its research purposes.[24] We believe that the issue of purpose in this case demands more attention. Although Donnelley's use appropriated the research formatted in BAPCO's phone directory, the purpose underlying Donnelley's use was not to promote research, but to promote commercial profit. Donnelley's incentive in appropriating the formatted expression in BAPCO's directory was to compete for business advertisements by publishing the infringing directory. BAPCO had already completed the research and formatted it for presentation in the phone directory. Donnelley simply copied BAPCO's formatted research and published it for their own profit.[25] Because the record shows that Donnelley's use does not promote a salutary purpose, the first prong of the fair use doctrine is not satisfied. Accordingly, the defense of fair use is inapplicable, regardless of the second prong analysis.

Misuse Defense

Donnelley asserts that BAPCO, its parent, BellSouth, and its affiliate, Southern Bell, have engaged in an anticompetitive course of conduct thereby misusing its copyright in the Yellow Pages. The alleged object of the joint course of conduct was to maintain monopoly power or to attempt to attain monopoly power either of which are section 2 violations of the Sherman Act.[26] Donnelley alleges that the monopoly was effectuated by (1) refusing to supply Donnelley with the information required to

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[24] *Associated Tel. Directory*, 756 F.2d at 811.

[25] The fact that BAPCO did all the research and Donnelley did none of it only militates against the applicability of the doctrine of fair use; it is not the basis underlying the copyrightability of BAPCO's directory.

[26] 15 U.S.C. § 2 (1988).

compete in the market and (2) overexerting their intellectual property rights in the copyrighted directories to prohibit the use of competition-essential, unprotected information. Donnelley asserts that the court should not enforce the copyrights because BAPCO has abused its copyright privileges.

The antitrust misuse defense is an established defense to patent infringement.[27] The policy supporting the patent misuse defense lies in the equitable clean hands doctrine. A patentee who comes into court, praying that defendant's patent infringement be enjoined will not be gratified if he is guilty of abusing his patent rights.[28] Some courts have concluded that a misuse of copyright defense is inherent in the law of copyright just as a misuse of patent defense is inherent in patent law.[29] Although the patent misuse defense closely fits the copyright law situation and may someday be extended to discipline those who abuse their copyrights, we decline to extend the application in the context before us because there is no antitrust violation.

The disdain the law has for monopolies and the acquisition of monopolies is beyond peradventure.[30] However, this case is different from the ordinary monopoly case because BAPCO's right to restrict the copying of its work was recognized in them by the government. Therefore, to commit a Sherman Act violation with regard to an exclusive right that is sanctioned by the government,

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[27] *Morton Salt Co. v. G.S. Suppiger Co.*, 314 U.S. 488, 62 S.Ct. 402, 86 L.Ed. 363, *reh'g denied*, 315 U.S. 826, 62 S.Ct. 620, 86 L.Ed. 1222 (1942).

[28] *Id.* 314 U.S. at 492-93, 62 S.Ct. at 405.

[29] *Lasercomb America, Inc. v. Reynolds*, 911 F.2d 970, 977 (4th Cir.1990).

[30] *See, e.g. Swift & Co. v. United States*, 196 U.S. 375, 396, 25 S.Ct. 276, 279, 49 L.Ed. 518 (1905); *United States v. Grinnell Corp.*, 384 U.S. 563, 570-71, 86 S.Ct. 1698, 1703-04, 16 L.Ed.2d 778 (1966).

the grantee must abuse the legitimate privileges that accompany the grant. In order to abuse these privileges, it is necessary that the grantee extend its exclusive right beyond the parameters inherent in the grant.[31]

We agree with the district court conclusion that there was no antitrust violation because BAPCO had not "sought to extend the exclusionary power granted by the copyrights beyond the protection of the copyrighted directories." BAPCO only seeks to enforce its exclusionary rights in intellectual property which is an objective "for limited times" [32] countenanced by the Constitution and the copyright laws. Although enforcement of their copyright privileges does give BAPCO a competitive advantage in the advertisement sales market, this advantage is legitimately within the range of sanctioned benefits inherent in compilation copyright ownership.

Any suspicion that BAPCO has extended its privileges beyond that which is protected by copyright is dispelled by the fact that Southern Bell furnished Donnelley with a list of its business telephone subscribers pursuant to a license agreement. The furnished information includes names, addresses and telephone numbers for Southern Bell's business subscribers. By enforcing its copyright, BAPCO only seeks to prohibit Donnelley from appropriating its protected format and organization of the information published in the phone directory. BAPCO has not blocked the use of any information that is essential for competition as accused. Instead, BAPCO's alleged

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[31] *United States v. United Shoe Mach. Corp.*, 110 F.Supp. 295 (D.Mass.1953) (patentee violated Sherman Antitrust Act by leasing patented shoe manufacturing machinery pursuant to comprehensive lease agreements which induce lessor to rent successive machines and attain maintenance service only from patentee) *aff'd per curiam*, 347 U.S. 521, 74 S.Ct. 699, 98 L.Ed. 910 (1954); *Morton Salt Co.*, 314 U.S. 488, 62 S.Ct. 402 (patentee misused patent by illegally tying the license of patented machines with the sale of patentee's unpatented salt tablets).

[32] U.S. Const. art. I, § 8, cl. 8.

accomplice, Southern Bell, has made the information available to Donnelley. Accordingly, we affirm the conclusion that the antitrust misuse defense is not applicable to the undisputed facts of the case.

Conclusion

We agree with the district court that there were no issues of material fact before the trial court on the motions for summary judgment. BAPCO possessed a valid copyright in, and Donnelley copied, the original format of the Yellow Pages. Because the undisputed facts do not support Donnelley's fair use and misuse defenses, BAPCO is entitled to summary judgment on the issue of copyright infringement. Accordingly, the order for summary judgment and the injunction and restraining order were appropriately entered by the District Court for the Southern District of Florida. AFFIRMED.

APPENDIX C

UNITED STATES DISTRICT COURT
S.D. FLORIDA

No. 85-3233-CIV

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,
Plaintiff-Counterdefendant,

v.

DONNELLEY INFORMATION PUBLISHING, INC.,
Defendant-Counterclaimant,

v.

BELLSOUTH CORPORATION and SOUTHERN BELL TELEPHONE and TELEGRAPH COMPANY,
Additional Counterdefendants.

Oct. 27, 1988

Anthony B. Askew, Robert E. Richards, Stephen M. Schaetzel, Jones, Askew & Lunsford, Atlanta, Ga., Eric B. Meyers, Stephen B. Gillman, Shutts & Bowen, Miami, Florida, for BellSouth Advertising & Pub. Corp.

King & Spalding, Atlanta, Ga. and Shutts & Bowen, Miami, Fla., for BellSouth and Southern Bell Tel. and Tel. Co.

Fowler, White, Burnett, Hurley, Banick & Strickroot, P.A., Miami, Fla., for Donnelley Information Pub., Inc.

AMENDED MEMORANDUM OPINION

SCOTT, District Judge.

I. INTRODUCTION

THIS MATTER is before the Court on the parties' Motions and Cross-Motions for Summary Judgment. Plaintiff/Counter-Defendant BellSouth Advertising and Publishing Corporation's ("BAPCO") amended complaint against Defendant/Counterclaimant Donnelley Information Publishing, Inc. ("Donnelley") alleges copyright infringement, trademark infringement and unfair competition arising from Donnelley's publication and distribution of a classified advertising directory in South Florida. In its answer, Donnelley counterclaims against BAPCO, as well as Southern Bell Telephone and Telegraph Co. ("Southern Bell") and BellSouth Corporation ("BellSouth"), alleging that Counterdefendants illegally monopolized and attempted to monopolize the market for advertising directories in certain parts of Florida, in violation of Section 2 of the Sherman Act, 15 U.S.C. § 2, and Florida Statutes, § 542.19. After full and complete discovery, the voluminous record is replete with exhibits and depositions. The issues have been extensively briefed and are ripe for disposition.

II. FACTS AND PROCEDURAL POSTURE

In accordance with the "Plan of Reorganization and Divestiture" approved on August 5, 1983, by the United States District Court for the District of Columbia, American Telephone & Telegraph Company ("AT & T") was divided into seven regional companies. BellSouth is one of the seven regional companies and is the holding company for the stock of Southern Bell. Following the divestiture of AT & T, BellSouth created BAPCO as a wholly-owned subsidiary for the purpose of preparing, publishing and distributing telephone directories. *See generally Western Union Tel. Co. v. F.C.C.*, 815 F.2d 1495 (D.C.Cir. 1987); *GTE Service Corp. v. F.C.C.*, 782 F.2d 263 (D.C.Cir.1986).

On December 30, 1983, BellSouth Advertising and Publishing Corporation ("BAPCO")[1] and Southern Bell entered into an agreement by which Southern Bell granted to BAPCO the sole right to publish a classified advertising directory for the greater Miami, Florida area.[2] Pursuant to this agreement, BAPCO published and distributed a classified advertising directory known as the "1984 Miami Yellow Pages".[3] Southern Bell provided BAPCO with listing data for all new, changed and disconnected telephone subscribers, along with data for each foreign listing.[4] Additionally, BAPCO owns a valid copyright in the 1984 Greater Miami classified telephone directory.[5]

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[1] BAPCO is a corporation organized and existing under the laws of the State of Georgia, having its principal place of business at Atlanta, Georgia.

[2] Under the terms of the agreement between BAPCO and Southern Bell, BAPCO is engaged in "creating, compiling, publishing and distributing telephone directories and classified directories in the State of Florida, particularly the Greater Miami area." Amended Complaint, page 3.

[3] The directories were distributed in the following format:
(a) Greater Miami 1984-85 Yellow Pages—Vol. A-L
(b) Greater Miami 1984-85 Yellow Pages—Vol. M-Z.

[4] As per the terms of the agreement, Southern Bell provides BAPCO with information concerning its subscribers. Southern Bell obtains information from a new business telephone subscriber, which includes: (a) name; (b) name of business; (c) place of business; (d) directory address; (e) billing address; (f) desired type of phone equipment; (g) quantity of telephone books desired; (h) information about the number of jacks on the premises to facilitate installation; (i) number of business lines desired; (j) credit information; (k) remote call forwarding information; (l) long distance carrier desired; and (m) desired "Yellow Pages" heading. Mitchell Affidavit, para. 5.

[5] BAPCO published the 1984 Miami Yellow Pages with an appropriate copyright notice therein and otherwise complied in all respects with the applicable copyright laws. On October 10, 1984, BAPCO obtained, through deposit and registration of the works, federal registration of the copyright for the 1984 Miami Yellow Pages and has received from the Register a Copyright Certificate of Registration Nos. TX 1-425-775 and TX 1-425-783.

Following publication of the 1984 Miami Yellow Pages, Donnelley began the promotion and sale of classified advertising in a competitive classified directory for the Greater Miami area (hereinafter the "Donnelley Directory"). On August 23, 1984, Mr. William Bak, then Executive Vice President of Reuben H. Donnelley Corporation,[6] wrote to BAPCO requesting information about how Donnelley could obtain "listings" in connection with its own directory activities. Exhibit B to Mitchell Affidavit.

Following those discussions, Southern Bell entered into four business agreements with Donnelley for the publication and distribution of a competing classified advertising directory in the Miami area through which Southern Bell provided Donnelley with the name, address, and telephone number of its relevant business subscribers. This information is the same non-confidential business subscription information that Southern Bell provides to all similarly situated independent publishers.[7]

On October 2, 1985, BAPCO filed suit against Donnelley alleging three causes of action: (1) infringements of BAPCO's copyrights in the 1984 Miami Yellow Pages; (2) trademark infringement; and (3) unfair competition.[8] BAPCO moved for a preliminary injunction on

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[6] Mr. Bak is currently the president of Donnelley.

[7] There are fifty-seven (57) such license agreements now in effect.

[8] Donnelley did not request from Southern Bell any additional information until *after* BAPCO filed its Complaint, Born Affidavit, paras. 71-20, whereupon Donnelley sent a letter to Southern Bell on November 8, 1985, demanding comprehensive access to numerous catagories of information never before requested. Exhibit E to Born Affidavit. Donnelley's letter demanded the identical access to Southern Bell's subscriber information, both in form and content, that Southern Bell provided to BAPCO. The letter asserted that such identical access was "essential" for Donnelley to publish a classified directory. Donnelley also demanded on-line computer access to Southern Bell's subscriber data bases.

the copyright count, requesting that distribution of the Donnelley directories be prohibited. An evidentiary hearing was held in which substantial evidence was introduced. Donnelley neither disputed the validity of BAPCO's copyright registration for the 1984 Miami Yellow Pages nor denied obtaining listings and advertisements from the 1984 Yellow Pages in the preparation and publication of Donnelley's Miami North and Miami South classified telephone directories.

Donnelley's defense was essentially threefold: First, Donnelley alleged that BAPCO had purposely delayed filing the case until the eve of publication and, therefore, the alleged injury was not irreparable; second, Donnelley alleged unclean hands and antitrust violations by BAPCO, Southern Bell, and BellSouth; and third, the copyright laws did not prevent Donnelley from obtaining the listings and advertisements from BAPCO's copyrighted telephone directories.

The Court agreed with Donnelley's argument that "BAPCO's delay of over seven months in seeking injunctive relief [was] in conflict with its allegations of an urgent need to prevent irreparable injury."[9] Accordingly, BAPCO failed to meet its burden of persuasion that it would suffer irreparable injury sufficient to warrant the granting of an injunction.[10]

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[9] Order, dated October 31, 1985, page 6. As stated by the Court:

> During the course of the preliminary injunctive hearing, BAPCO failed to introduce any competent evidence to meet the "irreparable injury" prerequisite. BAPCO's references to irreparable harm were limited to argument of counsel. Conversely, the harm to Donnelley is real and imminent. Donnelley has invested literally millions of dollars and thousands of personnel-hours in its directory. Donnelley's very business reputation is at stake if the directory is not published the week of November 4, 1985.

[10] The Court, *sua sponte*, stayed execution of its Order denying preliminary injunctive relief for one (1) week in order to permit BAPCO an opportunity to perfect an appeal to the Eleventh Cir-

Before Donnelley answered the original complaint, BAPCO amended its complaint, expanding the allegations of copyright infringement to include all BAPCO copyrighted classified telephone directories from which Donnelley had obtained listings and advertisements.[11] The amended complaint was filed November 7, 1985. Donnelley answered, naming BAPCO, Southern Bell, and BellSouth, as Counterdefendants and alleged: (1) unlawful monopolization; (2) unlawful attempt to monopolize; and (3) invalid trademark registrations.[12]

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cuit. BAPCO filed its Notice of Appeal on October 31, 1985. On November 15, 1985, BAPCO moved to dismiss the appeal pursuant to Rule 42(b) of the Federal Rules for Appellate Procedure, which was entered by the Clerk of Court on November 25, 1985.

[11] According to the Amended Complaint, Donnelley used the 1984 Miami Yellow Pages in violation of the copyright laws of the United States in the preparation of the Donnelley Directory and in the preparation of materials for use in the solicitation of advertisements for the Donnelley Directory. Specifically, BAPCO alleges that Donnelley, without permission "made or required, at least one complete, unauthorized copy of the 1984 Miami Yellow Pages which was made by copying the work, or substantial portions thereof, into a computer data base so that said copy is in machine-readable form in collatable machine memory and/or recorded on magnetic media." Amended Complaint, page 9. Further, BAPCO alleges that "Donnelley unlawfully used said machine-readable copy of the 1984 Miami Yellow Pages, and/or hard copies thereof, in whole or in part, to contact the listed businesses and advertisers in the BAPCO 1984 Miami Yellow Pages and request that they place the same or substantially similar listings and advertisements in the Donnelley Directory. Specifically, . . . Donnelley used said machine-readable copy of the 1984 Miami Yellow Pages to generate sales lead sheets." *Id.* Finally, BAPCO alleges that Donnelley's use of the phrase "Yellow Pages" and the "Walking Fingers" logo is misleading to the public and violates BAPCO's registered trademarks.

[12] According to Donnelley's allegations, BAPCO, Southern Bell, and BellSouth have deliberately acquired and unlawfully maintained market power in the classified directory market by using their market power to exclude Donnelley and other potential competitors from the monopolized market in violation of federal and state

Following extensive discovery, the parties submitted voluminous motions for summary judgment—to wit:

(1) Donnelley moved for Summary Judgment on BAPCO's copyright claims.

(2) Donnelley moved for partial Summary Judgment on BAPCO's trademark claims;

(3) Donnelley moved for Summary Judgment seeking to cancel registration of the "Walking Fingers" logo;

(4) BAPCO moved for Summary Judgment on the copyright claims.

(5) BAPCO, BellSouth, and Southern Bell moved for Summary Judgment on Donnelley's antitrust counterclaims and defenses.

Oral argument was originally conducted on Friday, October 3, 1986. At the close of argument, the Court inquired as to whether discovery was complete. The parties indicated that "key" discovery needed to be taken. In view of these representations at oral argument, the Court allowed additional discovery. The parties were also granted leave to file supplemental memoranda and exhibits relating to their respective motions. In order to assist the Court in concluding this matter, the parties reargued their respective motions on May 22, 1987. Each motion as it relates to a substantive area of the law will be addressed independently.

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antitrust laws. Specifically, Donnelley alleges that "the license agreement offered by Southern Bell is a refusal to provide information known by it to be essential to the sale of advertising, compilation, publication and distribution of a fully competitive classified advertising directory." Answer, page 20.

Additionally, Donnelley asserts that the Counter-defendants and/or their predecessor-in-interest, AT & T, have abandoned the "Walking Fingers" logo, which has ceased to function as a trademark. Answer, page 26.

III. LEGAL DISCUSSION

A. COPYRIGHT

BAPCO moves for summary judgment [13] on count one of the amended complaint, arguing that Donnelley violated the copyright laws by reproducing the 1984 Miami Yellow Pages. As direct evidence of copying, BAPCO submits that Donnelley's own admissions, as well as the testimony of Donnelley's own employees, clearly establish that Donnelley actually copied name, address, telephone number and classified heading from the 1984 Miami Yellow Pages on to sales lead sheets and then into the Donnelley directories. As indirect evidence of mass copying, BAPCO argues that the 1984 Miami Yellow Pages were easily accessable to Donnelley, there being over 1,100,000 copies in circulation. Additionally, BAPCO asserts that the Donnelley sales lead sheets and the Donnelley directories are substantially similar to the 1984 Yellow Pages, relying mainly on the presence of "common errors" between the two publications.

In its Cross-Motion for Summary Judgment and Opposition to BAPCO's Motion for Summary Judgment, Donnelley's principal argument is that the names, addresses, and telephone numbers as they appear under yellow page headings in BAPCO's classified directories are not copyrightable subject matter. "Donnelley bases its claim of non-infringement on the contention that the particular material it has copied, because of both its nature and origin, is not protected by BAPCO's copyright." Concise Statement of Donnelley Information

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[13] Summary Judgment has specifically been found to be appropriate for deciding issues of copyright infringement. *Ferguson v. National Broadcasting Co., Inc.*, 584 F.2d 111, 200 U.S.P.Q. 65 (5th Cir.1978); *Chess Music, Inc., v. Tadych*, 467 F.Supp. 819, 204 U.S.P.Q. 516, 518 (E.D.Wis.1979); *see also Midway Mfg. Co. v. Bandai-American, Inc.*, 546 F.Supp. 125, 216 U.S.P.Q. 812, 822 (D.N.J.1982); *Knickerbocker Toy Co., Inc. v. Genie Toys, Inc.*, 491 F.Supp. 526, 211 U.S.P.Q. 461 (E.D.Mo.1980).

Publishing, Inc., Pursuant to Order of April 3, 1987, page 4.

To prevail on a claim of copyright infringement, a copyright owner must establish ownership of a valid copyright in the work and copying of that work by the defendant. *Donald Frederick, Evans and Assoc., Inc. v. Continental Homes, Inc.*, 785 F.2d 897, 903 (11th Cir. 1986); *Southern Bell Tel. & Tel. v. Assoc. Tel. Directory Publishers*, 756 F.2d 801, 810 (11th Cir.1985) (citing *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821 (11th Cir.1982); *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365 (5th Cir.1981)). Further, the "mere use of information contained in a directory without a substantial copying of the format does not constitute infringement." *Miller*, 650 F.2d at 1369-70; *New York Times Co. v. Roxbury Interface, Inc.*, 434 F.Supp. 217 (D.N.J.1977). Thus, there are three elements that must be established in order to show copyright infringement. These elements include:

(i) ownership of a valid copyright due to creation of an original work of authorship;

(ii) defendant's copying from plaintiff's work; and

(iii) the defendant's copying of enough protected expression to constitute an unlawful appropriation, i.e., a substantial and material taking.

When there is substantial copying, the alleged infringer may raise the issue of fair use, which is a defense in which various factors are balanced to determine if the defense is justified. *Assoc. Tel. Directory*, 756 F.2d at 810.

1. *Ownership of a Valid Copyright*

Directories such as the 1984 Miami Yellow Pages at issue in this case may receive copyright protection as "literary works" under 17 U.S.C. § 101 (1977). *Assoc. Tel Directory*, 756 F.2d at 809. *Southwestern Bell*

Media, Inc. v. Trans Western Publishing, Inc., 670 F. Supp. 899 (D.Kan.1987) (citing *Hutchinson Telephone Co. v. Frontier Directory Co.*, 770 F.2d 128 (8th Cir. 1985)); *Rural Tel. Service Co. v. Feist Publications, Inc.*, 663 F.Supp. 214, 218 (D.Kan.1987). This is true despite the fundamental principle of copyright law that facts cannot be copyrighted. *See* 17 U.S.C. § 102(b); *Miller*, 650 F.2d at 1368-69. Directories are also "compilations," which are defined as follows:

> A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. 17 U.S.C. § 101.

Thus, it has been held that,

> a telephone directory compilation whose components are comprised exclusively of information in the public domain can be protected by the copyright laws only as to the selection and arrangement of the compilation, the work as a whole, and not as to the preexisting information.

Assoc. Tel. Directory, 756 F.2d at 810. Directories in particular are afforded special protection as to the selection and arrangement of factual material notwithstanding the difficulty in reconciling this position with the principle that facts are not copyrightable. *See Miller*, 650 F.2d at 1370.

BAPCO published the 1984 Miami Yellow Pages with the appropriate copyright notice on each page. Furthermore, BAPCO filed for and received from the Registrar of Copyrights Certificates of Copyright Registration Nos. TX 1-425-775 and TX 1-425-783 for the 1984 Miami Yellow Pages. *See infra* note 5. Moreover, Donnelley does not contest the validity of BAPCO's copyrights of its classified telephone directories. In response to

BAPCO's Second Set of Interrogatories, Donnelley stated that it "does not contend that BAPCO's compilation copyright in the 1984 Miami Yellow Pages is invalid." Answer to Interrogatory No. 20, page 10.

The gravamen of Donnelley's argument of non-infringement is that the particular material it has copied, because of both its nature and its origin, is not protected by BAPCO's copyright. Concise Statement of Donnelley, pursuant to Order of April 3, 1987, page 4. Donnelley's fundamental claim, therefore, is that BAPCO did not select, coordinate or arrange the collection of facts to the extent that the directory became an original work of authorship. Although Donnelley's claim is well briefed, it does not apply to the facts of this case and fails to adequately distinguish case law binding on this Court.

This case is controlled to a large extent by *Southern Bell Telephone & Telegraph Co. v. Associated Telephone Directory Publishers,* 756 F.2d 801 (11th Cir.1985). In that case the court held that Southern Bell owned a valid copyright in the 1982 Atlanta Yellow Pages and enjoined the defendants from using photocopies of that compilation. The 1984 Miami Yellow Pages were compiled in an identical manner as the 1982 Atlanta Yellow Pages.[14] Second Affidavit of Bob Johnson at p. 1. Donnelley has not shown any facts which contradict this holding. Thus, the opinion by the Eleventh Circuit in *Assoc. Tel. Directory* that the 1982 Atlanta Yellow Pages were validly

[14] The court finds no material difference in the photocopying which took place in *Assoc. Tel. Directory* and the copying resulting from the input into a computer of every name, address, telephone number and associated classified heading for every listing in BAPCO's directory. Donnelley prepared sales lead sheets and its directories from these computer tapes. Although keying information into a computer and printing it out may not appear as egregious as photocopying, BAPCO's copied listings and headings still make up a substantial majority of Donnelley's directories. There is no meaningful distinction between photocopying material and inputing material into a computer before printing it out.

copyrighted is extremely persuasive authority that the 1984 Miami Yellow Pages are also validly copyrighted.

Both parties have submitted a multitude of authority regarding the legal standards by which compilations are to be measured under Section 101 of the Copyright Laws. Some courts have applied a "sweat of the brow" test to determine whether a particular compilation is copyrightable.[15] Under this test the factual compilations of a copyright owner are protected in that a subsequent compiler of such facts must do his own independent research and expend his own labor and effort. Other courts apply a "selection, coordination or arrangement" test in assessing copyrightability.[16] Although the underlying facts are unprotectable under this test, the compilation as a whole is protected as to the selection and arrangement of such facts. Although the Court prefers the "selection, coordination or arrangement" test, it is not clear which test the Eleventh Circuit adopted in *Assoc. Tel. Directory*.[17] It is clear, however, that BAPCO's directory meets both tests.[18]

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[15] Cases applying the "sweat of the brow" test include: *Hutchinson Telephone Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir.1985); *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir.1977).

[16] Cases applying the "selection, coordination or arrangement" test include: *Financial Information, Inc. v. Moody's Investors Service, Inc.*, 751 F.2d 501 (2d Cir.1984); *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir.1984).

[17] The Court stated:

> Our inquiry here does not require that we choose between a limited or more expansive standard of originality under the Act. It is enough that originality is to be tested by the nature of the selection and arrangement of the preexisting material in the compilation.

Assoc. Tel. Directory, 756 F.2d at 809 n. 9. But, without adopting a test, the Court concluded that the 1982 Atlanta Yellow Pages met the more vigorous "selection, coordination or arrangement" test.

[18] BAPCO and its affiliations have expended great efforts in collecting, assembling, compiling and publishing its directors. *See*

BAPCO collects and assembles preexisting material in the form of names, addresses, telephone numbers and classified headings. The process begins when Southern Bell sends BAPCO the name, address, telephone number (and sometimes a free listing classification) from business telephone subscribers when they obtain service from Southern Bell. BAPCO receives this information randomly and not sorted by geographical area, area code or telephone exchange. BAPCO then performs various acts of selection, coordination and arrangement of this information, which lead to the final organized Yellow Pages.

BAPCO performs various acts of selection which contribute to the publication of the directory. These acts include selection of the geographical area to be covered by a directory; selection of the number of free listings to be provided; selection of the requirement that businesses use business telephone service in order to advertise in the BAPCO directory; selection by the sales force of the headings which will be recommended to a customer; selection of the classified headings which will be available for a particular directory; selection of the headings under which an advertiser's listing will appear; selection of the criteria under which advertisers may or may not be permitted to advertise under headings not related to their business; selection of the number of free listings to be provided telephone subscribers; selection of customers who will be contacted by premise sales personnel, telephone sales personnel and no contact; selection of the date of commencement of a sales campaign; and selection of the date of closing the directory. *See* Second Affidavit of Bob Johnson.

BAPCO also engages in acts of coordination and arrangement which aid to the Yellow Pages publication.

Affidavit of Bob John; Second Affidavit of Bob Johnson. Donnelley does not claim to have used its own efforts in compiling the material published in its directory. There is no doubt, therefore, that BAPCO has met the "sweat of the brow" test.

BAPCO coordinated the headings. In addition, BAPCO arranged these headings, along with all of the listings under a particular heading, in alphabetical order. BAPCO chose to coordinate and arrange its directory in this manner from other alternatives. For example, BAPCO could have chosen to arrange its headings according to the numbers of advertisers or to arrange its listings under headings according to which listing had been advertising under that heading for the longest period of time.

Donnelley does not dispute that BAPCO performs these acts. The dispute centers only on the legal effect of such acts. All of BAPCO's acts contribute to the publication process and are identical to those carried out in aiding the publication of the 1982 Atlanta Yellow Pages. Because the opinion in *Assoc. Tel. Directory* held the Atlanta Yellow Pages to be validly copyrighted and because BAPCO has created a unique directory due to its method of selecting, coordinating and arranging its material, the Court concludes that BAPCO's compilation is an original work of authorship which is subject to a valid copyright.[19]

2. *Defendant's Copying From Plaintiff's Work*

This element of copyright infringement may be shown directly by an admission of copying by the defendant, or indirectly by proving access to the directory and substantial similarity between the plaintiff's and defendant's work. *Rural Tel. Ser. Co. Inc. v. Feist Publications, Inc.*, 663 F.Supp. 214 (D.Kan.1987); *Central Tel. Co. of Virginia v. Johnson Publishing Co.*, 526 F.Supp. 838, 843 (D. Colo.1981). It is well-settled that one of the most significant evidences of copying is the existence of common errors between the two directories. *Rural Telephone*, 663 F.Supp. at 218. *See also Fin. Information, Inc. v. Moody's In-*

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[19] Although not dispositive of the issues here we note parenthetically that Donnelley's acts of copying would have violated Donnelley's copyright notification in its own copyrighted directories. Deposition of Ernest J. Martin at 407, 410-11, 435.

vestors Serv., Inc., 599 F.Supp. 994, 996 n. 3 (S.D.N.Y. 1984); *Central Tel. Co.*, 526 F.Supp at 844.

There does not appear to be any dispute that Donnelley copied from BAPCO's copyrighted directory. Donnelley has never disputed "that it has copied material from BAPCO's directories." Concise Statement of Donnelley, Pursuant to Order of April 3, 1987, p. 4. This concession is buttressed by substantial facts of copying in the record.

Donnelley obtained copies of the 1984 Miami Yellow Pages and coded these pages for copying.[20] The coded pages were then sent to Appalachian Computer Services, Inc. ("Appalachian"), a data entry company located in London, Kentucky.[21] Appalachian reproduced in machine (computer) readable form every paid listing and every advertisement in the 1984 Miami Yellow Pages by "keying" (reproducing) into a computer data base the following information: name, address, telephone numbers, the code corresponding to the classified heading, a code corresponding to the unit of advertising and a code for the directory from which it came. This information was stored on magnetic tape and sent to Donnelley.

Donnelley then edited, compiled and organized the information on the magnetic tape, adding heading codes that

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[20] Copies of the 1984 Miami Yellow Pages were cut apart and each sheet was individually mounted on a stiffer backing sheet for ease of handling. Each mounted sheet was then coded in red ink by Donnelley personnel. This coding procedure involved marking each classified heading with a corresponding code and an advertising code.

[21] Appalachian specialized in converting data from paper or hard copy form to a computer or machine readable form by typing or "keying" data from the 1984 Miami Yellow Pages which appears on the paper into a computer terminal which then stores that computer data in magnetic form in a storage media, such as magnetic tape. *See* Appalachian Deposition, pages 10-17.

corresponded to the BAPCO classified heading. Upon completing this process, Donnelley had recorded on magnetic tape the name, address, telephone numbers, classified heading, unit of advertising and directory source from every paid listing and every advertisement in the 1984 Miami Yellow Pages. From this computer data base, Donnelley printed sales lead sheets, containing telephone numbers for every paid listing and advertisement in the 1984 Miami Yellow Pages. Collectively, the sales lead sheets constitute a reproduction of substantially the entire 1984 Miami Yellow Pages in inverted or criss-cross form. All of this information from the 1984 Miami Yellow Pages and/or sales lead sheets was then copied into the Donnelley directories and distributed in the Miami Area. A comparison of the two (2) directories reveals that Donnelley used a format nearly identical to that used by BAPCO. *See* Exhibit P and P Enlarged to BAPCO's brief.

Further evidence of copying by Donnelley is the presence of "common errors." [22] There are as many as thirty-seven (37) erroneous listings in the Donnelley directories which are identical to those in the 1984 Miami Yellow Pages.[23] Donnelley has offered no evidence to refute the

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[22] *See Rural Telephone*, 663 F.Supp. at 218; *Fin. Information*, 599 F.Supp. at 996 n. 3; *Central Tel. Co.*, 526 F.Supp. at 844.

[23] Illustrative examples of erroneous listings appearing in both the 1984 Miami Yellow Pages and the Donnelley Miami Directories are the following:

(1) On page 373 of the 1984 Miami Yellow Pages, "Fort Lauderdale News" is listed, erroneously, under the heading "Balancing Equipment". This identical listing for "Fort Lauderdale News" also appears under the heading "Balancing Equipment" in the Donnelley Miami North Directory at page 132. Copies of the pages from the 1984 Miami Yellow Pages and the Donnelley Miami Directories are attached to the second Affidavit of Barbara J. Wiggs as Exhibits 4 and 6 respectively with the subject listings highlighted in green. This entire listing is incorrect in both directories. Obviously the Fort Lauderdale News should not be listed under "Balancing

fact that it copied BAPCO's directory. Accordingly, the Court gleans from the record, three acts of copying. These include keying the information into the computer, preparing the sales lead sheets and publishing the Donnelley directories.

3. *Substantial Copying of Plaintiffs Work by Defendant*

As mentioned above, Donnelley does not contest that it copied every name, address, telephone number and classified heading from BAPCO's directories. Certainly the wholesale copying of every word in BAPCO's directory constitutes substantial copying. In addition, it does not matter that Donnelley did not produce an exact duplicate of BAPCO's directories. For example, in *Southwestern Bell Media v. Transwestern Publishing, Inc.*, 670 F.Supp. 899, 905 (D.Kansas 1987) the Court concluded that Transwestern infringed Bell Media's copyright despite noting that:

> In most of the prior federal court decisions dealing with copyright infringement in the area of telephone directories, the guilty party simply photocopied the existing directory or produced an identical listing of white pages, which is a much clearer case of copyright infringement. In the present case, Trans Western did not produce an exact, or even nearly exact,

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Equipment", a heading which is related to the balancing of automobile tires.

On page 1433 of the 1984 Miami Yellow Pages "Flash Courier Systems" is listed even though the subscriber's telephone was disconnected before January 1, 1984. This identical listing appears in the Donnelley Miami North directory at page 466. Copies of the pages from the 1984 Miami Yellow Pages and the Donnelley Miami North directory are attached to the Second Affidavit of Barbara J. Wiggs as Exhibits 37 and 39 respectively with the subject listing highlighted in green. The entire listing is incorrect in both directories. Furthermore, the listing was a "free listing" in the 1984 Miami Yellow Pages.

> copy of the Bell Media book. In a nutshell, Trans Media took essentially the same information contained in Bell Media's Yellow Pages and put it in a slightly different format.

Similarly, although Donnelley's directory is not identical to BAPCO's directory, the material was copied and used to produce a directory substantially similar in both content and format. *See* Affidavit of Barbara Wiggs; Testimony of Gerald Brown on Oct. 10, 1985. The Court easily concludes that such conduct constitutes substantial copying.[24]

4. *Fair Use Defense*

Donnelley argues that even if its copying constitutes copyright infringement, Donnelley's actions should be excused under the doctrine of "fair use." At the minimum, Donnelley claims that summary judgment is improper because of the existence of numerous material issues of fact raised by the fair use defense.

The fair use defense is a narrow exception to the Copyright Act which permits the use of copyrighted material under certain circumstances without the owner's consent. Fair use is an equitable rule of reason which must be decided on a case-by-case basis. *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 448, 104 S.Ct. 774, 792, 78 L.Ed.2d 574 (1984). *See also Harper & Row Publishers Inc. v. Nation Enterprises,* 471 U.S. 539, 105 S.Ct. 2218, 85 L.Ed.2d 588 (1985). Fair use presents a mixed question of law and fact. *Harper & Row,* 471 U.S. at 560, 105 S.Ct. at 2230; *Pacific & Southern Co. v. Duncan,* 744 F.2d 1490, 1495, n. 8 (11th Cir.1984). The burden of proving this defense is on Donnelley, the party asserting it. *Assoc. of Amer. Medical Colleges v. Mikaelian,* 571 F.Supp. 144, 151 (E.D.Pa.1983).

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[24] The substantiality of the copying is also an important factor to be analyzed in the fair use defense.

The fair use doctrine was judicially created and then codified by the Copyright Act at 17 U.S.C. § 107 (1977). The Act's preamble lists certain uses of copyrighted material that constitute fair use. These include using copyrighted material "for purposes such as criticism, comment, news reporting, teaching, scholarship [and] research." The Copyright Act then lists four factors which should be considered in evaluating whether a particular use is fair. These are:

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit education purposes;

(2) the nature of the copyrighted work;

(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

(4) the effect of the use upon the potential market for or value of the copyrighted work.

These factors are important but are not meant to be exclusive. *Harper & Row,* 471 U.S. at 560, 105 S.Ct. at 2230. An analysis of each of these factors and the equities of the case demonstrates that Donnelley's copying of BAPCO's copyrighted material does not constitute a fair use.

a. The Purpose of the Use

It is undisputed that Donnelley's motives in copying the 1984 Miami Yellow Pages were of a purely commercial and for-profit nature. Thus, Donnelley's copying clearly does not fall under any of the listed excusable uses in the preamble to Section 107. Justice Stevens stated that such pure "commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright." *Sony Corp.,* 464 U.S. at 451, 104 S.Ct. at 793. *See also Pacific & Southern Co., Inc. v. Duncan,* 792 F.2d 1013

(11th Cir.1986). Although such commercial use standing along may not be enough to deprive one of the fair use defense, *see Meeropol v. Nizer,* 560 F.2d 1061, 1069 (2d Cir.1977), *cert. denied,* 434 U.S. 1013, 98 S.Ct. 727, 54 L.Ed.2d 756 (1978), Donnelley's copying for profit strongly militates against the applicability of the fair use defense.

b. Nature of the Copyrighted Work

As Justice O'Connor explained in *Harper & Row,* "[t]he law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy." 471 U.S. at 560, 105 S.Ct. at 2230. Although "the opportunity to use the fair use defense for copying research is broad, the opportunity to use that defense is narrow once the research is selected and arranged into a compilation and is copied." *Assoc. Tel. Directory,* 756 F.2d at 810-11. Thus, because BAPCO has selected, coordinated and arranged the facts into a compilation, Donnelley's fair use defense is now narrow.

c. The Amount and Substantiality of the Copying

Donnelley does not contend that the extent of its copying of name, address, telephone numbers and associated classified headings from BAPCO's classified directories is insubstantial or immaterial. In fact, as previously stated, Donnelley has admitted to copying into its computer every listing in BAPCO's directory. Such wholesale copying is strong evidence against the fair use defense. *Sony Corp.,* 464 U.S. at 450, 104 S.Ct. at 792. *See also infra,* subsection three (3) on substantial copying.

d. The Market Impact

The effect of the use of the copyrighted material on the potential market is perhaps the most significant factor of fair use. *Harper & Row,* 471 U.S. at 566, 105 S.Ct. at 2233. When the use is for commercial purposes, harm

to the potential market for the copyrighted work is presumed. *Id.* at 562, 105 S.Ct. at 2231. *Sony Corp.*, 464 U.S. at 451, 104 S.Ct. at 793. In addition, BAPCO has presented evidence that it is suffering harm to the good will and trust that BAPCO's advertisers have in BAPCO's directories because Donnelley has reproduced its errors, thereby perpetuating such errors a second year. Donnelley has not rebutted the presumption of harm in the market or the above described harm and, therefore, it has failed to satisfy the fourth statutory factor.

e. Other Factors

Donnelley alleges that "keying" (obtaining a copy of the local directory and placing the business listing information of name, address, telephone numbers, and business classification from that directory into a computer base) is a standard industry practice among competitive directory publishers. Donnelley contends that such practice is germane to the fair use defense. This argument is logically and legally insufficient. Such practice is not relevant to the fair use defense.

Donnelley's claim is analogous to that of a driver stopped for speeding. The driver may claim that everybody drives over fifty-five and that it is unfair to stop only him. Just as widespread abuse of speed limits is irrelevant to the crime of speeding, industrial piracy of directories, even if widespread, should not be probative of whether such piracy is a fair use.

The law supports this result. In *Meeropol v. Nizer*, 417 F.Supp. 1201, 1210 (S.D.N.Y.1976), *reversed on other grounds*, 560 F.2d 1061 (2d Cir.1977), *cert. denied*, 434 U.S. 1013, 98 S.Ct. 727, 54 L.Ed.2d 756, 196 U.S.P.Q. 592 (1978), the court stated that:

> The alleged standard rule in the publishing industry in the United States that more than 300 words of a copyrighted work does not qualify as a fair use, is

> not dispositive of a fair use question. Fair use is a legal question to be determined by the court not by alleged industry practice.

While the Second Circuit reversed because genuine issues of fact precluded summary judgment, this does not diminish the effectiveness of the lower court's pronouncement on the irrelevance of industry practice to the fair use defense.

Similarly, in *Maxtone-Graham v. Burtchaell,* 631 F. Supp. 1432, 1436 (S.D.N.Y.1986), *aff'd on other grounds,* 803 F.2d 1253 (2d Cir.1986), the court stated that:

> [T]he doctrine of fair use is a legal doctrine having Constitutional implications, it cannot be subject to definition or restriction as a result of any such trade custom or practice, no matter how long continued. Accordingly, even if such a custom were shown to exist industry wide, and it has not been, it could have no legal force.[25]

Based on this authority and the inherent weakness of Donnelley's position, the Court concludes that industrial piracy in directory compilations is irrelevant to the consideration of the fair use defense.

In determining whether Donnelley's copying constitutes fair use, the Court must engage in a balancing of all of the statutory factors, plus the other factors enumerated and raised by the parties. Upon careful application of the record and in light of the applicable authorities, *see, e.g., Southwestern Bell Media, Inc. v. Trans Western Publishing, Inc.,* 670 F.Supp. 899 at 905 (D.Kansas

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[25] *See also Leo Feist, Inc. v. Appollo Records N.Y. Corp.,* 300 F.Supp. 32 (S.D.N.Y.1969), *aff'd,* 418 F.2d 1249 (2d Cir.1970), *cert. denied,* 398 U.S. 904, 90 S.Ct. 1694, 26 L.Ed.2d 63 (1970); *Famous Music Corp. v. Seeco Records, Inc.,* 201 F.Supp. 560 (S.D.N.Y.1961); *Southern Music Publishing Co., Inc. v. Seeco Records, Inc.,* 200 F.Supp. 704 (S.D.N.Y.1960).

1987) (citing *Assoc. Tel. Directory*, 756 F.2d at 810-11), the Court concludes that Donnelley has not met the fair use defense.

5. *Anti-Trust Defense*

In addition to asserting a counter claim against BAPCO for antitrust violations, Donnelley asserts antitrust violations as an affirmative defense to BAPCO's Motion for Summary Judgment on the copyright claim. In essence, Donnelley alleges that BAPCO has driven Donnelley out of the directory business in Southern Florida and violated the antitrust laws by refusing to give Donnelley reasonable and timely access to the information necessary to compete in the directory publishing business. Antitrust violations, however, cannot be a defense to BAPCO's copyright claims.

In order for an antitrust affirmative defense to bar enforcement of a Plaintiff's copyright, the alleged antitrust violation must involve the copyright holder's attempt to extend the exclusionary power granted by its copyright.[26] Courts have ruled uniformly that no valid defense to a copyright infringement claim exists even where it is demonstrated that the copyright owner is violating the antitrust laws,[27] except possibly where there is an attempt to

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[26] This does not mean that a defendant cannot obtain redress against a copyright holder for its violation of the antitrust laws. Affirmative relief against the copyright holder to prevent a continued or remedy a past antitrust violation can be obtained pursuant to a counterclaim.

[27] *See Orth-O-Vision, Inc. v. Home Box Office*, 474 F.Supp. 672, 686 (S.D.N.Y.1979); *Foreign Car Parts of New England, Inc. v. Auto World, Inc.*, 366 F.Supp. 977, 979 (M.D.Pa.1973) ("It is doubtful that an antitrust violation creates a defense in a copyright infringement action."); *United Artists Associated, Inc. v. N.W.L. Corp.*, 198 F.Supp. 953, 957 (S.D.N.Y.1961); *Harms, Inc. v. Sansom Home Enterprise, Inc.*, 162 F.Supp. 129, 135 (E.D.Pa. 1958), *aff'd sub nom, Leo Feist, Inc. v. Lew Tendler Tavern, Inc.*, 267 F.2d 494 (3d Cir.1959).

extend the exclusionary power granted by copyright beyond the protected work itself. This narrow exception is based upon *Morton Salt Co. v. G.S. Suppiger Co.,* 314 U.S. 488, 62 S.Ct. 402, 86 L.Ed. 363 (1942), where the Supreme Court refused to enforce a Morton Salt patent because Morton Salt had sought to and did extend the exclusionary power granted by its patent beyond the protected product by tying the sale of an unpatented product to a sale of a patented product. Courts have applied this vary narrow exception in copyright cases in similar instances, not present here, of illegal tying arrangements. *See M. Witmark & Sons v. Jensen,* 80 F.Supp. 843 (D. Minn.1984), *appeal dism'd sub nom.; M. Witmark & Sons v. Berger Amusement Co.,* 177 F.2d 515 (8th Cir.1949); *Broadcast Music, Inc. v. Moor-Law, Inc.,* 208 U.S.P.Q. 487 (D.Del.1978).

The extremely narrow scope of this exception was explained in *Orth-O-Vision, Inc. v. Home Box Office,* 474 F.Supp. 672 (S.D.N.Y.1979), where the court refused to apply this exception. There, Orth-O-Vision, a middleman for the sale of pay television subscriptions, sued HBO, the pay television transmitter, for antitrust violations alleging a conspiracy to limit plaintiff's ability to supply pay television. HBO counterclaimed for infringements of its copyright. The court noted that "as a general rule, it is no defense to a copyright infringement claim that the copyright owner is violating the antitrust laws." *Id.* at 686. The court then went on to explain that, if there were an exception to this rule, such defense must involve an extension of monopoly power conferred by the copyright:

> The Supreme Court has since recognized that copyright owners may sometimes enjoy analogous market dominance over their copyrighted articles enabling them to exert anti-competitive pressure in non-copyrighted articles, *United States v. Loew's Inc.,* 371 U.S. 38, 45, 83 S.Ct. 97, 9 L.Ed.2d 11 (1962), but has not expressly held that a court of

> equity ought to decline to enjoin infringement where the copyright owner is engaged in such anti-competitive activity. Even if the rationale of Mercoid and Morton Salt were extended to copyrights, Orth-O-Vision has failed to establish its antitrust defense because there is simply no nexus between HBO's alleged anti-competitive actions and its power over copyrighted material. Unlike the patentees in Mercoid and Morton Salt, HBO is not alleged to have used its legal monopoly over the copyrighted material to exert anti-competitive power over non-copyrighted material or to have otherwise used its copyrights to extend legal monopolies beyond their proper scope.

474 F.Supp. at 686. *See Rural Tel. Serv. Co. v. Feist Publications, Inc.*, 663 F.Supp. 214, 220 (D.Kan.1987) (summary judgment granted plaintiff on copyright infringement and anti-trust violations do not constitute defense to copyright infringement); *Knickerbocker Toy Co. v. Winterbrook Corp.*, 554 F.Supp. 1309, 1322 (D.N.H. 1982) (dismissed Section 2 counterclaim where "[t]he key link—the exclusionary power of the Knickerbocker copyright, is not alleged."); *Midway Mfg. Co. v. Artic Int'l., Inc.*, 211 U.S.P.Q. 1152, 1161 (N.D.Ill.1981) (alleged antitrust violation not an affirmative defense because it "does not relate directly to the claim of copyright infringement").

Based upon the foregoing authorities, if Donnelley's antitrust affirmative defense could bar enforcement of BAPCO's copyrights, Donnelley would have to show that BAPCO sought to extend the exclusionary power granted by its copyrights beyond the protection of the copyrighted directories. In its counterclaim and not in its affirmative defense, Donnelley alleges that counter-defendants violated the antitrust laws because Southern Bell failed to provide Donnelley with updated listing information received by Southern Bell from subscribers and

supplied to BAPCO. Donnelley further alleges in its counterclaim that BAPCO improperly failed to permit Donnelley to copy BAPCO's entire classified directory. Such claims do not allege that BAPCO has attempted to extend the exclusionary power granted by its copyrights beyond the protected work itself. Moreover, Donnelley has failed to make any claim or offer any evidence that BAPCO has used its copyrights to prevent Southern Bell from providing Donnelley with raw data supplied by Southern Bell to BAPCO. The Court concurs with prior case law in concluding that antitrust violations generally do not constitute a defense to copyright infringement. The Court further finds that Donnelley has not satisfied the narrow exception to this rule. Accordingly, Donnelley's affirmative defense of antitrust violations does not bar the entry of summary judgment for copyright infringement.

In sum, upon careful review of the record and applicable law, the Court concludes that no genuine issues of material fact exist; and, therefore, BAPCO's Motion for Summary Judgment on the copyright issues is GRANTED and Donnelley's Motion for Summary Judgment is DENIED.

B. TRADEMARK/UNFAIR COMPETITION

Donnelley moves for partial summary judgment on counts two[28] and four[29] of BAPCO's amended com-

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[28] Specifically, count two of BAPCO's amended complaint alleges as follows:

45.

On information and belief, by using the trademarks, words and symbols "Yellow Pages" and the "Walking Fingers" logo, and by unlawfully using BAPCO's copyrighted 1984 Miami Yellow Pages, and by telling customers that Donnelley has "published" Southern Bell's Yellow Pages classified directories, and by telling customers that Southern Bell will no longer publish a classified directory, Donnelley has used a false desig-

plaint, which assert that Donnelley's use of the term "yellow pages" and the "walking fingers" logo, among others, constitutes federal statutory and common law unfair competition respectively. In support of its motion, Donnelley argues that BAPCO can assert no exclusive right in either the term "yellow pages" or the three-finger "walking fingers" logo. In particular, Donnelley argues that the "walking fingers" logo is in the public domain because the symbol is used by the entire classified directory industry; thus, the symbol fails to "identify and distinguish" the mark owner's goods "from those manufactured by others and to indicate the source of the goods" as required by 15 U.S.C. § 1127. Donnelley further argues that BAPCO cannot claim exclusive rights in the term

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nation of origin and/or a false description or representation, of its goods and/or services and is therefore liable in a civil action by plaintiff under Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125.

[29] Similarly, count four of BAPCO's amended complaint alleges as follows:

51.

On information and belief, by using the trademarks, words and symbols "Yellow Pages" and the "Walking Fingers" logo, and by unlawfully using BAPCO's copyrighted 1984 Miami Yellow Pages, Donnelley has used a false designation or origin and/or a false description of representation of its goods and/or services to create a likelihood of confusion as to the source, sponsorship or affiliation, of Donnelley and Donnelley's directory and to pass off Donnelley as BAPCO or Southern Bell.

52.

On information and belief, by telling customers that Southern Bell is no longer going to publish a classified directory in the Greater Miami are, by telling customers that Donnelley has published Southern Bell's Yellow Pages classified directories in the past and by telling customers that Donnelley is now taking over the task of publishing the classified directory in the greater Miami area, Donnelley has attempted to pass itself off as BAPCO or Southern Bell and has committed fraud on the public all to BAPCO's damage.

"yellow pages" because the term is generic and thus not protectable under trademark law.[30]

BAPCO contends that summary judgment is improper as to counts two and four because a combination of Donnelley's actions, including among others the use of the term "yellow pages" and the "walking fingers" logo, constitute unfair competition. Although BAPCO admits that it does not claim exclusive rights to the term "yellow pages," BAPCO asserts that Donnelley has used the term and the logo to confuse the public through copyright and trademark infringement in violation of the laws prohibiting unfair competition.

Donnelley has also moved for summary judgment on count three of BAPCO's amended complaint for infringement of the registered two-finger "walking fingers" trademark and on its counterclaim to cancel BAPCO's registration for the two-finger "walking fingers" logo. Donnelley contends that BAPCO and its affiliates have abandoned the two-finger mark because it has not been used in the Bell South area since 1978-79.[31]

BAPCO admits that it did not use the two-finger logo from 1979 until 1985 and that its use in 1985 followed the initiation of this lawsuit. Although this constitutes *prima facie* evidence of abandonment, it may be overcome by evidence of an intent to resume use of the mark. *Humble*, 524 F.Supp. at 465. BAPCO submits that such intent is evidenced by BAPCO's continual use of the

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[30] *See, e.g., Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 114, 59 S.Ct. 109, 111, 83 L.Ed. 73 (1938); *Miller Brewing Co. v. G. Heilman Brewing Co.*, 561 F.2d 75, 79 (7th Cir.1977), *cert. denied*, 434 U.S. 1025, 98 S.Ct. 751, 54 L.Ed.2d 772 (1978); *CES Publishing Corp. v. St. Regis Publications, Inc.*, 531 F.2d 11, 13 (2d Cir.1975).

[31] *See Exxon Corp. v. Humble Exploration Co., Inc.*, 524 F.Supp. 450, 464-65 (N.D.Texas 1981), *aff'd*, 695 F.2d 96 (5th Cir.1983) (non-use of a mark for two consecutive years *prima facie* evidence of abandonment).

similar three-finger logo in conjunction with its use of the two-finger logo because each logo creates the same commercial impression.

A careful review of the record demonstrates that there are numerous genuine issues of material fact in dispute. As to count three of BAPCO's amended complaint and Donnelley's counterclaim to cancel registration of the two-finger "walking fingers" logo, genuine issues of fact exist as to the use of abandonment and BAPCO and its affiliates' intent to resume commercial use of the two-finger logo. As to counts two and four of BAPCO's amended complaint, issues of fact exist in light of BAPCO's "Directory and Symbol Study" [32] and BAPCO's "Symbol Study." [33] The first Symbol Study, which shows that the public to some extent recognizes the three-finger logo as a trademark indicating BAPCO or one of its affiliates, creates a factual issue as to whether the logo has been dedicated to the public. Similarly, the Directory Study and the second Symbol Study, which demonstrates that the public to some extent associates the identifying elements of the "yellow pages" term and the walking fingers logo as used in connection with a BAPCO directory,

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[32] Two separate surveys were conducted on the same day. In the Directory Study people were given a 1985-86 Donnelley Yellow Pages and then asked which company put out the directory. Over three times as many people thought the Donnelley directory was published by BAPCO as thought the directory was published by Donnelley. In the Symbol Study people were shown a naked replica of the three-finger "walking fingers" logo and asked which company uses the symbol. Roughly 59% of those surveyed thought the logo was a symbol identifying BAPCO or its affiliates and only 1% thought the symbol to identify Donnelley.

[33] In the Symbol Study the interviewer explained the difference between a brand name and a generic term to each respondent. Each respondent was then shown six symbols, including Mr. Peanut, Walking Fingers, RX, Skull & Crossbones, Morton's Salt Girl and a Barber Pole, and then asked whether or not the symbol is a brand of product. The survey yielded high percentages of 97, 94 and 74 respectively for Mr. Peanut, Morton's Salt Girl and Walking Fingers.

creates issues of fact as to the trademark significance of both the three-finger logo and the term "yellow pages."

The above described genuine issues of material fact preclude granting summary judgment as to the trademark issues.[34] Accordingly, Donnelley's Motions for Summary Judgment as to counts two, three and four of BAPCO's amended complaint and as to its counterclaim to cancel BAPCO's registration for the two-finger "walking fingers" logo are hereby DENIED.

C. ANTITRUST

In its amended answer Donnelley counterclaims against BellSouth, Southern Bell and BAPCO alleging that the three Bell companies together have violated federal and state antitrust laws. Counts one and two are for monopolization and attempted monopolization and allege violations of Section 2 of the Sherman Act (15 U.S.C. § 2). Count three alleges this same conduct is in violation of Florida Statutes Section 542.19. The gravamen of Donnelley contentions is that the Bell Companies have a monopoly in the market for the sale of advertising and have willfully maintained such monopoly power by not providing Donnelley with enough information, such as business classifications and updates, allegedly essential to compete in the directory business, in a timely fashion so as to enable Donnelley publish a competing directory.

All three of the Bell companies have moved individually for summary judgment against Donnelley on the antitrust counterclaims. Southern Bell generally contends that: (1) it does not have monopoly power in the relevant market, which is that of business information; (2) it has provided Donnelley with all the information necessary to compete and has not refused to deal with Don-

[34] BAPCO is given the benefit of all reasonable doubts and favorable inferences. *Poller v. Columbia Broadcasting System, Inc.*, 368 U.S. 464, 82 S.Ct. 486, 7 L.Ed.2d 458 (1962); *Kypta v. McDonald Corp.*, 671 F.2d 1282 (11th Cir.1982).

nelley; and (3) Donnelley has not offered sufficient evidence of "injury-in-fact" to avoid summary judgment. BellSouth and BAPCO's basis for summary judgment will be addressed hereafter.

The elements of a monopoly in violation of Section 2 of the Sherman Act are set forth in *United States v. Grinnell Corp.*, 384 U.S. 563, 86 S.Ct. 1698, 16 L.Ed.2d 778 (1966). The offense of monopoly consists of: "(1) the possession of monopoly power in the relevant market and (2) the willfull acquisition or maintenance of that power as distinguished from growth or development as a consequence of a superior product, business acumen, or historic accident." *Id.*, at 570-71, 86 S.Ct. at 1703-04. *See also St. Joseph's Hospital v. Hospital Corp. of America*, 795 F.2d 948 (11th Cir. 1986). Proof of a private monopolization claim also requires proof of a causal relationship between the antitrust violation and specific injury to plaintiff's business or property. *McClure v. Undersea Indus., Inc.*, 671 F.2d 1287, 1289 (11th Cir.1982); *Drinkwine v. Federated Publications, Inc.*, 780 F.2d 735, 738-39 (9th Cir.1985), *cert. denied*, 475 U.S. 1087, 106 S.Ct. 1471, 89 L.Ed.2d 727 (1986). To prove an attempt to monopolize plaintiff must show a specific intent to accomplish monopolization and that there existed a dangerous probability that the attempt would be successful. *Ad-Vantage Telephone Directory Consultants v. GTE Directories*, 849 F.2d 1336, 1341 (11th Cir.1987); *Spectrofuge Corp. v. Beckman*, 575 F.2d 256, 276 (5th Cir.1978), *cert. denied*, 440 U.S. 939, 99 S.Ct. 1289, 59 L.Ed.2d 499 (1979).

The offenses of both monopoly and attempt to monopolize require proof of the relevant product and geographic markets, which are a question of fact for the jury. *Ad-Vantage*, at 1341. Both claims also require proof of the intent of defendants to acquire or maintain a monopoly, which necessarily requires a factual determination from the evidence presented.

In the offense of monopoly (which Donnelley chiefly relies upon), the need to prove defendant's intent is obviated if the plaintiff successfully demonstrates that it has been denied an essential facility. *See Aspen Skiing Co. v. Aspen Highlands Skiing Corp.*, 472 U.S. 585, 105 S.Ct. 2847, 86 L.Ed.2d 467 (1985). Southern Bell argues that only tangible physical objects are "facilities" and, as such, because the Bell Companies allegedly withheld from Donnelley only information, the essential facilities doctrine does not apply. Southern Bell further buttresses its argument with *Directory Sales Management Corp. v. Ohio Bell Telephone Co.*, 833 F.2d 606 (6th Cir.1987), which states that the service of business classifications is not an essential facility because such information is unreliable and thus, has to be duplicated in any event by a competitor.

Although the doctrine of essential facilities has been applied predominantly to tangible assets, there is no reason why it could not apply, as in this case, to information wrongfully withheld The effect in both situations is the same: a party is prevented from sharing in something essential to compete. *See Driscoll v. New York*, 650 F.Supp. 1522, 1529 (S.D.N.Y.1987) (essential facilities doctrine applies "where there has been 'denial of access to physical structures or discreet [sic] *services.*'" (citing *Midsouth Grizzlies v. National Football League*, 550 F.Supp. 558, 570 n.32 (E.D.Pa.1982)). In addition, the opinion in *Ohio Bell* appears to base its ruling on the "uncontroverted evidence," in that the plaintiff would not be given a competitive advantage because the business classifications are unreliable. No such evidence of unreliability exists in this case. Accordingly, Donnelley is not precluded from attempting to prove intent by using the essential facilities doctrine in conjunction with other evidence that the Bell companies willfully maintained a monopoly.

The application of the essential facilities doctrine raises genuine issues of material facts. Specifically, there are

clear factual disputes as to the essentiality of the data Donnelley seeks and the availability of such data from sources alternative to the Bell companies. Moreover, there are numerous other factual issues in dispute under the rubrics of antitrust. Indeed, the parties cannot even agree on the very first issue in a monopoly claim—the relevant market. Donnelley contends the relevant market is for the sale of advertising directories and Southern Bell claims the market is in business information. The issue is factual, *see Ad-Vantage,* at 1341.

In sum, the plethora of factual disputes on the antitrust issues include:

1. The relevant market for the purposes of Section 2 liability;

2. Whether the Bell companies have a monopoly in such market;

3. Whether the data Donnelley seeks is essential to compete in the relevant market;

4. Whether such data may be obtained from other sources;

5. Whether the Bell companies have engaged in anti-competitive activity with the requisite intent;

6. Whether Donnelley requested certain information from Southern Bell in addition to that contracted for and whether such request was ignored;

7. Whether Southern Bell offered Donnelley such additional information; and if so, whether such offer was linked to concessions by Donnelley on the copyright issues;

8. Whether Southern Bell gave Donnelley sufficient data to realistically compete in the market for directories; and,

9. Whether the Bell companies' actions have caused Donnelley injury in fact.

Accordingly, these and other genuine issues of material fact preclude the entry of summary judgment at this time.

The final set of antitrust issues concern whether BellSouth and or BAPCO are proper defendants to Donnelley's antitrust counterclaims. Donnelley alleges that BellSouth, Southern Bell and BAPCO ("Bell Companies") jointly comprise an enterprise subject to liability under Section 2 of the Sherman Act as a matter of law. Donnelley contends that *Copperweld Corp. v. Independence Tube Corp.*, 467 U.S. 752, 104 S.Ct. 2731, 81 L.Ed.2d 628 (1984), "plainly establishes that the 'flip side' of abolishing the intra-enterprise conspiracy doctrine is that a family of corporations is an 'enterprise'—in the language of *Copperweld*—which is to be treated under Section 2." Concise Statement of Donnelley pursuant to Order of April 3, 1987 at 37-38. Alternatively, Donnelley argues that if a factual inquiry is made, then BellSouth and BAPCO's involvement in the "enterprise" is evidenced by their conduct.[35]

BellSouth contends that no federal decision, including *Copperweld,* holds that a parent company is or should be liable as a matter of law under Section 2 for the alleged unlawful activities of its subsidiaries when the parent has not engaged in any anti-competitive conduct. Concise Statement of BellSouth pursuant to Order of April 3, 1987 at 3. In addition, BellSouth argues that Donnelley has failed to submit any evidence in support of its contention that BellSouth has itself engaged in anticompetitive activity or that it should be vicariously liable[36] for

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[35] This is consistent with the Court's prior denial of summary judgment in open court as to the trademark issues. *See* Transcript of Status Conference on May 22, 1987 at 53.

[36] Because Donnelley has alleged that BellSouth has engaged in unlawful conduct in furtherance of a monopolistic scheme, BellSouth's vicarious liability is not at issue. Donnelley's Memorandum in Opposition to BAPCO and BellSouth's Motion For Summary Judgment on Antitrust Issues at 14.

the alleged unlawful activities of its subsidiaries. BAPCO argues that its only alleged improper act is the filing of this lawsuit against Donnelley and that such conduct is protected from antitrust attack by the *Noerr-Pennington* doctrine as formulated in *California Motor Transport Co. v. Trucking Unlimited,* 404 U.S. 508, 92 S.Ct. 609, 30 L.Ed.2d 642 (1972); *United Mine Workers v. Pennington,* 381 U.S. 657, 85 S.Ct. 1585, 14 L.Ed.2d 626 (1965); *Eastern Railroad President Conference v. Noerr Motor Freight, Inc.,* 365 U.S. 127, 81 S.Ct. 523, 5 L.Ed. 2d 464 (1961). BAPCO's Motion for Summary Judgment on Antitrust Issues at 9. Further, BAPCO claims that it is not liable for Southern Bell's actions as a matter of law or fact. The Court will address BellSouth's motion and then that of BAPCO.

In *Copperweld,* the United States Supreme Court addressed a situation in which anti-competitive conduct was explicitly coordinated and accomplished by two corporations. The Court held that a parent corporation and its wholly-owned subsidiary cannot be considered separate entities for purposes of a conspiracy allegation pursuant to Section 1 of the Sherman Act. In so holding, the Court rejected the long standing intra-enterprise conspiracy doctrine and recognized that a parent and subsidiary have a unity of purpose that renders unrealistic any attempts to treat them as totally independent for conspiracy purposes.

Donnelley bottoms its argument that BellSouth, as the parent corporation of Southern Bell, is liable as a matter of law on a few passages in *Copperweld.* For example:

> [A] parent and its wholly owned subsidiary have a complete unity of interest. Their objectives are common, not disparate; their general corporate actions are guided or determined not by two separate corporate consciousnesses, but one. They are not unlike a team of horses drawing a vehicle under the control

> of a single driver. *Id.* 467 U.S. at 771, 104 S.Ct. at 2741.

The Court also stated that the "single entity" test, which measure the separateness of a subsidiary, is inadequate.

> to describe a separate economic entity for purposes of the Sherman Act. The factors [to determine separateness] simply describe the manner in which the parent chooses to structure a subunit of itself. They cannot overcome the basic fact that the ultimate interests of the subsidiary and the parent are identical, so the parent and subsidiary must be viewed as a single economic unit. *Id.* at 773 n. 18, 104 S.Ct. at 2742 n. 18.

The Court concluded its opinion stating that "[a] corporation's initial acquisition of control will always be subject to scrutiny under § 1 of the Sherman Act. . . . Thereafter, the enterprise is fully subject to § 2 of the Sherman Act. . . ." *Id.* at 777, 104 S.Ct. at 2744.

This Court is thus faced with the novel issue of whether *Copperweld* should be extended to permit a parent corporation to be held liable for the conduct of its affiliates even when the parent has not engaged in unlawful conduct. No court has yet to interpret the dicta in *Copperweld* in this manner; and this Court declines to be the first. *See United National Records, Inc. v. MCA, Inc.*, 616 F.Supp. 1429, 1433 (N.D.Ill.1985) (holding that *Copperweld* does not overrule state corporate law which provides for limited liability of a parent corporation). As mentioned, *Copperweld* is a Section 1 case and that opinion only addressed the issue of separate corporate entities as it related to allegations of conspiracy. No such conspiracy is even alleged in this case and thus, BellSouth (and BAPCO) are not liable under *Copperweld* as a matter of law for Southern Bell's actions.

Donnelley has alleged, however, that BellSouth has itself engaged in anti-competitive activity in that:

1. A Corporate Policy Council composed of the most senior officers of BellSouth approved the formation of BAPCO and the form contract between BAPCO and Southern Bell.

2. BellSouth's direction of and involvement in the business of its subsidiaries, including its exercise of alleged direct control over decisions relating to their marketing of subscriber listing data bases.

3. BellSouth's sponsorship of Competitive Evaluation and Strategy Workshops for its subsidiaries, including Southern Bell and BAPCO.

4. BellSouth's provision of support services to BAPCO, including the provision of alleged critical assistance to BAPCO in developing an advertising campaign which would allegedly exploit the advantages gained by BAPCO through the Bell companies' alleged refusal to provide competitors with complete and up-to-date subscriber listing information.

5. That BellSouth officers serve as BAPCO directors.

Concise Statement of Donnelley pursuant to Order of April 3, 1987 at 38; Donnelley's Memorandum in Opposition to Motions by BAPCO and BellSouth For Summary Judgment on Antitrust Issues at 17-24 and affidavits and depositions cited therein. Supplemental Factual Statement of Donnelley in Opposition to Bell Companies' Motions For Summary Judgment on Antitrust Issues. The Court concludes that Donnelley's allegations of BellSouth's involvement and control of alleged antitrust activities, among others as supported by various affidavits and deposition testimony, are barely sufficient to defeat BellSouth's Motion For Summary Judgment on the antitrust issues. However, these issues should be properly evaluated by a jury, whose verdict will undoubtedly reflect the extent, if any at all, of BellSouth's alleged unlawful activities.

The only wrongful act by BAPCO specifically alleged in the counterclaim is the filing of the complaint against Donnelley. Donnelley has since engaged in a massive discovery effort, evidenced by the voluminous file in this case, and has not alleged any significant additional facts regarding unlawful monopoly conduct by BAPCO. Donnelley's new allegations include its principal claim that the agreement between Southern Bell and BAPCO covering directory operations, by itself, is enough to make BAPCO liable for the alleged monopolization scheme. Donnelley's Memorandum in Opposition to Motions by BAPCO and BellSouth For Summary Judgment on Antitrust Issues at 24. Donnelley also asserts that in early 1984 Southern Bell's personnel told an independent directory publisher that they would need BAPCO's approval to furnish subscriber information to that publisher. Supplemental Factual Statement of Donnelley in Opposition to Bell Companies' Motions For Summary Judgment on Antitrust Counterclaims at 13 and cited deposition. Donnelley finally contends that BAPCO has supplied subscriber listing data to an independent directory publisher to fulfill obligations of a contract between that publisher and Southern Bell and that BAPCO has provided at least one extract of business listings for use by a competitive analyst studying interexchange carriers. *Id.* at 13-14.

Although Donnelley contends that BAPCO's liability can be premised on the agreement between BAPCO and Southern Bell, Donnelley does not base its claim on the existence of the agreement. Rather, Donnelley objects to Southern Bell's alleged refusal to provide Donnelley with the identical information and services provided to BAPCO. The agreement between BAPCO and Southern Bell does not restrict Southern Bell from providing listing data or services to any third party. Because Southern Bell's agreement with BAPCO provides Southern Bell, and only Southern Bell, with the power to give or refuse to give subscriber listing data to third parties, the agreement itself fails to show any unlawful conduct by BAPCO.

Donnelley's other contentions are tenuously supported by deposition testimony and do not offer persuasive evidence that BAPCO, as opposed to the other Bell Companies, had anything but tangential involvement in the alleged anticompetitive activity. Accordingly, Donnelley has failed to offer "significant probative evidence demonstrating that a genuine issue of fact exists," as the party opposing summary judgment must do, with respect to anticompetitive activity of BAPCO. *First Nat'l Bank of Arizona v. Cities Service Co.*, 391 U.S. 253, 290, 88 S.Ct. 1575, 1593, 20 L.Ed.2d 569 (1968); *Pan-Islamic Trade Corp. v. Exxon Corp.*, 632 F.2d 539, 554 (5th Cir.1980). BAPCO's Motion For Summary Judgment with respect to Donnelley's antitrust affirmative defenses and counterclaims is therefore GRANTED.

IV. CONCLUSION

In summary, it is hereby

ORDERED and ADJUDGED as follows:

1. BAPCO's Motion For Summary Judgment on the copyright claims is GRANTED and Donnelley's Motion For Summary Judgment on the copyright claims is DENIED.

2. Donnelley's Motion for Summary Judgment on the trade-mark claims and on its counterclaim to cancel BAPCO's registration of the two-finger "walking fingers" logo are DENIED.

3. BellSouth and Southern Bell's Motions for Summary Judgment on Donnelley's antitrust counterclaims are DENIED.

4. BAPCO's Motion For Summary Judgment on Donnelley's antitrust counterclaims and affirmative defenses is GRANTED.

5. This case will be set for trial on the remaining issues by separate order.

DONE and ORDERED.

APPENDIX D

UNITED STATES COURT OF APPEALS
ELEVENTH CIRCUIT

No. 89-5131

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,
Plaintiff-Counterclaim
Defendant-Appellee,

v.

DONNELLY INFORMATION PUBLISHING, INC. and the
REUBEN H. DONNELLY CORP.,
Defendants-Counterclaim
Plaintiff-Appellants,

BELLSOUTH CORPORATION, *et al.*,
Counterclaim Defendants.

Appeal from the United States District Court
for the Southern District of Florida
Thomas E. Scott, Judge

Nov. 4, 1992

Douglas C. Broeker, Michael J. Cappucio, Fowler, White, Burnett, Hurley, Banick & Strickroot, Miami, Fla., David L. Foster, Theodore Case Whitehouse, Francis J. Menton, Jr., Willkie, Farr & Gallager, Baila H. Celedonia, Roger L. Zissu, Cowan, Liebowitz & Latman, P.C., New York City, for appellants.

Robert E. Richards, Anthony B. Askew, Jones, Askew & Lunsford, Atlanta, Ga., for Bellsouth Advertising.

John K. Roedel, Jr., Senniger, Powers, Leavitt & Roedel, St. Louis, Mo., for amicus ANADP.

Robert E. Marsh, Blackwell, Sanders, Matheny, Weary & Lombardi, Kansas City, Mo., for amicus US West.

Robert Alan Garrett, Arnold & Porter, Washington, D.C., for amicus Bell Atlantic.

ON PETITION FOR REHEARING AND SUGGESTION FOR REHEARING EN BANC

Before TJOFLAT, Chief Judge, FAY, HATCHETT, EDMONDSON, BIRCH, BLACK and CARNES, Circuit Judges.*

BY THE COURT:

A member of this court in active service having requested a poll on the application for rehearing en banc and a majority of the judges in this court in active service having voted in favor of granting a rehearing en banc,

IT IS ORDERED that the above cause shall be reheard by this court en banc. The previous panel's opinion is hereby VACATED.

* Judges Phyllis A. Kravitch, R. Lanier Anderson, III, Emmett R. Cox and Joel F. Dubina have recused themselves and will not participate.

APPENDIX E

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA
MIAMI DIVISION

No. 85-3233-CIV-TES

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,
Plaintiff-Counterdefendant,

v.

DONNELLEY INFORMATION PUBLISHING, INC., and
THE REUBEN H. DONNELLEY CORPORATION,
Defendants-Counterclaimants,

v.

BELLSOUTH CORPORATION and SOUTHERN BELL
TELEPHONE AND TELEGRAPH COMPANY,
Counterdefendants.

MODIFIED FINAL INJUNCTION AND
RESTRAINING ORDER

[Filed January 5, 1989]

NOW, THEREFORE, this Court being fully advised and having entered its Memorandum Opinion on October 27, 1988, in response to the parties' Motions and Cross-Motions for Summary Judgment, it is hereby ORDERED, ADJUDGED and DECREED that:

(1) Donnelley Information Publishing, Inc., The Reuben H. Donnelley Corporation, including but not limited to, its division Donnelley Directory, and their officers, agents, servants, employees and attorneys, and all other persons

in active concert or participation with them who receive actual notice of the Order by personal service or otherwise, and their successors and assigns other than Official Airline Guide and Donnelley Marketing and their successors and assigns (hereinafter collectively referred to as "DIP and RHD/Donnelley Directory") are hereby PERMANENTLY RESTRAINED and ENJOINED from:

(a) Keying, copying, or otherwise reproducing the Expression of Information, in whole or in part, from BAPCO copyrighted classified directories; [1]

(b) Preparing sales lead sheets from the Expression of Information keyed, copied, or otherwise reproduced, in whole or in part, from BAPCO copyrighted classified directories, or otherwise preparing derivative works based, in whole or in part, on BAPCO copyrighted classified directories;

(c) Publishing directories containing the Expression of Information keyed, copied, or otherwise reproduced, in whole or in part, from BAPCO copyrighted classified directories;

(d) Using keyed listings or listings which are otherwise mechanically or systematically reproduced from BAPCO copyrighted classified directories as a part of DIP and RHD/Donnelley Directory's directories, sales solicitations or market evaluations;

(e) Obtaining or using the Expression of Information unlawfully copied or reproduced by others from BAPCO copyrighted classified directories; and

(f) Engaging in any other conduct which constitutes infringement of BAPCO's copyrights in its classified directories.

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[1] The Court has not considered the question of copyrightability for white page directories, and the Court expresses no opinion as to the copyrightability of such white page directories.

As used herein, the term "Expression of Information" shall mean:

(a) Listings as arranged under a heading or headings;

(b) Listings and their associated heading or headings;

(c) A listing and its associated headings;

(d) The selection of headings;

(e) Listings and their associated directory advertising codes;

(f) A listing and its associated directory advertising codes; and

(g) Listings and their associated headings and their associated directory advertising codes.

As used herein, the term "listing" shall mean: the name, or the address, or the telephone number, or any combination thereof for each entity appearing in a classified directory in column or in display advertising.

(2) Donnelley Information Publishing, Inc., The Reuben H. Donnelley Corporation, including but not limited to, its division Donnelley Directory, and their successors, assigns, officers, agents, servants, employees and attorneys (other than its former divisions, Official Airline Guide and Donnelley Marketing, and the successors and assigns of those former divisions) shall file with this Court and serve upon counsel for BAPCO within forty-five (45) days after entry of this Injunction and Restraining Order, a report setting forth in detail the manner in which compliance with this Injunction and Restraining Order has been accomplished and periodically thereafter when requested by BAPCO and ordered by the Court.

(3) This Court will retain jurisdiction over the parties in this action to insure compliance with the terms of this Injunction and Restraining Order.

DONE and ORDERED in Chambers at Miami, Florida, on this 5th day of January, 1989.

/s/ Thomas E. Scott
THOMAS E. SCOTT
United States District Judge

APPENDIX F

PERTINENT CONSTITUTIONAL AND STATUTORY PROVISIONS

United States Constitution, Article I, section 8, clause 8:

> [t]he Congress shall have power * * * to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

Copyright Act of 1976, 17 U.S.C. §§ 101 et seq.:

§ 101. Definitions

* * * *

A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term "compilation" includes collective works.

* * * *

§ 102. Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.

* * * *

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

§ 103. Subject matter of copyright: Compilations and derivative works

(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works * * *.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

APPENDIX G

RULE 29.1 STATEMENT

Bellsouth Corporation Non-Wholly Owned Subsidiaries

Movicel S.A.
Bell Communications Research Inc.
ITT World Directories, Inc.
ITT World Directories (U.K.) Ltd.
Promedla B.V.
Uniquest Incorporated
BellSouth Argentina S.A.
BellSouth New Zealand (a Partnership)
Optus Communications Pty. Limited
AUSSAT New Zealand Limited
Instapage Joint Venture (NSW Partnership)
BCP Comercio e Participacoes Ltda.
BSB Comercio e Participacoes Ltda.
Telcell S.A.
BSE Comercio e Participacoes Ltda.
Celular Catarinense Comercio e Participacoes Ltda.
Movicom S.A.
Telefonia Movel do Sul S.A.
E-Plus Mobilfunk GmbH
TCIL BellSouth Limited
BellSouth Inversora S.A.
B.A. Celular Inversora S.A.
Compania de Radiocomunicaciones Moviles S.A.
BLS Denmark Associates
DMT Dansk Mobiltelefon I/S
Compagnie Financiere pour le Radiotelephone S.A.
PCN One Limited
Communication-Developpement S.A.
Comunicaciones Celulares de Occidente, S.A. de C. V.
ROU Celular Inversora S.A.
Abiatar S.A.
TelCel Celular, C.A.
Air Call Communications SA

Australia New System L.P.
BellSouth Wireless Data Company L.P.
RAM/BSE Communications L.P.
Belgium New System L.P.
RAM Mobile Data Belgium S.P.R.L.
France New System L.P.
France Telecom Mobiles Data, S.A.
Germany New System L.P.
Honolulu Cellular Telephone Company
Netherlands New System L.P.
RAM Mobile Data C.V.
RAM Mobile Data (Netherlands) B. V.
RAM Mobile Data USA Limited Partnership
BSE Mobile Data Company, L.P.
RAM/BSE, L.P.
RAM/BSE Paging Company, L.P.
National Cellular Communications, Inc.
Gulf Coast Cellular Telephone Company (A Partnership)
Charisma Communications Corp. of the Southwest
Houston Mobile Cellular Communications Company
(A Partnership)
Houston Cellular Telephone Company (A Partnership)
Galveston Cellular Partnership
Galveston Mobile Partnership
Honolulu Cellular Telephone Company (A Partnership)
Cellular Systems (A Partnership)
MCTA (A Partnership)
Los Angeles RCCs, Inc.
Los Angeles Cellular Corporation
Los Angeles Cellular Telephone Company
(A Partnership)
Bloomington Cellular Telephone Company
(A Partnership)
Kokomo Celltelco Partnership (A Partnership)
Muncie Cellular Telephone Company, Inc.
Terre-Haute Cellular Telephone Company, Inc.
Los Angeles Cellular Corporation

Los Angeles Cellular Telephone Company
(A Partnership)
Green Bay Cellular Telephone Company (A Partnership)
Janesville Cellular Telephone Company, Inc.
Madison Cellular Telephone Company (A Partnership)
Racine Cellular Telephone Company (A Partnership)
Sheboygan Cellular Telephone Company, Inc.
RCTC Wholesale Company (A Partnership)
Westel-Tampa Company, Inc.
Acadiana Cellular General Partnership (RSA's No. 5 & 6)
Huntsville MSA Limited Partnership
Centel Cellular Company of Hickory
Centel Cellular Company of North Carolina
Centel Cellular Company of Tallahassee
Century Cellunet of North Louisiana Cellular Limited
Partnership
Chattanooga MSA Limited Partnership
Decatur RSA Limited Partnership
Jacksonville MSA Limited Partnership
Florida RSA #2B (Indian River) Limited Partnership
Atlanta-Athens MSA Limited Partnership
Georgia RSA No. 1 Limited Partnership
Georgia RSA No. 2 Limited Partnership
Georgia RSA No. 3 Limited Partnership
Lexington MSA Limited Partnership
Baton Rouge MSA Limited Partnership
Lafayette MSA Limited Partnership
Louisiana RSA No. 7 Cellular General Partnership
Louisiana RSA No. 8 Limited Partnership
Memphis SMSA Limited Partnership
Nashville/Clarksville MSA Limited Partnership
North Carolina RSA 15 North Sector Limited Partnership
Northeastern Georgia RSA Limited Partnership
Orlando SMSA Limited Partnership
Columbia MSA Limited Partnership
South Carolina RSA No. 4 Cellular General Partnership
South Carolina RSA No. 5 Cellular General Partnership
South Carolina RSA No. 6 Cellular General Partnership
MobileComm of the West, Inc.
Skilldex, Inc.